Supreme Court, U.S.
FILED

97 • 376 SEP 3 1997

No. OFFICE OF THE CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1997

Warren Publishing Inc.,
Petitioner,

v.

Microdos Data Corp., *et al.*,
Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

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PETITION FOR WRIT OF CERTIORARI

JOYCE B. KLEMMER
SMITH, GAMBRELL, & RUSSELL
Suite 3100, Promenade II
1230 Peachtree Street, NE
Atlanta, GA 30309-3592
(404) 815-3500

DENNIS LANE
Counsel of Record
MORRISON & HECKER L.L.P
Suite 800
1150 18th Street, NW
Washington, DC 20036-3816
(202) 785-9100

QUESTIONS PRESENTED

1. Whether the manner by which materials are selected for inclusion in a factual compilation is a "system," as that term is used in 17 U.S.C. § 102(b), that renders the resulting selection uncopyrightable.

2. Whether a manner of selection grounded in commercial usefulness lacks the requisite creativity to support the copyrightability of the resulting factual compilation.

3. Whether the merger doctrine should be analyzed in terms of the idea behind the particular expression found in a work, rather than in terms of the idea behind the work itself.

PARTIES TO THE PROCEEDING BELOW

Microdos Data Corporation

Robert Payne

Warren Publishing, Inc.

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PETITION FOR WRIT OF CERTIORARI

Warren Publishing, Inc. ("Warren"), plaintiff-appellee below, petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Eleventh Circuit in this case.

OPINIONS BELOW

The *en banc* opinion of the court of appeals (Pet. App. 1a-52a) is reported at 115 F.3d 1509. The panel opinion of the court of appeals (Pet. App. 53a-73a) is reported at 52 F.3d 950. The panel opinion was vacated when rehearing *en banc* was granted. 67 F.3d 276 (Pet. App. 74a-75a). The district court decision (Pet. App. 76a-102a) is reported at 1992 WL 235745 (N.D.Ga. Mar. 31, 1992).

JURISDICTION

The *en banc* judgment of the court of appeals was entered on June 10, 1997. Jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTES INVOLVED

The relevant provisions of the Copyright Law of the United States of America are reproduced at Pet. App. 103a-104a.

STATEMENT OF THE CASE

The *en banc* decision below conflicts with the rulings of other courts of appeals on the recurring and important issue of the requisite level of originality and creativity necessary to render the selection of materials for inclusion in factual compilations copyrightable and thus subject to copyright protection.

Other courts of appeals, following the principles established by this Court, have examined the manner of selection to determine the creativity of an author in compiling facts. Those courts ruled that where the manner of selection

reflects an author's original intellectual conception of how materials are to be chosen for inclusion, the resulting selection is copyrightable. In contrast, the *en banc* court below ruled that an author's manner of selection is a "system," as that term is used in 17 U.S.C. § 102(b), which makes the resulting selection uncopyrightable.

Other courts of appeals have also found that selections based on commercially useful principles for organizing data show sufficient creativity and originality to render the resulting selection copyrightable. In contrast, the *en banc* court below ruled that a selection derived from a commercially useful organizing principle is a discovery of fact, not a creative act, and thus uncopyrightable.

Had the *en banc* court below followed this Court's guidelines regarding the level of originality and creativity necessary to render a factual compilation copyrightable, it would have upheld the district court's and the panel's decisions that the selection at issue is protected by copyright law. Those guidelines teach that nearly all selections used to create factual compilations will satisfy the originality and minimal level of creativity required. The court below improperly raised the bar to copyrightability of factual compilations by excluding selections, arrangements or organizations chosen (1) under a systematic organizing principle or (2) for commercial usefulness.

A. Warren's Factbook

Since 1948, Warren has published an annual directory of information about cable systems throughout the country called the *Television & Cable Factbook* ("Factbook"). The 1988 edition of the Factbook at issue in this case, particularly the "Directory of Cable Systems," contains approximately 1,340 pages with listings about 8,413 "cable systems." 115

F.3d at 1511, Pet. App. 4a.[1] Each cable system listing in the Factbook contains a similar set of information about a system's location, management, equipment, services, prices, and size (*e.g.*, number of subscribers, miles of plant).

Cable operators obtain franchises from local authorities, and then build cable systems to serve subscribers in those franchised area(s). *See, e.g., Capital Cities Cable Inc. v. Crisp*, 467 U.S. 569, 702 (1984). There is no single statutory definition of "cable system." *Compare, e.g.,* 17 U.S.C. § 111(f) (copyright law definition) *with* 47 U.S.C. § 522(6) (communications law definition). To identify the cable systems to be listed in the Factbook, Warren formulated its own definition of cable system: an entity offering subscribers in one or more communities the same cable services for the same price. 115 F.3d at 1521, Pet. App. 28a.

The district court noted that "how one defines a 'cable system' will dictate the communities selected to represent those systems." Dist.Ct.Op. 10, Pet. App. 82a. Consistent with its definition, Warren gathered from various sources, including its own annual questionnaire, considerable information about cable service in each community. 115 F.3d at 1520 and 1526, Pet. App. 24a and 40a. Warren overlaid its cable system definition on this assembled data to identify groups of communities served by the same entity offering the same cable services for the same price. *Id.* at 1522-23, Pet. App. 32a. Each such separately identified group of communities was reported as a "cable system" in the Factbook.

The listings in the Factbook are organized by state, and within each state, alphabetically by community name. *Id.* at 1512, Pet. App. 4a. Although the Factbook lists the names of

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[1] Because of the 1988 Factbook's size, the parties agreed to use of the listings for Illinois as representative. 115 F.3d at 1513 n. 8, Pet. App. 9a.

all communities served by cable operators, Warren does not consider each community to be a separate cable system, as does the Federal Communications Commission ("FCC"). *See* 115 F.3d at 1521, Pet. App. 29a (FCC definition of cable system). As a result, only those groups of communities that meet Warren's definition are classified as "cable systems" and given a detailed listing in the Factbook.

Warren chooses one of the communities (called the "principal community") served by a cable system to identify that system in the Factbook.[2] *Id.* at 1512, Pet. App.5a. If a "cable system" serves multiple communities, Warren aggregates data from those communities to give a portrait of the system as a whole.[3] *Id.* at 1523, Pet. App. 32a. These aggregated data appear under the "principal community" chosen by Warren for that system listing. The aggregated listing identifies all other communities other than the "principal community" served by that cable system. 115 F.3d at 1512, Pet. App. 5a.

Using Illinois as the representative of all Factbook listings, Warren identified 1,000 plus communities served by cable operators in that state. 115 F.3d at 1518 and 1522, Pet. App. 20a and 31a. From this universe, Warren, using its definition, selected 406 "cable systems" to be reported in the

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[2] In cases where cable operators serve only a single community, the single community identifies the "cable system" under Warren's definition.

[3] For example, assume Warren identifies a cable system with 3,000 subscribers in community A and 2,000 subscribers in community B. Assume also that Warren chooses B as the "principal community" perhaps because the system's offices are located there. The system is thus identified as "B" in the Factbook and the only detailed information about the system (*e.g.*, that it has 5,000 total subscribers) would be found under B. Although the community name "A" would also be found in the Factbook, it would merely be as one community served by a cable operator, not as a separately identified cable system.

1988 Factbook. *Id.* These 406 cable systems are representative of the Factbook selection for which Warren seeks copyright protection.

B. Microdos's Database

The defendant, Microdos, began in 1989 to market a computer software package called "Cable Access," which includes a database of information on individual cable systems. *Id.* at 1512, Pet. App. 6a. Warren sued Microdos for copyright infringement based, in relevant part, on the near identity between the selection of cable systems in the 1988 Factbook and those contained in the several versions of the Cable Access database. *Id.* at 1520, Pet. App. 26a.

C. The Decisions Below

The district court held that Warren's "cable system" selection was "sufficiently creative and original to be copyrightable." Dist.Ct.Order at 11, Pet. App. 83a. The district court found that the cable system listings in Microdos's database were substantially similar to the selection in the 1988 Factbook. *See id.*, at 12-13, Pet. App. 84a (1988 Factbook lists 406 Illinois cable systems, the four versions of Microdos's database had 405, 394, 393 and 398 of same systems). The court rejected the independent creation defense, finding "virtually no evidence that Microdos relies on any principled criteria for community selection, and the impression is that Microdos copied Warren's selection and then endeavored to mask the copying by minor manipulation." *Id.* at 17, Pet. App. 87a.

On appeal, a panel of the Eleventh Circuit affirmed. 52 F.3d 950, Pet. App. 53a. That opinion was vacated by a grant of rehearing *en banc*. 67 F.3d 276, Pet. App. 74a. Upon rehearing *en banc*, the Eleventh Circuit overturned the district court's ruling, based on a conclusion that Warren's selection

was uncopyrightable:

> Although the record indicates that Microdos's choices as to where to list the factual data on cable system had an extremely high correlation with Warren's principal community listings, Microdos copied no original selection, coordination, or arrangement of Warren's factual compilation.

115 F.3d 1520-21, Pet. App. 26a . Three judges dissented from the decision. 115 F.3d at 1521, Pet. App. 27a.

REASONS FOR GRANTING THE WRIT

The *en banc* decision below conflicts with decisions of other courts of appeals concerning the level of creativity necessary for selections contained in factual compilations to be protected by copyright. Rather than recognizing the modicum of creativity that this Court and other courts have found fulfills the constitutional and statutory requirements, the decision below found that certain classes of selections are completely lacking in creativity. Eliminating whole classes of selection from copyrightability eviscerates the copyright protection afforded factual compilations, and thus threatens an important and growing segment of works essential to the widespread dissemination of information.[4]

1. One class excluded from copyright protection by the *en banc* decision below is any selection employing a system for selecting materials to be included in a particular factual compilation. The 1988 Factbook is a factual "compilation" within the meaning of the copyright law. 17 U.S.C. § 101 "compilation" and § 103. The Factbook

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[4] The briefs for *amici curiae* will offer a picture of the scope and importance of factual compilations.

compiles information about cable systems. *See, e.g., Turner Broadcasting System, Inc. v. FCC*, 512 U.S. 622, 628 (1994)(relying on the 1994 Factbook for information about channel capacity of cable systems). The only issue before the *en banc* court below was the copyrightability of the selection of cable systems included in the Factbook. 115 F.3d at 1516, Pet. App. 16a.

The district court held the selection contained in the Factbook should be protected by copyright because:

> Warren argues that the selection of those communities was creative and protectible because Warren uses a unique system in selecting the communities that will be represented in the Factbook. The court finds that Warren Publishing's system of selecting communities is sufficiently creative and original to be copyrightable.

Dist.Ct. Order. 16, Pet. App. 83a (emphasis in original).

The *en banc* decision below seized on the reference to Warren's "system of selecting communities" to conclude that the district court had erred because "system" is expressly identified in 17 U.S.C. § 102(b) as outside the scope of copyright protection:

> the district court concluded that Warren's "system" of selecting communities was original and entitled to copyright protection. This conclusion is contrary to the plain language of 17 U.S.C. § 102(b), and is clearly incorrect.

115 F.3d at 1517, Pet. App. 17a (citation and footnote omitted).

The *en banc* decision below directly conflicts with a

ruling by the Eighth Circuit on this very point. *Toro Co. v. R & R Products Co.*, 787 F.2d 1208 (8th Cir. 1986). In that case, the district court held that "§ 102(b) of the 1976 [Copyright] Act precluded copyright protection for systems like appellant's parts numbering system." 787 F.2d at 1211. After analyzing the language and history of § 102(b), the Eighth Circuit ruled:

> the district court's literal application of [§ 102(b)'s] language - that appellant's parts numbering system is not copyrightable because it is a "system" - cannot stand. All that the idea/expression dichotomy embodied in § 102(b) means in the parts numbering system context is that appellant could not copyright the idea of using numbers to designate replacement parts. Section 102(b) does not answer the question of whether appellant's particular expression of that idea is copyrightable.

Id. at 1212.

Warren seeks protection only for the expression -- *e.g.*, the 406 Illinois cable systems in the 1988 Factbook -- that resulted from its "system" for selecting "cable systems" ultimately included in the Factbook. The infringement alleged was copying that resulted in a nearly identical list of cable systems in Microdos's database. Warren did not seek copyright protection for the underlying idea of its "system" or for any aspect of its data collection efforts. 115 F.3d at 1530, Pet. App. 50a. In these circumstances, reliance on section 102(b) to find no copyright protection is unwarranted.

At a broader level, creation of factual compilations always entails use of a "system" for collecting and selecting data. A "system" is an orderly arrangement of parts into a whole according to some rational principle. *Black's Law Dictionary* 1450 (6th ed. 1990). The definition of

"compilation" in 17 U.S.C. § 101 acknowledges the process of arranging materials into a whole:

> A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. [5]

This Court, too, has noted that a compilation derived from a system to select materials for inclusion can be copyrightable:

> The compilation author typically chooses which facts to include, in what order to place them, how to arrange the collected data so that they may be used effectively by readers. *These choices* as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws.

Feist Publications, Inc. v. Rural Telephone Service Co., 499

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[5] The legislative history likewise recognizes that a compilation "results from a process of selecting, bringing together, organizing, and arranging" materials. H.R. Rep. No. 1476, 94th Cong. 2d Sess. 57, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5670. "Process," like "system," is classified in 17 U.S.C. § 102(b) as outside the scope of copyright protection. Following the reasoning of the *en banc* court below leads to the anomalous result that Congress's explanation of how a copyrightable compilation is created actually describes an unprotected selection because a "process" is "excluded from copyright protection under section 102(b)." 115 F.3d at 1517 n.22, Pet. App. 17a n.22. It is impossible to believe that Congress intended this result.

U.S. 340, 348 (1991) (emphasis added); *see also* 499 U.S. at 358 ("courts . . . in determining whether a fact-based work is an original work . . . should focus on the manner in which the collected facts have been selected"). In the face of these controlling authorities, the *en banc* decision barring protection whenever "a system to select" (115 F.3d at 1517, Pet. App. 17a) materials is employed cannot be allowed to stand.

2. Another class of compilations excluded from copyright protection by the *en banc* decision below is any in which selection is based on an organizing principle of commercial usefulness.

The *en banc* court ruled that "Warren discovered the existence of the principal community as an organizing principle [for selecting cable systems], Warren did not create this organization." 115 F.3d at 1520 n. 31, Pet. App. 25a n.31. The court also stated that the decision to use principal communities to identify cable systems was done "to make the Factbook commercially useful." *Id.* at 1518, Pet. App. 21a. In other words, the court below views an organizing principle based on commercial usefulness as a fact to be discovered, not as the product of an author's intellectual labor.

This ruling directly conflicts with the rulings by other courts of appeals that have addressed the copyrightability of selections based on commercially useful organizing principles. None of those courts have found such principles to be facts waiting to be discovered, but rightly determined that they ensued from the creative labor of an author.

This issue goes to whether a selection meets the originality requirement for copyright protection. Original for copyright purposes means that "the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of

creativity." *Feist*, 499 U.S. at 345. This Court further explained that "the requisite level of creativity is extremely low" and that "[t]he vast majority of works make the grade quite easily." *Id.* In the instant case, it has never been suggested that Warren copied its cable system listings from another work. As a result, the only issue is whether Warren's selection exhibits a minimal degree of creativity.

Courts of appeals applying this Court's guidelines have uniformly determined that any organizing principle emanating from the author of a selection meets the requisite level of creativity. *See Key Publications v. Chinatown Today Pub. Enterprises, Inc.*, 945 F.2d 509, 513 (2d Cir. 1991)(selection "implies the exercise of judgment in choosing which facts from a given body of data to include in a compilation" and such judgment showed creativity); *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 140 (5th Cir. 1992), (creativity found where selection "required [author] to make choices that resulted in independent expression"); *Urantia Foundation v. Macherra*, 114 F.3d 955, 959 (9th Cir. 1997)("the human selection and arrangement of the revelations in this case could not have been so `mechanical or routine as to require no creativity whatsoever'")(citation omitted); *Atari Games Corp. v. Oman*, 979 F.2d 242, 247 (D.C.Cir. 1992)(any selection which "is neither `obvious' nor an `inevitable' choice" passes muster)(citation omitted); and *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991)("unlikely" that there is a lack of creativity "[i]n view of the variety of pitching forms disclosed in the record").

The only situation in which courts have not allowed protection has been where an organizing principle eliminates any opportunity to make a choice. *Mid America Title Co. v. Kirk*, 59 F.3d 719, 722 n. 3 (7th Cir. 1993) ("external forces dictated that Mid America was to list all facts which affect marketable title, there was no room for creativity"); *Victor Lalli Enterprises v. Big Red Apple*, 936 F.2d 671, 673 (2d Cir.

1991) (the chart at issue "is a convention: Lalli exercises neither selectivity in what he reports nor creativity in how he reports it"); and *Sem-Torq, Inc. v. K Mart Corp.*, 936 F.2d 851, 855 (6th Cir. 1991) ("functional nature of the signs, not creativity, mandated the selection of the features which were already widely used").

Nothing in the record suggests that the selection of cable systems in the Factbook was dictated by external forces or was a convention. Both the number of Illinois cable systems (406) and the number of Illinois listed communities (1,000 +) in the 1988 Factbook differ from the number of community cable systems (724) listed by the FCC, 115 F.3d at 1518 and 1522-23, Pet. App. 20a and 31a-32a, or by other publications (243). *Id.*at 1530, Pet. App. 52a.[6] These are not differences that vary "only to a trivial degree" so as to call into question the originality of Warren's selection. *Kregos*, 937 F.2d at 705. Nor do they "follow 'a convention' that is 'purely functional,' allowing 'no opportunity for variation.'" *Atari Games*, 979 F.2d at 246 (citation omitted).[7] These considerable differences between selections in the instant record show, rather, that the "organizing principles of the [various] directories are thus not substantially similar." *Key Publications*, 945 F.2d at 516.

In short, other courts of appeals have looked to

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[6] The district court found a "total of 880 communities were listed by one or more of the entities publishing works on the cable industry," ranging from the FCC's high of 724 to a low of 243. Dist.Ct. Order. at 12, Pet. App. 84a. The district court also found that "each source listed some communities not included in other works." 52 F.3d at 953, Pet. App.60a.

[7] Even the *en banc* court below recognized the "numerical disparity" between the FCC's and Warren's listings, which forced it to surmise a "likely explanation" for the disparity. 115 F.3d at 1518 n. 26, Pet. App. 20a n.26. That surmise shows, however, that Warren used of a different selection process from that of the FCC.

whether an organizing principle offers an author any latitude in selecting what materials to include in a compilation. If it does, protection is allowed; if it does not, no protection is granted. No other court has followed the approach of the *en banc* court below that a commercially useful organizing principle, like Warren's, is a fact to be discovered (rather than a creative conception of the author), and thus is not protected.

3. The *en banc* court found that "Warren's claim of copyright in its selection of [principal] communities does not survive application of the merger doctrine." 115 F.3d at 1518-19 n. 27, Pet. App. 21a n.27. According to the *en banc* court, the "idea of organizing [cable system selection] by principal community yields very few ways, if not the only way, of expressing the data." *Id.* The *en banc* court also indicated that if protection were given to Warren's selection, "the concept of cross-referencing would be subsumed in its copyright." *Id.* This application of the merger doctrine directly conflicts with other courts of appeals' approach to this question.

Application of the merger doctrine is a means of line-drawing between "ideas" and "expression": "if particular expression is necessary to an idea, [that] expression is not copyrightable." *Toro Co.*, 787 F.2d at 1212. Identifying the idea is key: "We cannot determine whether an idea is capable of a variety of expressions until we first identify what that idea is. A court's decision whether to apply the merger doctrine often depends on how it defines the author's idea." *Mason*, 967 F.2d at 140. Defining the idea involves balancing between the desirability of protection and non-protection: "[t]he guiding consideration in drawing the line is the preservation of the balance between competition and protection reflected in the patent and copyright laws." *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971).

The *en banc* court below defined the idea at issue as

the means used by Warren ("idea of organizing by principal community") to make its selection. But this approach is circular, and will always merge the selection with the idea behind it.[8] The proper approach, as found by other courts of appeals, examines the idea behind the overall work, and then determines whether that idea can be expressed in a few, or many, ways. *See Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678-79 (1st Cir. 1967)(protection denied where "by copyrighting a mere handful of forms, [an author] could exhaust all possibilities of future use of [an idea's] substance").

The need to look at the idea behind a work, not the idea behind a particular selection, is illustrated by two Fifth Circuit cases reaching different conclusions about particular maps under the merger doctrine. In *Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458, 1459 (5th Cir.), *cert. denied*, 498 U.S. 952 (1990), the court was faced with copying of a map that "depicted the proposed route of a natural gas pipeline." The idea behind the work (map) was the "proposed location of a prospective pipeline." *Id.* at 1464. This idea merged with the map's expression because the "map markings are certainly the only effective way to convey the idea of the proposed location of a pipeline across 1,000 miles of terrain." *Id.*

In *Mason, supra*, 967 F.2d at 139, the idea was "to create the maps" at issue showing "the abstract and tract boundaries, indicating the ownership name, the tract size, and the other factual information" using "legal and factual public information." The Fifth Circuit found no merger because

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[8] "Every compiler of facts has the idea that his particular selection of facts is useful. If the compiler's idea is identified at that low level of abstraction, then the idea would always merge into the compiler's expression of it. Under that approach, there could never be copyrightable compilation of facts." *CCC information Services, Inc. v. Maclean Hunter Market Reports, Inc.*, 44 F.3d 61, 71 (2d Cir. 1994)(citation and footnote omitted).

> copies of maps created by Mason's competitors . . . prove beyond dispute that the idea embodied in Mason's maps is capable of a variety of expressions. Although the competitors' maps and Mason's maps embody the same idea, they differ in the placement, size, and dimensions of numerous surveys, tracts, and other features.

Id. In both cases, the court looked to the idea behind what was to be depicted (not how it was depicted) on the map to determine whether that idea offered sufficient latitude of expression.

The same reasoning was applied in *Superior Form Builders, Inc. v. Chase Taxidermy Supply Co.*, 74 F.3d 488, 492-93 (4th Cir. 1996), which distinguished between casting and sculpting a deer under the merger doctrine:

> Several sculptors may copy a deer, even the same deer, in creating a sculpture, and each may obtain copyright protection for his or her own expression of the original. . . . If, however, a person makes a casting rather than a sculpture of the deer, the effort introduces no originality into the product. Indeed, in such a case, the idea in the original and its expression in the casting are identical and inseparable because the mechanical process allowed for no possibility of originality, which is inherent in authorship.

In the instant case, the *en banc* court's merger analysis did not examine the idea behind the Factbook, but looked to the idea behind Warren's organizing principle of selection. This would be akin to the *Superior Form* court determining

that no sculpture of a deer could be protected because the idea behind, for example, sculpting a deer in Art Deco style merged with the expression of the resulting Art Deco sculpture. By focusing myopically on the idea behind a single means of expression, the *en banc* court below lost sight of the fact that the idea behind the work could be expressed in many ways.

The idea behind the Factbook is to create a source of information about "cable systems." What constitutes a "cable system" is an open question: no uniform statutory or common usage definition exists and cable operations constantly change. This fluid situation presents opportunities for any number of choices in selecting how to report information about "cable systems." After detailed analysis, the district court found three disparate compilations of "cable systems" in use at the time of the 1988 Factbook, Dist.Ct. Op. 12, Pet. App. 84a, and the dissent outlined other reporting possibilities. 115 F.3d at 1530, Pet. App.51a-52a.[9] The actual and potential selection choices for reporting information about cable systems makes the merger doctrine inapplicable.

In sum, the *en banc* court's application of the merger doctrine conflicts with the approach of other courts of appeals by looking at the idea behind the actual selection (*i.e.*, expression), rather than the idea behind the work.

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[9] The *en banc* decision focused on single community systems, which comprise 55% of Warren's Illinois cable systems, as having "only one possible principal community." 115 F.3d at 119 n. 30, Pet. App. 23a n.30. But this does not consider whether single community cable systems could be grouped in other ways, *e.g.*, by owner. The *en banc* court claimed that for two-thirds of the remaining 45% of Illinois cable systems (or 30% of the total) the principal community is the one in the FCC records with the largest number of subscribers. *Id.* The court states that no "tenable argument" can be made about these selections. But the district court found considerable discrepancy between claimed matches of FCC and Factbook data. Dist.Ct.Op. at 15-16, Pet. App. 86a-87a. The *en banc* court offers no explication for the final 15% of Warren's Illinois cable system listings.

4. The *en banc* court found that Warren "did not exercise any creativity or judgment in 'selecting' cable systems to include in its Factbook, but rather included the relevant universe known to it." 115 F.3d at 1518, Pet. App. 21a. This finding follows from the fact that Warren lists all communities served by cable operators (the universe) as well as cable systems identified by principal community (the selection) in the Factbook. *Id.* In effect, the court ruled that the listing of the selection within the universe negated creativity in Warren's selection.[10] This ruling directly conflicts with the Second Circuit's ruling in a virtually identical situation.

The coexistence of Warren's selection of cable systems within the universe of the communities served by cable operators does not negate the creativity or originality of the selection. In a virtually identical juxtaposition of selection within universe, the Second Circuit found the selection protectible. The work at issue in *Eckes v. Card Prices Update*, 736 F.2d 859, 860 (2d Cir. 1984), was a baseball card guide that "list[ed] some 18,000 different baseball cards." The guide divided the cards "into two groups: premium or star cards, and common cards. . . . [with] approximately 5,000 of the former" premium cards listed. *Id.* The infringing work "contained substantially the same 5,000 cards that the Guide had listed as premium cards." 736 F.2d at 861.

The infringers contended that "copyright protection does not extend either to the *idea* of a baseball card

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[10] Notwithstanding the inclusion of all community names, the Factbook is overwhelmingly regarded as a cable system source book. As the *en banc* court noted, the relevant part of the Factbook, entitled "Directory of Cable Systems," contains "extensive information on cable systems." *Id.* at 1512, Pet. App. 4a. The defendant copied into its database only cable system listings, not individual community names. *Id.* at 6a. This Court, too, has looked to the Factbook for data about cable systems, not about communities. *Turner Broadcasting System*, 512 U.S. at 628.

compilation or to the facts and information contained in the compilation." *Id.* at 862 (citations omitted; emphasis in original). The court agreed that facts and information were not protected, but ruled the selection of the 5,000 cards from the larger universe was protected:

> We have no doubt that appellants exercised selection, creativity and judgment in choosing among the 18,000 or so different baseball cards in order to determine which were the 5,000 premium cards. Accordingly, we believe that the Guide merits protection under the copyright laws.

Id. at 863. The court found infringement of "protected expression contained in" the premium card selection of the guide, notwithstanding that this guide coexisted with the universe. *Id.* at 864; *accord Key Publications*, 945 F.2d at 516-17.

5. Factual compilations have become increasingly important in today's information-driven economy. This Court and several courts of appeals have found that a minimal level of creativity is needed to protect the selection, arrangement or organization of such compilations through copyright law. The *en banc* decision below directly conflicts with those decisions by building artificially higher barriers to a finding of creativity. These higher barriers reduce the protection afforded compilation authors for their creative efforts in derogation of the public policy behind the copyright law. *CCC Information Services* , 44 F.3d at, 66 :

> Compilations that devise new and useful selections and arrangements of information unquestionably contribute to public knowledge by providing cheaper, easier, and better organized

> access to information. Without financial incentives, creators of such useful compilations might direct their energies elsewhere, depriving the public of the creations and impeding the advance of learning.

This Court should grant certiorari to resolve the circuit conflict on this important area of copyright law.

CONCLUSION

The petition for writ of certiorari should be granted.

Respectfully submitted,

DENNIS LANE
Counsel of Record
MORRISON & HECKER L.L.P.
Suite 800
1150 18th Street, NW
Washington, DC 20036-3816

JOYCE B. KLEMMER
SMITH, GAMBRELL & RUSSELL
Suite 3100, Promenade II
1230 Peachtree Street, NE
Atlanta, GA 30309-3592

Appendix

IN THE UNITED STATES COURT OF APPEALS

FOR THE ELEVENTH CIRCUIT

No. 93-8474

D. C. Docket No. 1:90-CV-1654-JOF

WARREN PUBLISHING, INC.,

Plaintiff,
Counter-Defendant,
Appellee,

versus

MICRODOS DATA CORP.;
ROBERT PAYNE,

Defendants,
Counter-Claimants,
Appellants.

Appeal from the United States District Court
for the Northern District of Georgia

(June 10, 1997)

Before HATCHETT, Chief Judge, TJOFLAT, ANDERSON, EDMONDSON, COX, BIRCH, DUBINA, BLACK, CARNES, and BARKETT, Circuit Judges, and GODBOLD* and KRAVITCH**, Senior Circuit Judges.

*Senior U.S. Circuit Judge John C. Godbold elected to participate in this decision pursuant to 28 U.S.C. § 46(c).

**Senior U.S. Circuit Judge Phyllis A. Kravitch heard oral argument in this case on February 13, 1996 as a judge on active status. She took senior status on December 31, 1996 and has elected to participate in this decision pursuant to 28 U.S.C. § 46(c).

BIRCH, Circuit Judge:

This is an appeal from the district court's entry of a preliminary injunction[1] enjoining a putative infringer from infringing the compilation copyright of a publisher of a cable television factbook. As a predicate for the injunction, the district court granted partial summary judgment for the copyright holder, finding that the copyright holder's system of selecting the names of communities under which to list the data in its factbook was sufficiently creative and original to warrant copyright protection. Based on Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991), as well as our application of Feist in BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc., 999 F. 2d 1436 (11th Cir. 1993) (en banc),[2](11th Cir. 1992), and on reh'g 999 F.2d 1436 (11th Cir. 1993) (en banc), cert. denied, 510 U.S. 1101, 114 S. Ct. 943, 127 L. Ed. 2d 232 (1994). cert. denied, 510 U.S. 1101, 114 S. Ct. 943, 127 L. Ed. 2d 232 (1994), we VACATE the injunction and REMAND for further proceedings.

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[1] The district court granted Warren's motion for "permanent" injunction. Warren's claim for unfair competition, as well as Microdos's counterclaims for defamation and trade disparagement, interference with contractual relations, and violation of Sherman Act by attempts to monopolize, however, all have yet to be addressed by the district court. No final judgment was entered under 28 U.S.C. § 1291 because the court has not yet disposed of all the claims in the case and did not make its injunction a final judgment pursuant to Fed. R. Civ. P. 54(b). Accordingly, the order before us is an interlocutory order for an injunction that is subject to review under 28 U.S.C. § 1292(a)(1).

[2] We note that the district court, in ruling on the summary judgment motions, did not have the benefit of our en banc opinion in BellSouth. At the time of the district court's order, the panel opinion in BellSouth had not yet been vacated by our grant of rehearing en banc, and thus the district court relied in part on the panel opinion. BellSouth Advertising & Publishing Corp. v. Donnelley Info. Publishing, Inc., 933 F.2d 952 (11th Cir. 1991), vacated and reh'g en banc granted, 977 F.2d 1435

I. BACKGROUND

Warren Publishing, Inc. ("Warren"), compiles and publishes annually a printed directory called the Television & Cable Factbook ("Factbook"), which provides information on cable television systems throughout the United States. The Factbook contains two volumes, the "Station" volume and the "Cable and Services" volume. The focus of this case is the "Cable & Services" volume of the 1988 edition of the Factbook, and, in particular, the two sections of this volume entitled "Directory of Cable Systems" and "Group Ownership of Cable Systems in the United States." These sections are comprised of approximately 1,340 pages of factual data on 8,413 cable systems throughout the country and their owners.

The "Directory of Cable Systems" section contains extensive information on cable systems, including, inter alia, the name, address, and telephone number of the cable system operator, the number of subscribers, the channels offered, the price of service, and the types of equipment used. The entries in this section are arranged state by state in alphabetical order, and, within each state, all of the communities receiving cable television service are listed alphabetically. The "Group Ownership" section contains listings of selected information on "all persons or companies which have an interest in 2 or more systems or franchises." Factbook, Cable and Services Volume, at B-1301. The persons or entities listed in the group ownership section are known as multiple-system operators ("MSOs"), as contrasted with single-systems operators ("SSOs").

In the "Directory of Cable Systems" section, the factual data for each cable system is not printed under the name of each community that the cable system serves. The reason for this is that many communities are part of multiple-community cable systems, and it would be duplicative to list the same factual information under the individual community names for each community that comprises a multiple-community system. Therefore, a determination is made as to what community is the "principal" or "lead" (hereinafter "principal") community served by a particular cable system, and Warren prints the data only under the name of the principal community. Under the entries for the nonprincipal communities of a multiple-community cable system, there is a cross-reference to the principal community listing.[3] communities in north-central Georgia are cross-referenced to Atlanta in the 1988 Factbook: Alpharetta, Avondale Estates, Clarkston, College Park, Decatur, DeKalb County, East Point, Lithonia, Pine Lake, Sandy Springs, and Stone Mountain. In addition, Fulton County, although it has its own separate listing with factual data (since it is served by cable system different from that which serves Atlanta), also has a cross-reference that states "See also ATLANTA, GA." We infer from these listings that there are portions of Fulton County that are served by the cable system listed under the Fulton County heading, and that there are other portions of Fulton County served by the cable system listed under the Atlanta heading. The same holds true for DeKalb County, which is cross-referenced to both Atlanta and Chamblee, Georgia. We note that, in many cases, a cable system is a single-community system, and thus there is only one possible principal community.

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[3] For instance, in the Georgia section of the book, Atlanta is designated as a principal community, with the factual data for the cable system serving Atlanta and the surrounding areas listed under the Atlanta heading. There are, however, numerous other communities served by the same cable system that serves Atlanta; under the names of these communities, it says, "See ATLANTA, GA." The following

Microdos Data Corp. and Robert Payne ("Microdos") also market a compilation of facts about cable systems. Robert Payne is the principal officer and shareholder of Microdos. Microdos's compilation comes in the form of a computer software package called "Cable Access." The Cable Access program, like the Factbook, provides detailed information on both SSOs and MSOs. The district court described the format of Cable Access as follows:

> The Cable Access software package is broken into three databases. The first database provides information on the individual cable systems. This database is referred to as "the system database." The second database provides information on multiple system operators and is simply referred to as "the MSO database." The third database is a historical database which provides selected information on the cable industry from 1965 to the present. . . .
>
> Defendant's Cable Access software package comes pre-sorted by state and city. The customer may rearrange the data in a format of its choosing. The customer may construct searches of the database's information on cable systems as required to fit its particular needs, as well as output the data to a hard copy in various formats, again to fit the specific needs of the customer.

There is no dispute that Warren's Factbook predates the Cable Access program. Warren has been publishing cable television information since 1948, whereas Microdos began marketing Cable Access in 1989. Shortly after Warren became aware of the existence of the Cable Access software, it notified Microdos that it believed that the Cable Access program infringed its copyright in the Factbook.[4] In 1989, Microdos ceased marketing the original version of Cable Access, and, after some delay, began marketing a second version of Cable Access. Subsequently, a third and fourth version of Cable Access were marketed.

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[4] Warren registered its claim of copyright for the 1988 Factbook in July of 1988, and, in November of that year, the United States Copyright Office issued Warren a Certificate of Copyright Registration. Moreover, Warren annually registers its claim of copyright in the newest edition of the Factbook, and has been doing so since it began publishing the Factbook. It is not disputed that the Factbook as a whole is a factual compilation that is entitled to copyright protection. What is in dispute is whether Warren's method of presentation of facts under the principal community headings, with cross-references to the other communities served by that MSO, is entitled to copyright protection. As the Supreme Court held in Feist, the only protectable elements of a factual compilation are a compiler's selection, arrangement, or coordination, and these elements are protectable only if they possess the requisite originality. Feist, 499 U.S. at 348, 111 S. Ct. at 1289, 113 L. Ed. 2d 358; see also Bell South, 999 F.2d at 1440.

In July of 1990, Warren filed suit against Microdos, alleging copyright infringement and unfair competition.[5] Warren alleged that all four versions of Cable Access infringed upon its compilation copyright in the 1988 Factbook. Microdos counterclaimed for defamation and trade disparagement, tortious interference with contractual relations, and violations of Section 2 of the Sherman Act, based on Warren's alleged attempt to monopolize. Warren contended that Microdos infringed its compilation copyright in the Factbook in three areas: (1) the communities covered/principal community system, (2) the data fields, and (3) the data field entries. Following discovery, Warren and Microdos each moved for partial summary judgment on these three copyright infringement issues. With respect to the data fields issue, the district court found that Microdos had not infringed Warren's data field format.[6] With respect to the data field entries issue, the district court found that these entries were uncopyrightable facts, and therefore Warren's "sweat of the brow" argument on this issue could not prevail in light of the Supreme Court's Feist decision.[7] Accordingly, the district court entered partial summary judgment for Microdos on these two issues.

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[5] In its complaint, Warren does not allege that the Cable Access program as a whole infringes its copyright in the Factbook. Rather, it is only the "system database" and the "MSO database" of the Cable Access software that Warren alleges infringes its compilation copyright.

[6] The district court found that Warren's selection of its data fields was not sufficiently original to warrant copyright protection. As for the Factbook's coordination and arrangement of the data fields, the district court found that this was sufficiently creative and original to warrant copyright protection, but that Microdos's coordination and arrangement was not substantially similar to that of the Factbook. Therefore, the district court granted Microdos's motion for summary judgment on the data fields infringement issue, and denied Warren's cross-motion for summary judgment on the same.

[7] Thus, the district court granted Microdos's motion for summary judgment on the data field entries infringement issue and denied Warren's cross-motion for summary judgment on that issue.

The district court, however, reached a different conclusion on the communities covered issue. It found that the principal community system utilized by Warren in presenting the data on cable systems in its Factbook was "sufficiently creative and original to be copyrightable." R4-36-11 (footnote omitted). The district court then analyzed the selection of communities employed by Microdos and found it to be "substantially similar" to that of Warren.[8] Id. at 12-17. Based on this finding, and its conclusion that Microdos failed to prove that it obtained its information from a source independent of the Factbook, the district court denied Microdos's motion for summary judgment on the principal community system and granted Warren's cross-motion on that issue.[9] The district court subsequently denied Microdos's motion for reconsideration of the order and granted Warren's motion for a "permanent" injunction.[10] The court "enjoined

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[8] The parties stipulated to the use of Illinois as a test or representative state for the purpose of the substantial similarity analysis. Counsel for both sides agreed that the data records produced during discovery were most complete as to Illinois, and thus Illinois provided a common factual ground for the parties to present their respective arguments. In addition, they agreed that the Illinois section of the Factbook fairly represented the factual circumstances throughout the Factbook. Given the voluminous listings in the Factbook, we think that it was wise for the parties to limit the substantial similarity analysis to one representative state and have no doubt that limiting the analysis to Illinois has in no way restricted the parties' ability to present all of the legal issues relevant to the infringement issue.

[9] Microdos filed a motion for reconsideration of the district court's grant of summary judgment in favor of Warren on the principal community system issue. The district court denied this motion and granted Warren's motion for permanent injunction and impoundment of the infringing materials. Microdos permanently was enjoined from violating Warren's copyright in the Factbook "through the use, copying, distribution or selling of any version of [their] Cable Access products." R4-42-4. In addition, Microdos was directed to turn over to the clerk of the district court "all copies of and materials used to make any version of [their] Cable Access database products." Id. Microdos complied with this order, turning over in excess of 20,000 pages of documents and research materials used to make its Cable Access product.

[10] Because no final judgment was entered by the district court, the

[Microdos] from violating [Warren's] copyright of the Factbook through the use, copying, distribution or selling of any version of [Microdos's] Cable Access products." R6-42-4. Microdos appeals the interlocutory order granting the injunction.[11]

II. DISCUSSION

Microdos argues that the district court improperly granted Warren's motion for an injunction based on an erroneous ruling of law. As a predicate for injunctive relief, the district court granted Warren's motion for partial summary judgment on the principal community system issue. Microdos contends that the district court erred, as a matter of law, in finding the principal community system protectable under copyright law.

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injunction is by law a preliminary injunction. See supra note 1.

[11] The judgment of the district court was affirmed by a panel of this court, but that panel decision was subsequently vacated by a grant of rehearing en banc. Warren Publishing, Inc. v. Microdos Data Corp., 52 F.3d 950 (11th Cir.), vacated and reh'g en banc granted, 67 F.3d 276 (11th Cir. 1995).

A. Review of Relevant Statutory Provisions and Case law

Because copyright law is principally statutory, we begin our analysis with a review of the pertinent statutory provisions. In this case, we are dealing with a compilation, which the Copyright Act of 1976 (the "Act") defines as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship."[12] 17 U.S.C. § 101 (emphasis added). Section 102 of the Act provides that "[c]opyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." 17 U.S.C. § 102(a) (emphasis added). As a limiting principle, the Act states that "[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work." 17 U.S.C. § 102(b).[13]

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[12] The phrase "as a whole" is highly relevant to our analysis of the originality and creativity of Warren Publishing's selection. "Evaluation of the originality [and creativity] of selection should focus on the selection as a whole." Jane C. Ginsburg, No "Sweat"? Copyright and Other Protection of Works of Information After Feist v. Rural Telephone, 92 Col. L. R. 338, 348 (1992). The dissent takes the position that original selection is present in Warren Publishing's selection of "principal communities" as a means of organizing the data although the data included in the compilation represent the entire universe of cable television systems. The dissent's interpretation ignores the cross-referencing to all cable television systems in the compilation and, more importantly, fails to give meaning to the statutory phrase "as a whole."

[13] The dissent takes exception to the characterization of section 102(b) as a "limiting principle." Dissent at 23. The dissent attempts to support this argument by making the unarguable points that section 102(b) is a codification of the idea/expression dichotomy and that use of the term

The Supreme Court, in its most recent decision focusing on compilation copyrights, noted that "[t]he sine qua non of copyright is originality." Feist, 499 U.S. at 345, 111 S. Ct. at 1287, 113 L. Ed. 2d 358. The Court emphasized that originality is a constitutional requirement, noting that the Constitution "authorizes Congress to 'secur[e] for limited times to Authors . . . the exclusive Right to their respective Writings.'" Id. at 346, 111 S. Ct. at 1288, 113 L. Ed. 2d 358 (quoting U.S. Const. art. I, § 8, cl. 8).[14] The Court also admonished that:

> Facts, whether alone or as part of a compilation, are not original and therefore may not be copyrighted. A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves.

Id. at 350, 111 S. Ct. at 1290, 113 L. Ed. 2d 358 (emphasis added).

"idea, procedure, process, system, method of operation, concept, principle, or discovery" to characterize expression does not itself preclude copyrightability. Even given these unarguable points, Section 102(b), nonetheless, is a limiting principle and is "universally understood to prohibit any copyright in facts." Feist, 499 U.S. at 356, 111 S. Ct. at 1293, 113 L. Ed. 2d 358. Of course, section 102(b) does more than prohibit facts from being copyrighted; it emphasizes that copyright protection does not extend to ideas procedures, processes, systems, methods of operation, concepts, principles, or discoveries. Thus, if the expression is characterized as a "system," for example, it is not copyrightable if the characterization is accurate.

[14] The terms "authors" and "writings" as used in the Constitution have been interpreted definitively by the Supreme Court to "presuppose a degree of originality." Feist, 499 U.S. at 346, 111 S. Ct. at 1288, 113 L. Ed. 2d 358.

Thus, the compiler's choices as to selection, coordination, or arrangement are the only portions of the compilation that arguably are even entitled to copyright protection. As the Feist Court noted, these choices must be made "independently by the compiler and entail a minimal degree of creativity"[15] in order to be entitled to compilation copyright protection. Id. at 348, 111 S. Ct. at 1289, 113 L. Ed. 2d 358. The Feist Court further explained:

This protection is subject to an important limitation. The mere fact that a work is copyrighted does not mean that every element of the work may be protected. Originality remains the sine qua non of copyright; accordingly, copyright protection may extend only to those components of a work that are original to the author.

Id. Given these limitations on the scope of copyright protection in a factual compilation, it is abundantly clear that "copyright in a factual compilation is thin." Id. at 349, 111 S. Ct. at 1289, 113 L. Ed. 2d 358.[16] Only when one copies the protected selection, coordination, or arrangement in a factual compilation has one infringed the compilation copyright;

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[15] The Supreme Court further clarified that "a minimal degree of creativity" requires "more than a de minimis quantum." Feist, 499 U. S. at 363, 111 S. Ct. at 1297, 113 L. Ed. 2d 358.

[16] There are three types of work that are entitled to copyright protection -- creative, derivative, and compiled. Copyrights in these three distinct works are known as creative, derivative, and compilation copyrights. An example of a creative work is a novel. An example of a derivative work is a screenplay based on a novel; it is called "derivative" because it is based on a preexisting work that has been recast, transformed, or adapted. An example of a compilation is Warren's Factbook. The Act has created a hierarchy in terms of the protection afforded to these different types of copyrights. A creative work is entitled to the most protection, followed by a derivative work, and finally by a compilation. This is why the Feist Court emphasized that the copyright protection in a factual compilation is "thin." 499 U.S. at 349, 111 S. Ct. at 1289, 113 L. Ed. 2d 358.

copying of the factual material contained in the compilation is not infringement.[17]

B. The Principal Community System Employed by Warren

To establish its claim of copyright infringement, Warren must prove "(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original." Feist, 499 U.S. at 361, 111 S. Ct. at 1296, 113 L. Ed. 2d 358. The first element is not at issue here, because Microdos does not contest that the Factbook, considered as a whole, is entitled to copyright protection.[18] To prove the second element, Warren must demonstrate that Microdos, by taking the material it copied from the Factbook, appropriated Warren's original selection, coordination, or arrangement. See BellSouth, 999 F.2d at 1441.

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[17] This point is emphasized in section 103(b) of the Act, which states that "[t]he copyright in a compilation or derivative work extends only to the material contributed by the author to such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material." 17 U.S.C. § 103(b).

[18] Microdos does strongly challenge, however, the district court's finding that Warren's system of selection of principal communities is copyrightable.

The district court found that Warren's coordination and arrangement of the communities listed in the Factbook was "an obvious, mechanical, or routine task which required no creativity," and thus concluded that "the coordination and arrangement of the communities selected is not copyrightable." R4-36-11. That holding is not at issue on appeal. The district court, however, agreed with Warren that "the selection of those communities was creative and protectable because Warren uses a unique system in selecting the communities that will be represented in the Factbook." Id. This system, so concluded the district court, was "sufficiently creative and original to be copyrightable." Id. (footnote omitted). The district court then employed "substantial similarity" analysis,[19] concluding that Microdos's selection of communities was substantially similar to that of Warren and therefore infringed Warren's compilation copyright.[20] Based on this finding, the district court entered summary judgment for Warren on the principal community selection issue.

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[19] The test for infringement of copyrighted works is one of "substantial similarity." As the Second Circuit has noted, the substantial similarity inquiry is "narrowed" when dealing with a compilation. Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc., 945 F.2d 509, 514 (2d Cir. 1991). It explained that "the components of a compilation are generally in the public domain, and a finding of substantial similarity or even absolute identity as to matters in the public domain will not suffice to prove infringement." Id. Therefore, "[w]hat must be shown is substantial similarity between those elements, and only those elements, that provide copyrightability to the allegedly infringed compilation." Id. (emphasis added).

[20] The district court found that there was a greater than 90% correlation between the principal communities in the Illinois section of the Factbook and the communities listed in the Illinois section of the Cable Access software. The district court compared all four versions of Cable Access with the Factbook and found the correlation to range from 91.85% to 94.85%. R4-36-13-14.

On appeal, the only issue before us is whether the district court abused its discretion in granting a preliminary injunction based on an erroneous ruling on the principal selection issue. We review the district court's grant of a preliminary injunction for abuse of discretion. Zardui-Quintana v. Richard, 768 F.2d 1213, 1216 (11th Cir. 1985). The district court abuses its discretion when it grants a preliminary injunction in spite of the movant's failure to establish "(1) a substantial likelihood that [the movant] will ultimately prevail on the merits; (2) that [the movant] will suffer irreparable injury unless the injunction issues; (3) that the threatened injury to the movant outweighs whatever damage the proposed injunction may cause the opposing party; and (4) that the injunction, if issued, would not be adverse to the public interest." Id. Because we conclude that Warren failed to establish a substantial likelihood of success on the merits, we need not address the additional elements required for a preliminary injunction.

The district court found that "Warren has developed a system for selecting communities which is original in the industry. This selection process represents a part of the format of the compilation which is copyrightable." R4-36-16 (emphasis added). Since the district court concluded that Microdos had "substantially appropriated the copyrightable selection of communities portion of the format of Warren's Factbook," it held that "Microdos ha[d] infringed Warren's copyright in the Factbook." R4-36-30. The district court was correct in employing "substantial similarity" analysis once it concluded that Warren's system for selecting communities was copyrightable. Where it erred, however, was in concluding that Warren's system of selection was copyrightable in the first place.[21]

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[21] Since the district court erred in finding that Warren's system of selection was copyrightable, the substantial similarity analysis was unnecessary, for even verbatim copying of uncopyrightable matters is not infringement. As we noted in BellSouth, in the case of a factual

1. Warren's "System" of Selection

Section 102(b) of the Copyright Act specifically excludes "any idea, procedure, process, system, method of operation, concept, principle, or discovery" from copyright protection "regardless of the form in which it is described, explained, illustrated, or embodied in such work." 17 U.S.C. § 102(b) (emphasis added). Nonetheless, the district court concluded that Warren's "system" of selecting communities was original and entitled to copyright protection. R4-36-16. This conclusion is contrary to the plain language of 17 U.S.C. § 102(b), and is clearly incorrect.[22] If Warren actually does employ a system to select the communities to be represented in the book, then section 102(b) of the Act bars the protection of such a system.

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compilation, the original elements of the compiler's work are compared with the corresponding elements of the putative infringer's work. 999 F.2d at 1445. In this case, Warren's system of selecting principal communities is not copyrightable; therefore, comparing this uncopyrightable selection with Microdos's system of selecting communities is pointless.

[22] The dissent is correct in arguing that use of the term "system" does not itself preclude copyrightability under section 102(b). Rather, because the characterization is accurate, Warren's "system" is not copyrightable because it is a system and systems are excluded from copyright protection under section 102(b).

Even if we were to assume that the district court incorrectly denominated Warren's selection of communities as a "system," such an assumption would not validate the district court's finding of copyrightability. Warren contends that it has a unique method of choosing which communities to include in its directory, based on its "principal community" system. Warren defines a "cable system" as an entity offering subscribers in one or more communities the same cable services for the same price. As the district court found, "[t]he principal community, used to represent the entire cable system, is then selected by contacting the cable operator to determine which community is considered the lead community within the cable system. Other communities within the same cable system are then listed under the principal community, not independently."[23] R4-36-10. The Federal Communication Commission ("FCC"), unlike Warren, does not use a principal community system; rather, it lists individually every geographical community having cable service. As a result, if there are five communities served by one "cable system," Warren would list the system's data under the principal community name, and there would be cross-references under the listings of the names of the other four communities. The FCC, on the other hand, would list the data on all five communities separately.[24]

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[23] The district court's finding on this matter is inaccurate. Each community served in each state is listed separately in the Factbook; the principal community designation eliminates the need for Warren to reprint duplicative factual information about a cable system under every community that is part of the multiple-community system. Instead, under the nonprincipal community headings, it has a cross-reference in order to inform the reader of the principal community heading for that particular cable system. This directs the user where to find the factual data for a particular cable system. What the district court may have been attempting to explain is that in the Factbook, under the principal community listing, there is included an "also serves" entry, in which the names of all of the nonprincipal communities served by that multiple-community system are listed. This list identifies all of the communities that are cross-referenced to the principal community listing.

[24] In many instances, Warren's "system" and the FCC's community list

At oral argument, Warren asserted, and the dissent agrees, that the district court was correct in finding that Warren is entitled to copyright protection in its "selection" of communities, which is based on its putatively unique definition of a cable system. The problem with this is that Warren does not undertake any "selection" in determining what communities to include in the Factbook. Warren claims that its system of listing communities does not include the entire universe of cable systems, and thus there is "selection" involved as to which communities they include in their Factbook. This assertion, however, is plainly wrong.

The district court found that the FCC, which attempts to list individually every community across the country with a cable system, had 724 communities listed for Illinois. R4-36-12. Warren, it observed, listed 406 communities under its principal community concept. Id. It did note that "[n]umerous additional communities were listed under the various principal communities," but stated that they were not separately listed.[25] Id. Given that Warren did not list all of the communities that the FCC did, the district court concluded that Warren did "select" which communities to include in the Factbook, and thus its selection was copyrightable. In an unintentionally prescient footnote, however, the district court noted that :

This is not to say that the selection of cable systems would be copyrightable in all cases. Had Warren selected every cable system listed by the F.C.C., then there would not be sufficient originality in the "selection" to warrant copyrightability.

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are identical, for if a "system" only serves one community, then there is only one possible place to list the data.

[25] This is an inaccurate statement. Every community in the Factbook is listed separately, state by state, in alphabetical order. What is not listed separately under each community name is the factual data about the cable system serving that particular community -- this data is listed under the principal community listings only.

Id. at 11 n.9. Yet, this is precisely what Warren did. The district court made the mistake of comparing the number of principal communities listed with the number of individual communities listed by the FCC. Given the way the principal community system works, however, that is like comparing apples to oranges. The proper method is to compare the 724 individual communities listed by the FCC for Illinois with the total number of communities listed by Warren for Illinois; in other words, include not only the principal communities listed, but also those that are listed and are cross-referenced to one of the 406 principal communities. Our count of the total number of communities listed for Illinois by Warren, both principal and nonprincipal, is approximately 1,000. Therefore, Warren seems to have included not only all that the FCC listed, but also some others that the FCC did not.[26]

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[26] A likely explanation for this numerical disparity is that Warren lists not only names of towns, villages, and cities, but also townships and counties. Therefore, this results in a greater number of listings than the FCC, which seems to list by town, city, or village name only. These additional listings in the Factbook are cross-referenced to the principal community for the area, but they are nonetheless individually listed by Warren, albeit with a one-line entry.

The Second Circuit has noted that "[s]election implies the exercise of judgment in choosing which facts from a given body of data to include in a compilation." Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc., 945 F.2d 509, 513 (2d Cir. 1991). In Key Publications, the record indicated that the compilation copyright holder did not include the entire relevant universe in her directory; she testified that she chose to exclude certain businesses based on her belief that they would not remain open for very long. As the court noted, "[t]his testimony alone indicates thought and creativity in the selection of businesses included in the 1989-90 Key Directory." Id. Warren, to the contrary, has failed to make such a showing in this case. It did not exercise any creativity or judgment in "selecting" cable systems to include in its Factbook, but rather included the entire relevant universe known to it. The only decision that it made was that it would not list separately information for each community that was part of a multiple-community cable system; in other words, it decided to make the Factbook commercially useful. Therefore, it cannot prevail in its claim that it "selected" which communities to include in its Factbook.[27] The district court

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[27] On an alternative ground, Warren's claim of copyright in its selection of communities does not survive application of the merger doctrine. "Under the merger doctrine, 'expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself.'" BellSouth, 999 F.2d at 1442 (quoting Kregos v. Associated Press, 937 F.2d 700, 705 (2d Cir. 1991)). If Warren were given protection in its principal community system, the concept of cross-referencing would be subsumed in its copyright. The idea of organizing by principal community yields very few ways, if not only one way, of expressing the data. Each SSO has only one principal community. Each MSO has one obvious principal community. For the compilation to be convenient and useful, not repetitive and onerous, however, the nonprincipal communities in each MSO must be cross-referenced to the principal community with the data listed only under the principal community. The people for whom the Factbook and similar products are produced are not interested in having information repeated under every community served by a multiple-community system. Consequently, expression of the principal community selection has merged

erred in determining that Warren's system of selecting communities was copyrightable.

2. The Originality Requirement

Even were we to assume that the presentation of the selection of principal communities made by Warren was creative and original and therefore copyrightable, its claim that it is entitled to protection would nonetheless fail, because the selection is not its own, but rather that of the cable operators. The district court found that the principal community was "selected by contacting the cable operator to determine which community is considered the lead community within the cable system." R4-36-10. As we observed in BellSouth, "these acts are not acts of authorship, but techniques for the discovery of facts."[28] 999 F.2d at 1441.

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with the idea, and thus the selection of principal communities is uncopyrightable.

[28] The dissent takes several opportunities to describe in substantial detail Warren's "acts of selection." Dissent at 4-7, 14, 17. It should be noted, however, that analysis of the compiler's acts of selection is relevant only to determine whether the compiler exercised any individual judgment that is equivalent to creativity. See BellSouth, 999 F.2d at 1441. The industriousness of the collection is not relevant to a determination of copyrightability. Feist, 499 U. S. at 359-60, 111 S. Ct. at 1295, 113 L. Ed. 2d 358. "The fact that a finding of creativity is subjective often means the court can apply a 'sweat' recognition of the developer's labor and ignore the creativity requirement." Charles Von Simson, Note, Feist or Famine: American Database Copyright as an Economic Model for the European Union, 20 Brook J. Int'l. L. 729, 768 (1995). The court in this opinion, as in BellSouth, does not succumb to the urge to allow industrious collection to substitute for creativity.

In BellSouth, a case involving a "yellow pages" classified business directory, we held that Donnelley Information Publishing, Inc. ("Donnelley"), "[b]y copying the name, address, telephone number, business type, and unit of advertisement purchased for each listing in the BAPCO [BellSouth Advertising & Publishing Corporation] directory . . . copied no original element of selection, coordination or arrangement," and thus Donnelley was entitled to summary judgment on BAPCO's copyright infringement claim.[29] Id. at 1446. The en banc court stated that "[w]hile BAPCO may select the headings that are offered to the subscriber, it is the subscriber who selects from those alternatives the headings under which the subscriber will appear in the directory. The headings that actually appear in the directory thus[] do not owe their origin to BAPCO . . . ." Id. at 1444. In this case, Warren employed a method similar to that of BAPCO in "selecting" the principal community heading under which to list the data for the multiple-community systems.[30]

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[29] The dissent questions the wisdom of this court's en banc decision in BellSouth. Dissent at 22 n.6. The dissent notes "considerable criticism" of the opinion and cites a student note to show support for this contention. Dissent at 22 n.6. Another student note, however, considered the en banc decision to be consistent with Feist, stating that "[t]he first appellate decision demonstrate[d] the way sympathy for the effort expended by the compiler will lead some courts to find creativity in anything. The second appellate decision exemplifie[d] proper application of Feist's creative selection." Von Simson, 20 Brook. J. Int'l L. at 748.

[30] As noted before, in the case of a single-community system, there is only one community served and therefore only one possible principal community. Thus, no argument can be made regarding the selection of the principal community in the case of a single-community system. The record shows that in the Illinois section of the Factbook, approximately fifty-five percent of the principal communities are single-community systems. For the remaining principal communities, which are all part of multiple-community systems, Microdos contends that over two-thirds of them are simply the community in the multiple-community system that, according to FCC records, has the highest number of subscribers. En Banc Brief of Appellants at 37-38. Warren cannot make any tenable argument regarding selection in these instances either, given that their "selection" is nothing more than discovery of facts that are contained in the publicly-available

Lynn Levine, the Director of Market Research and Data Sales for Warren, stated in her deposition that Warren determines the names of the communities served by a cable system by contacting the operators of the cable systems and asking them which communities they serve. Levine dep. at 53. In addition, she stated that Warren, in gathering data for the Factbook, relied in "great part" on the questionnaire responses received from the various cable operators. Id. at 35. These acts are nothing more than techniques for the discovery of facts. Simply because Warren may have been the first to discover and report a certain fact on cable systems does not translate these acts of discovery into acts of creation entitled to

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FCC records. The dissent seems to argue that creativity exists because the principal community could be determined in more than one way. Specifically, the cable system operators could be contacted to identify their principal communities or the principal community could be determined by external factors, like the number of subscribers. Dissent at 15-16. The dissent ignores the fact that these methods are likely to identify the same principal community -- without necessitating any judgment on the part of Warren. For example, a cable operator is likely to designate its principal community as the community with the most subscribers.

copyright protection.[31] See Feist, 499 U.S. at 347, 111 S. Ct. at 1288, 113 L. Ed. 2d 358 (distinguishing creation from discovery). "Just as the Copyright Act does not protect 'industrious collection,' it affords no shelter to the resourceful, efficient, or creative collector." BellSouth, 999 F.2d at 1441.

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[31] For a compilation to be creative, and hence copyrightable, the compiler must exercise individual judgment. Key Publications, 945 F.2d at 513. The dissent makes much of the fact that Warren was the first to organize a comprehensive directory of cable systems by principal community rather than by discrete community that represented the franchising entity. The dissent suggests that Warren newly defined the industry because the industry originally developed around these franchising entities. Dissent at 2. The evolution of the industry, however, did not develop around franchising units but around geographically distinct areas. The Supreme Court in Turner Broadcasting Systems, Inc. v. F.C.C., ___ U.S.___, 114 S. Ct. 2445, 129 L. Ed. 2d 497 (1994) reviewed the development of the industry: "The earliest cable systems were built in the late 1940's to bring clear broadcast television signals to remote or mountainous communities. The purpose was not to replace broadcast television but to enhance it." Id. at ___, 114 S. Ct. at 2451, 129 L. Ed. 2d 497. Thus, although acknowledging that cable systems depended on the express permission of local governing authorities since "[t]he construction of th[e] physical infrastructure entail[ed,] the use of public right-of way and easements, the Supreme Court recognized that geography and population, rather than franchising entities, influenced the location and extent of early cable television systems. Even if the industry was newly defined, as the dissent contends, when Warren organized cable systems under principal communities, however, the creative element is still lacking in Warren's compilation. The mere discovery of an organizing principle which is dictated by the market is not sufficient to establish creativity. "The distinction is one between creation and discovery: The first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence." Feist, 499 U. S. at 347, 111 S. Ct. at 1288, 113 L. Ed. 2d 358. The same can be said for an organizing principle like the "principal community." Thus, even if Warren discovered the existence of the principal community as an organizing concept, Warren did not create this organization.

The record indicates that it is the cable operators, not Warren, that determine, in the case of a multiple-community system, the community name under which to list the factual data for the entire cable system. Therefore, Warren cannot prevail in its claim that it undertakes original selection in employing the principal community concept. Rather, it has created an effective system for determining where the cable operators prefer to have the data listed. While Warren may have found an efficient method of gathering this information, it lacks originality, which is the sine qua non of copyright. See Feist, 499 U.S. at 345, 111 S. Ct. at 1287, 113 L. Ed. 2d 358. Thus, the district court erred in finding that Warren's principal community "system" was sufficiently creative and original to be entitled to copyright protection.

III. CONCLUSION

The district court erred in granting Warren a preliminary injunction based on its erroneous ruling on the principal community selection issue. Although the record indicates that Microdos's choices as to where to list the factual data on cable systems had an extremely high correlation with Warren's principal community listings, Microdos copied no original selection, coordination, or arrangement of Warren's factual compilation. Warren thus failed to show a substantial likelihood of success on the merits. We therefore VACATE the preliminary injunction entered by the district court and REMAND for proceedings consistent with this opinion.

GODBOLD, Senior Circuit Judge, dissenting, in which HATCHETT, Chief Judge, and BARKETT, Circuit Judge, join:

The district court understood this case. It held that Warren's compilation of selected data concerning cable television operations, in the form of data-reporting units with each unit named for a principal community within the unit, was original and creative. Its decision should be affirmed.

I. Introductory

The Copyright Clause of the Constitution provides that Congress has the power to secure to authors "the exclusive Right to their respective Writings." U.S. Const. art. I, § 8, cl. 8. Therefore originality -- authorship -- is a constitutional requirement. By 17 U.S.C. § 102 Congress provided for copyright protection to original works of authorship. 17 U.S.C. § 103 provides that § 102 includes compilations. 17 U.S.C. § 101 defines compilation:

> A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.

Thus, originality is also a statutory requirement.

Warren's compilation was held by the district court to be protected as an original work of authorship "selected" pursuant to § 101. It is a work containing data on cable television operations nationwide, issued annually in book form, entitled Television and Cable Factbook, and the volume in question is the 1988 edition. It contains collected data selected and assembled into reporting units each of which comprises a functional "cable system," which Warren defines as: "an entity composed as one or more communities that are offered the same service by the same cable system owner at the same price." Each "cable system" bears the name of a "lead" or "principal" community within the system. That name identifies the cable system, and data for the system is presented under that name.[32] To simplify the evidence the parties have accepted that evidence concerning cable television operations in the state of Illinois is representative.

Understanding Warren's compilation, and this case, requires one to understand that cable television service exists by authority of franchises granted by organized governmental units, usually cities and counties. The district court found how, prior to Warren's work, the various compilers of industry data commonly compiled and arranged information concerning cable television operations:

Warren Publishing admits that the cable system information coordinated and arranged by the various compilers in the industry is commonly organized alphabetically by state and then alphabetically by community within the states.

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32 As the district court succinctly put it, "how one defines a 'cable system' will dictate the communities selected to represent those systems [i.e., the principal communities]." Dis Ct. op. p. 10.

Dis. Ct. op. p. 10. This common form of organizing and presenting data is not surprising since franchises to operate sprang from discrete communities. Moreover, this accords with Federal Communications Commission definitions. FCC defines a "cable television system" as a facility that provides cable service to subscribers "within a community." 47 C.F.R. § 76.5(a). Also, it defines a "cable television system" as one that "operates . . . within a separate and distinct community." 47 C.F.R. § 76.5(dd). Type and extent of service, rates, commonality of service with other communities, and sharing of facilities or equipment or staff or management are not elements of FCC definitions of cable systems. As the industry developed innumerable new cable operations were franchised and activated, some contiguous to existing franchises, others disassociated and far distant from previously franchised communities, some operators with a single franchise, others with more than one. Over time cable operations were sold, merged, expanded in area, mechanical equipment was shared, and staff and servicing combined or shared. Geographic areas of service changed. But the industry norm for selecting and presenting data remained the community.

Against this background one must examine what, in a general sense, a compiler does and, in a specific sense, what Warren as compiler did. The creator of a compilation responds to a perceived need for information, and that response may be a highly creative act but at this initial stage it is only an idea and clearly not copyrightable. William S. Strong, Database Protection After Feist v. Rural Telephone Co., 42 J. Copyright Soc'y U.S.A. 39, 47 (1994). Responding to the perceived need the compiler must choose the facts it wants and devise a framework for the data to be assembled, which includes formulating rules and identifying categories that may be highly selective but are not necessarily so. Id. Categories desired may be limited or dictated by their utility or

by the marketplace and hence involve no originality, or they may be original to the compiler. It is at this identification/formulation of categories stage that the compiler moves from uncopyrightable idea to acts of selection that are the expression of his ideas.

Warren grasped the "perceived need for information" reflecting the present nature of the cable television industry and the past practices of the industry for selecting and presenting data. It then chose the facts it wanted to compile. The Supreme Court has recognized this choice of facts as part of a compiler's authorship: "The compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers." Feist Publications, Inc. v. Rural Service Co., Inc., 499 U.S. 340, 348 (1991). See also Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc., 945 F.2d 509, 513 (2d Cir. 1991), "Selection implies the exercise of judgment in choosing which facts from a given body of data to include in a compilation."

At the initial stage of choosing the facts that it wanted Warren moved from idea to intellectual expression through selection. The selection of facts it wanted were not the facts that previously the industry had compiled in terms of community. Rather Warren chose to select and present facts that reflected the way the industry is currently actually operating. Its choice was reflected in functional service/operations/management terms. The building block, the data-reporting unit, for selection and presentation of industry data was the "cable system" as newly defined by Warren, "an entity composed as one or more communities that are offered the same service by the same cable system owner at the same price." Warren had, as Strong, supra, has described it, devised a framework for the data to be assembled and had formulated selective rules and categories. Reporting data by a functional unit was a new and original concept, and the implementing definition of "cable system" was new to the industry and crafted by Warren.

Next, it was necessary for Warren to define and identify the universe of raw data from which it would select and present information. It chose a universe composed of all geographic communities (in the state of Illinois, the representative state) having cable television service. This defined universe was itself new. It consisted of 1,000 plus geographic communities (1,017 by one count, 1,045 by another). It included cities, towns, and villages, and also included counties and townships, which historically were not usual franchise-granting units. The FCC maintained its own list of cable systems (as it defined them), composed of cities, towns and villages, that is, franchise-granting units. FCC's universe was 724 communities. Warren's functional/operational definition swept in non-franchising geographic areas receiving service. Its universe of raw data was thus new in concept and some 40% larger in number of communities than the FCC universe.

As its next step Warren identified and selected from its universe 406 data-reporting units in Illinois, each a "cable system" pursuant to its functional definition. Then, drawing from the 1,000 plus universe, Warren had to identify and properly locate within the proper unit of the 406 each geographic community enjoying cable service. More than half of the 406 Illinois cable operations turned out to be single-system operations (SSO's), that is, each served only a single community. A multiple community system (MSO) served more than one community. Each SSO, because of its singularity, fell within Warren's same operator/same service/same price definition of a cable system. The name under which its data was presented was necessarily that of the single community it served. Having located within the proper cable system (MSO or SSO) each community served, for MSO's Warren had to merge or combine the operating data for each community into one unitary body of operating data to be reported for the system. Data relating to each geographic community served was no longer independently listed community-by-community but instead was included in the unitary system data. The name of an individual (nonprincipal) geographic community whose service was operated and managed as part of a cable system appeared but without data and was cross-referenced to the system where its data was included in the unitary data. This referencing was necessary, of course, because data-reporting was unitary rather than individual.

As part of Warren's acts of selection it was necessary for it to choose a name by which each cable system would be listed and identified and under which the system data would be set out. For this purpose Warren elected to use a geographic name, and the type of geographic name it chose was that of the "lead" or "principal" geographic community within the system. Obviously, for an SSO the name of the single community served was selected. When these acts were concluded Warren's selection (406 units) consisted of 45% fewer data-reporting units than the FCC's listing of 724.

II. Originality and creativity

We are faced in this case with what Feist described as the "undeniable tension" between two well-established propositions -- that facts themselves are not copyrightable but compilations of facts generally are. 499 U.S. at 344-45. A compilation draws its originality from its selection and arrangement.

Factual compilations, on the other hand, may possess the requisite originality. The compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers. These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws. Nimmer § § 2.11[D], 3.03; Denicola 523, n. 38. Thus, even a directory that contains absolutely no protectable written expression, only facts, meets the constitutional minimum for copyright protection if it

features an original selection or arrangement. See Harper & Row, 471 U.S., at 547, 105 S.Ct., at 2223. Accord, Nimmer § 3.03.

Id. at 348. The originality necessary to render Warren's work copyrightable lies in its selection of data as provided by § 101. The selection must be done "in such a way" that it possesses the necessary originality.

What does "originality" mean? The selection must be made independently by the compiler, not copied, and must owe its origin to the author. Novelty is not required. But selection must entail a minimal degree of creativity.[33]

How much originality is required? Feist tells us: "a modicum of intellectual labor," 499 U.S. at 347; "independent creation plus a modicum of creativity," id. at 346; "at least some minimal degree of creativity," id. at 345; "the requisite level of creativity is extremely low; even a slight amount will suffice," id. at 345. Nimmer expresses the degree of originality this way:

It has been said that all legal questions are in the last analysis questions of degree, requiring judicial line drawing. Certainly, copyright law is replete with such questions. The determination of the quantum of originality necessary to support a copyright presents such a question. It is not, however among the more troublesome questions of degree inherent in copyright law, as the line to be drawn includes almost any independent effort on the side of sufficient originality.

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[33] It is of only semantic significance whether originality is defined as embodying creativity or whether creativity is regarded as a necessary adjunct to originality. But it is clearer to refer to them as separate elements. Nimmer, § 201[B], p. 2-15.

Melville B. Nimmer and David Nimmer, Nimmer on Copyright § 2.01 [B], at 2-13 (1996). And

> [O]riginality for copyright purposes amounts to . . . little more than a prohibition of actual copying.

Nimmer, § 2.01B[, p. 2-14 (quotes and internal quotes omitted). Accord, Key Publications, supra, at 513.

Warren's selection entails more than the required degrees of originality and creativity. Warren saw the need, chose the facts it wanted to compile, chose how it wanted to arrange them in gathering points for data rather than by individualized presentations. It employed a new concept of gathering cable data into a smaller number of units and, for this purpose, it devised a new concept of a cable system as functionally defined and a new concept (and new title) of "principal community." It is sufficient if there is a "small spark of distinctiveness," but this is no small spark. It is a fundamental change in reporting data of a changing and developing industry. The fact that some of the data-reporting units were SSO's does not diminish the fact of Warren's acts of selection or of the originality and creativity of the selection, which required Warren to determine whether each of the 1,000 plus systems was a single community system (SSO) or part of a multiple community system (MSO) and to assemble and report system data accordingly.

Along with originality of selection and arrangement is a related but different requirement. The Constitution authorized protection of the work of an author. The claimant to copyright protection must be an author, not a mere discoverer of facts.

No one may claim originality as to facts. Facts may be discovered, but they are not created by an act of authorship. One who discovers an otherwise unknown fact may well have performed a socially useful function, but the discovery as such does not render him an 'author' in either the constitutional or statutory sense.

Nimmer, § 2.11[A], p. 2-172.16 (footnotes omitted). But by hypothesis a compiler collects and assembles the work of others, and his compilation is a "work formed by the collection and assembly of preexisting material." See 17 U.S.C. § 101.

In the tension between facts and compilation of facts there are some facts that cannot trigger copyrightability. In a narrow range of circumstances facts themselves may be of such character that a work relating to them is incapable of meeting the requirement of a "work of authorship" referred to by the Constitution and by the statute. These might be called "public domain facts," known to or available to the world at large. Feist, at pp. 347-48, refers to census data, scientific and historical and biographical facts, and news of the day. Professor Nimmer refers to scientific facts as to the nature of the physical world, historical facts, and contemporary news events. Nimmer, § 2.03[F], at p. 2-36. Regulations covering "Registration of Claims to Copyright" provide in 37 C.F.R. § 202.1:

Material not subject to copyright

. . .

(d) Works consisting entirely of information that is common property containing no original authorship, such as, for example: Standard calendars, height and weight charts, tape measures and rulers, schedules of sporting events, lists or tables taken from public documents or other common sources.

Another narrow range of facts do not fit neatly within the "public domain" category but nevertheless are so obvious or trivial that no creativity will transform mere selection of them into copyrightable expression. Nimmer § 201[B], p. 2-14. In Feist, the telephone company's white page directory alphabetically listed telephone users by name, town and telephone number. 499 U.S. at 362. The subject matter was not original with the telephone company, and the company's use of the facts through alphabetical listing was not only unoriginal but practically inevitable. Id. at 363. The Supreme Court "ultimately reversed [in Feist] on the ground that plaintiff's white pages directory was not copyrightable at all." Jane C. Ginsburg, "No Sweat"? Copyright and Other Protections of Information after Feist v. Rural Telephone, 92 Colum. L. Rev. 338, 342. In BellSouth Adv. & Pub. Corp. v. Donnelley Info. Pub., Inc., 999 F.2d 1436 (11th Cir. 1993) (en banc), BAPCO's heading structure, for example, "Attorneys" or "Banks", represented such obvious labels for the entities appearing beneath that they lacked the required originality for copyright protection.

III. The opinion of this court

Apart from two lesser points discussed in Parts V and VI below, the opinion of this court has these main premises:

(1) The Factbook does not come within the "selection" prong of the § 101 definition of a "compilation" because no selection has been made (by anybody), since the Factbook lists all geographic communities having cable service. (Mss. pp. 22-26.)

(2) Assuming that the Factbook is sufficiently creative and original to be copyrightable, Warren's claim of protection fails because:

(a) Warren seeks copyright protection for mere techniques for discovery of facts.

(b) The selection of principal communities was made by cable operators and not by Warren. Therefore, Warren does not meet the constitutional requirement that it be the "author" of the compilation, rather it is engaged in mere discovery of facts.

I take these up in the above sequence.

(1) The premise that the Factbook contains no selection at all because it lists the universe composed of all geographic communities having cable service.

It is puzzling that this argument is seriously advanced. It is a play on words such as "listing" and "including" and it confuses the universe of data with the data drawn from the universe. As noted in the opinion of this court, (Mss. p. 26), the district court itself recognized that a list of a universe (in that reference, FCC's universe) would of itself not be original and, therefore, not copyrightable. Warren claims no copyright on the universe, and the district court found no copyright on such a list. Warren claims, and the district court found, a copyright on the selection of data drawn from the universe. Definition of a universe of data was an essential initial step in selection, but no claim is made that the universe by itself is copyrightable as a selection. The district court's references to "selected communities" are plainly references to communities as selected and presented through Warren's 406 cable-system data-presenting units. Key Publications, supra, tells us that selection implies the exercise of judgment in choosing which facts from a given body of data to include in a compilation. 945 F.2d at 513. There the compiler's universe consisted of a

multitude of businesses that she thought of interest to Chinese-Americans. The infringer urged that the compiler had made no selection but had included every business of which she had information. The court found that she had excluded businesses she thought might not remain open for very long, and this alone indicated the necessary thought and creativity. Id. The compiler did not list the universe, only the selected businesses. This court suggests that Warren has no copyright protection because it "included" its universe as well as its selected data. This misconceives the work of selection. All communities were selected, some identified and located in MSO's, others in SSO's.

(2)The premise that, assuming that the Factbook is sufficiently creative and original to be copyrightable, Warren's claim of protection fails because:

(a) The premise that, as in BellSouth, Warren seeks copyright protection for mere techniques for discovering facts.

This is a baffling premise. In BellSouth the district court had described acts that BAPCO performed as alleged "acts of selection" -- geographic limits, closing dates for entries, requiring yellow page subscribers to use business telephone service, and use of marketing techniques such as free listings and on-site visits. On appeal this court found that the district court had erred in not considering whether these alleged acts of selection met the level of originality, therefore it examined the acts. 999 F.2d at 1441. This court then held that through these strategies and marketing techniques BAPCO had learned that subscribers described their businesses in particular manners in yellow page listings and would pay for listings under certain business categories. The strategies and techniques used by BAPCO were not selected facts at all in the copyright sense but were merely creative means used to discover the facts it wanted to learn, merely

industrious means for collecting data. These "uncopyrightable formative acts used to generate [the] listings were not entitled to copyright protection." Id. at 1441.

Warren seeks no copyright on the means it used to find out facts. It has no strategies or marketing techniques. As acts of selection it collected facts in the old-fashioned way.[34] It collects data from trade publications, FCC records and reports, newspaper and magazine clipping services. Each year it sends "thousands and thousands" of questionnaires to over 10,000 cable operators in the country, which are used to identify changes from the preceding year and to update. If a system does not respond or responds inadequately Warren telephones the operator to obtain update data. It follows leads to new systems. A staff of over 20 people spend the entire year gathering data, inputting, checking, conferring and updating. It confirms with some operators the geographic areas they are currently serving. It contacts some operators to inquire what community is considered to be the lead or principal community. These are all fact-gathering techniques. None is claimed to enjoy copyright protection.

(b) The premise that the selection of principal communities was made by cable operators and not by Warren, therefore, Warren does not meet the constitutional requirement that it be the "author" of the compilation, rather it is engaged in mere discovery of facts.

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[34] This court suggests (n. 27) that Warren's acts of selection merely show industriousness, which is not relevant to copyrightability. To the contrary, Warren's acts of selection are examined, just as this court in BellSouth examined BAPCO's acts of selection, 999 F.2d at 1441, to determine whether those acts met the level of originality to extend copyright protection.

First, as a matter of fact did Warren delegate to operators the choice of principal communities? The district court found "[t]he principle community used to represent the entire system, is then selected by contacting the cable operator to determine which community is considered the lead community within the cable system." (Op. 10.) This court draws upon that statement to conclude that Warren has made no selection of principal communities or that it accepts as conclusive operators' consideration of what are principal communities of their respective cable systems. This single sentence by the district court does not bear the weight of this court's conclusions. The phrase "contacting the cable operator to determine" the principal community was used by a witness. Elsewhere a witness explained that a call might be made to an operator to determine in conjunction with the operator the identity of the principal community. Moreover, this court's conclusions are inconsistent with Microdos' position. Before the panel Microdos asserted that the choice of the principal community is controlled by external objective factors. It urged that the principal community is the one with the greatest number of subscribers. It has suggested the principal community is the "largest," which it infers to be the most populous because, Microdos says, it will generate the most subscribers. It has asserted that the lead community is the site of the headend (the location of equipment used to process television signals for redistribution to cable subscribers).[35] Also, Microdos has strenuously urged that Warren draws the

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35 Television signals may be received by satellite, by microwave tower, or by telephone lines from television stations. Microwave towers generally are located on high ground that may be unrelated to other facilities of the operator and not necessarily even in the area served by the cable system. Many systems have multiple headends. It has been suggested that "lead" community means the site of the managerial headquarters of the system, where a customer, salesmen for cable equipment, or a potential advertiser may seek the manager or the engineer or the sales manager. But managerial headquarters is not necessarily even in the area served, and examination of Illinois systems in the Factbook shows that frequently it is not.

identity of the principal community from data it finds in Federal Communications Commission reports. Additionally, in its petition for rehearing en banc it has called the court's attention to Atlanta as the principal community for its cable service, chosen, Microdos says, because it is the dominant municipal area served and everybody knows that it is the principal community. It is obvious that these objective factors are relevant to determining the identity of the principal community of a cable system, and Microdos accordingly has relied upon them.[36] But this court has laid all these aside as having no significance, indeed as though never uttered, in favor of its own conclusion that it is the cable operators, not Warren, that determine in the case of a multiple community systems, the community name under which to list the pertinent data for the entire cable system. (Mss. p. 33.)

Alternatively, this court proposes (n. 29) that a cable operator is "likely" to designate as its principal community the community with the most subscribers, therefore no exercise of judgement was required by Warren to select the principal communities. I have pointed out the many factors asserted by Microdos itself as relevant to selection of the principal community. Neither the record, nor Microdos, supports the "likelihood" that the principal community will be the one with the most subscribers, nor the statement (n. 26) that every MSO has one "obvious" principal community. That may be so as to Atlanta ("everybody knows it is the principal community"), but a study of some 406 principal communities in Illinois, most of them smaller towns and cities, discloses no such "obvious" character.

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36 Other relevant factors are miles of cable and numbers of homes passed in a particular community.

This court (Mss. p. 31) analogizes Warren's contacts with operators to what it describes as the "similar" selection of headings made by telephone users in BellSouth. But, as BellSouth noted, the headings offered to BAPCO subscribers did not originate with BAPCO but were obvious and unoriginal labels for business categories such as "Attorneys" or "Banks." 999 F.2d at 1445. The BAPCO subscriber ordered from an unoriginal menu of business categories the menu item it liked and would pay to be listed under in the yellow pages. Warren's category, "principal community," is neither obvious nor unoriginal. The cable operator in this case was asked for operational information about how his business was currently functioning, to be listed in an operations directory. The extensive objective factors advanced by Microdos itself demonstrate relevant criteria that bear on this industrial directory listing.

Moreover, this court has focused upon the selection of the principal community, whose name the system will bear, as though that is all that the case is about. The acts of selection carried out by Warren were a stream of events, beginning with its choice of the facts it wanted and the construct of a functional methodology in which to develop and present them. The use of a geographic name for each cable system, and the choice of the names of principal communities as identifiers, and the decision on a particular name, were not isolated acts of selection like Athena springing full grown from the brow of Zeus, or a decision made by a snap of someone's fingers, or a mechanical decision from a single telephone call, or by numerous calls. They were parts of the stream of acts of selection that I have described. This court does not, however, refer to Warren's exercise of judgment in creating this structure of selection and in choosing the facts to be reported and how to report them. Yet these acts of selection are independent expressions of the author, part of the overall "work of authorship."[37] This court does not hold them to be unoriginal or non-creative. Instead, it ignores them and treats this case as turning on the single fact of the source of information about principal communities. This trivializes what this case is about. Laying aside the foregoing, I turn to this court's conclusion that Warren does not meet the

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37 The selections made of categories -- "cable system," "principal community," -- are by themselves, acts of selection that meet requirements of originality. CCC Information Services, Inc. v. Maclean Hunter Mkt. Reports, Inc., 44 F.3d 61 (2d Cir. 1994), held copyrightable a compilation of the compiler's predictions of used car valuations based upon market data and the compiler's judgment and expertise. One of the elements of originality held to pass Feist's threshold was the use of the abstract concept coined by the compiler, of the "average" vehicle in each category. Id. at 67. The Second Circuit held the compilation was protected and that the district court erroneously applied a higher standard of originality than Feist. Kregos v. Associated Press, 937 F.2d 700 (2d Cir. 1991), concerned a form that displayed statistics on the recent past performances of baseball pitchers scheduled to start the next day's games. The compiler's selection of statistics survived summary judgment motion alleging lack of originality.

requirements of authorship because it is a "mere discoverer" of facts. The difference between mere discovery of facts by Warren and authorship by Warren cannot be based on the single fact that Warren is engaged in collecting information. All compilers are collectors of facts collected from some other source. If the fact of collecting data from an original source deprives a compiler of authorship status, all the vitality is drained out of the congressional provision for copyright of compilations in §§ 101 and 102. Warren's status as author versus mere discoverer requires examination of the nature of the facts discovered. If they are "public domain" facts, or such facts as by their nature cannot support originality, Warren is not an author. If, however, Warren has collected facts that are capable of supporting originality, and it meets the statutory requirements for selection and presentation, then both statute and the constitutional provision for originality (authorship) are met. The linchpin of Feist is the nature of the underlying facts (names, towns and telephone listings) that would not support copyrightability. BellSouth has the same linchpin: headings, such as "Attorney" and "Banks" that were not original expressions of an author but mere facts, obvious if inevitable classifications drawn from the public domain. In both cases, Feist and BellSouth, the compiler was gathering information that would not support copyrightability.

Warren's facts do not fit into these narrow categories of uncopyrightable facts. Data on how businesses in a growing and changing industry are owned, operated and managed is not public matter like today's news event, or the speed of a falling object, or the face of the calendar, nor is it unoriginal subject matter open to and utilized by the world at large like the telephone listings of Feist. Its facts are functional data of a changeable and changing industry, structured in a new and original format. Its gathering of these facts from original sources is authorship, not mere discovery.

U.S. Payphone, Inc. v. Executives Unltd. of Durham, Inc., 18 U.S.P.Q.2d 2049 (4th Cir. 1991), is a per curiam with Justice Powell on the panel. The compiler assembled and summarized public information on state tariffs regulating fees payable to telephone utilities by owners and operators of pay telephones. The summarized information was presented in the format of one sheet for each state. The court found:

> Payphone's selection and organization of the state tariff material was sufficiently subjective and original to make the Tariff Section copyrightable material.

18 U.S.P.Q.2d at 2051.

IV. BellSouth does not ring for this case

It is understandable that judges of this court wish to be faithful to the en banc decision in BellSouth. But we need not extend it. I gather in one place the reasons this decision is not controlled by BellSouth.

(1) BellSouth concerned uncopyrightable facts, obvious headings drawn from the public domain. This case does not.

(2) The district court in BellSouth found that the compiler's establishment of the geographic limits of its directory and of a closing date for listings were acts of selection. This court found these were uncopyrightable acts common to compilations. 999 F.2d at 1441. There are no such acts in the present case.

(3) In BellSouth this court found that the district court had erred in treating as copyrightable facts that were not copyrightable facts at all but merely techniques for the discovery of facts -- marketing techniques and sales strategies. Warren has no such techniques and strategies and it relies upon selection and presentation of facts.

(4) Much of the BellSouth decision concerns BAPCO's claims of originality based upon the coordination and arrangement provisions of § 102. 999 F.2d 1442-44. These issues are not present in this case. The district court ruled against Warren on coordination and arrangement, and this holding is not an issue in this appeal.

(5) BAPCO failed to establish that its structure of headings was "original expression," that is, that it was the author of the headings such as "Attorneys" and "Banks." Without question Warren is the creator of the heading "principal community," a name previously unknown to the industry and implicating the concept of a data-reporting unit previously unknown. BellSouth found that an expressive act of dividing such obvious categories as "Attorneys" into subcategories (such as bankruptcy lawyers and criminal lawyers) merged into the idea of listing in a directory the subtitles as a class of business. 999 F.2d at 1444. There are no such subdivisions in this case, and, as discussed below in Part VI, merger does not fit, indeed does not even come close, to this case.

(6) At the heart of BellSouth is the single fact of the subscriber's selecting an appropriate heading from the menu of obvious and unoriginal headings. The selection involved in the present case is a stream of original and nonobvious acts only one aspect of which involves choice of names for data-reporting units.[38]

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[38] While I do not suggest that BellSouth be abandoned, it has drawn considerable criticism. Wood, Ethan L., Copyrighting the Yellow Pages: Finding Originality in Factual Compilations, 78 Minn. L. Rev. 1319, 1335 (1994): "The Eleventh Circuit's approach directly contradicts Key Publications" [discussed above in text]. . . . "The Eleventh Circuit opinion in BellSouth is much more hostile than Key Publications to claims of copyright infringement of the yellow pages." Id. at 1333. "The Eleventh Circuit's BellSouth decision used a standard of originality that is inconsistent with the Supreme Court's approach in Feist." Id. at 1336. "[T]he Eleventh Circuit has raised the threshold of required originality higher than the Feist decision established." Id. at 1337. And finally, "[U]nlike the Eleventh Circuit, the Second Circuit, which has traditionally been the most influential in developing copyright law, properly follows the Feist approach." Id. at 1339 (footnote omitted). See also Nimmer § 3.04[B], p. 3-31 (footnotes omitted):

> Most applications of Feist have recognized the circumscribed sphere to which its holding applies, ruling that it invalidates the copyright only in the most banal of works, such as the white pages of a copybook. Other post-Feist decisions cannot be squared with BellSouth. See CCC Information Services, Inc. v. Maclean Hunter Mkt. Reports, Inc., 44 F.3d 61 (2d Cir. 1994), in footnote 5, supra. See also U.S. Payphone, Inc. v. Executives Unltd. of Durham, Inc., 18 U.S.P.Q.2d 2049 (4th Cir. 1991), discussed above in Part III.

V. Use of the word "system" does not bar copyrightability

The district court used the word "system" in referring to Warren's acts of selection, and the panel opinion by this court fell into the same phraseology. 17 U.S.C. § 102(b) tells us that copyright protection for an original work of authorship does not extend to a "system." This court relies upon § 102[b] as a bar to copyrightability. Neither district court nor the panel addressed § 102(b), nd one may infer that both courts used the word "system" in a generic, everyday sense and not as a word of art under § 102(b).

In any event, § 102(b) is not, as this court describes it, a "limiting principle." In the leading case, Toro Co. v. R. & R. Products Co., 787 F.2d 1208, 1212 (8th Cir. 1986), the claimant asserted a copyright on its use of a "system" of numbering in its catalog replacement parts for lawn care machines. The district court denied copyrightability on the ground that the claim was for a "system." The court of appeals rejected the view that literal use of the term "system" from § 102(b) is a "limiting principal." [Section 102(b)] is nothing more than a codification of the idea/expression dichotomy as it developed in the case law prior to passage of the 1976 Act. H.R.Rep. No. 1476, 94th Cong., 2d Sess. 57, *reprinted in* 1976 U.S.Code Cong. & Ad.News 5659, 5670 ("Section 102(b) in no way enlarges or contracts the scope of copyright protection under the present law. Its purpose is to restate . . . that the basic dichotomy between expression and idea remains unchanged.") (Emphasis added.)

Id. at 1212. The court held the claimant's copyright not valid, based on the idea/expression dichotomy; i.e., claimant could not copyright the idea of using numbers to designate replacement parts. And its expression of that idea simply drew numbers from the public domain and, without rhyme, reason, or judgment, arbitrarily assigned them to parts. The expression of the idea did not meet the requirement of originality. See Nimmer § 203(D), p. 2-35, to the same effect as Toro. It seems beyond argument that Warren does not seek copyright protection on the idea of gathering and selecting data and reporting it in a manner that responds to the perceived needs for functional data of a changeable and changing industry. Rather it seeks a copyright on its expression of that idea.

The opinion of this court recognizes that the use of the term "system" does not preclude copyrightability. But, the court says, Warren's acts of selection were in fact a "system," and that fact creates a bar. (n. 21). In the first place, the district court made no such finding, nor does the evidence address it. Second, this contention is contrary to what Congress itself has said. See quotation, above, H.R. Report No. 1476. If what the copyright claimant has done is an expression of sufficient originality that it is entitled to copyright, calling it a "system" does not strip it of copyrightability.

VI. The doctrine of merger does not bar copyrightability

By footnote this court suggests the merger doctrine as an alternative ground for denying copyrightability. Merger operates where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself. The court suggests that Warren's principal community presentation is one, if not the only, commercially useful way of organizing a compilation of information on the cable television industry, so the presentation is merged with the idea of a cable television directory.

This is another puzzling point. As has been said repeatedly, Warren's reporting data by principal community units is a total departure from prior methods utilized in the industry. No one -- industry or government -- has previously assembled and presented functional data drawn from the way the industry presently operates and is managed. Presumably, for many users, Warren's way of selecting and presenting data is the most useful way. But there are many ways.

The television industry is driven by the advertising dollar, and advertisers place their dollars by numbers and types of viewers, based in part on information that includes numbers of homes reached by cable. Seekers of cable data may wish to utilize data compiled community-by-community, as, for example, an equipment salesman will wish to know whether discrete communities within a service area utilize differing equipment. A compiler may wish to organize cable television data by counties, by areas of the state ("upstate" and "downstate"), by adjoining communities, by agricultural areas, by urban and rural areas, by big systems and smaller systems, large cities and small towns, high income and low income areas, sports-oriented areas and less interested areas. Nor does cross-referencing change the picture. Warren cross-references and groups data by service/management. Another compiler

may group and cross-reference agricultural areas or high income areas. It may group and cross-reference all cable operations that use a particular manufacturer of equipment.

Warren's selection of data is original, creative and useful. To suggest it is the only conceivable useful way is astonishing. The FCC listed 724 communities in Illinois versus Warren's selected 406, based on different criteria. The Broadcast Yearbook, another recognized directory of the industry, listed 243 communities in Illinois. Different organizations create lists different in structure, scope and number that may be useful for different readers for varying purposes. Merger does not fit.

VII. Conclusion

The district court correctly decided this case, and we should affirm its decision. Our statutes provide rational and economically useful copyright protection for compilations. If that protection is to be narrowed and cabined the choice is for Congress, not the courts.

United States Court of Appeals,

Eleventh Circuit.

No. 93-8474.

WARREN PUBLISHING, INC.,
Plaintiff-Counter-Defendant,
Appellee.

v.

MICRODOS DATA CORP.; Robert Payne,
Defendants-Counter-Claimants,
Appellants.

May 23, 1995.

Appeal from the United States District Court for the Northern District of Georgia. (No. 1:90-cv-1654-JOF), J. Owen Forrester, Judge.

Before KRAVITCH, Circuit Judge, GODBOLD and MORGAN, Senior Circuit Judges.

GODBOLD, Senior Circuit Judge:

This is an appeal from a permanent injunction enjoining defendants from infringing a copyright of Warren Publishing. As a predicate for the injunction the district court denied a motion by the defendants for partial summary judgment on the infringement issue and granted a cross motion for partial summary judgment on that issue by Warren Publishing.[39] We affirm.

I. Background and Copyrightability

Warren compiles and publishes annually a printed director known as the "Television and Cable Factbook," which provides information on cable television systems throughout the country. The subject matter of this case is the 1988 issue of the Factbook, which contains a "Directory of Cable Systems" section and a "Group Ownership of Cable Systems" section, together containing approximately 1,350 pages of information concerning 8,413 cable systems throughout the country and their owners.

The district court explained the format of the Factbook:

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[39]Warren also asserted a claim for unfair competition, and Microdos counterclaimed for defamation and trade disparagement, interference with contract relations, and violations of the Sherman Antitrust Act by attempts to monopolize. These claims remain undisposed of.

The directory of cable systems section arranges entries alphabetically by state, and, within each state, alphabetically by the name of the "lead" or "principal" community served by the particular cable system. The group ownership section contains a listing of selected information about entities owning and/or operating more than one cable system. These entities are called multiple system operators, or MSOs. The 1988 Factbook contained information on 8,413 cable systems. Information on each cable system and MSO entry is broken down into a uniform set of "data fields" which provide a specific piece of information about the system. The Factbook uses the same pattern for each cable system entry. The Factbook's format is based on identifying cable systems, then providing information on the cable systems through the use of specific groups of data fields.

Order, p. 2.

Warren has been publishing cable television information since 1948, constantly adding to its work systems and data fields of systems. It is not disputed that the Factbook is a copyrighted work and is appropriately registered. The Factbook is, however, a compilation.

A "compilation' is a work formed by the collection and assembling of preexisting materials or of data that are *selected, coordinated, or arranged* in such a way that the *resulting work* as a whole *constitutes an original work of authorship.*

17 U.S.C. § 101 (1990) (Emphasis added.).

A "compilation' results from a process of selecting, bringing together, organizing and arranging previously existing material of all kinds, regardless of whether the individual items in the material have been or ever could have been subject to copyright.

H.Rep. No. 1476, 94th Cong., 2d Sess. 57, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5670.[40]

The preexisting materials in this case consist of information about cable television systems. A copyright of a compilation does not lead automatically to a conclusion that all materials therein are copyrighted. The owner must prove that the alleged infringer appropriated a protectable element of the compilation consisting of the owner's original selection, coordination or arrangement. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 111 S.Ct. 1282, 113 L.Ed.2d 358 (1991). The district court found, on the summary judgment record, that the Factbook had sufficient originality in its selection, coordination and arrangement of the data contained therein to be copyrighted, a conclusion that Microdos does not seriously contest. Warren contended that the elements of the compilation that were copyrighted and infringed were three: (1) the communities covered; (2) the selection, sequencing and arrangement of data fields; and (3) the content of the data fields. With respect to (2), the court found that the selection of data fields to be incorporated into the Factbook was obvious to persons in the industry and did not require the creativity and originality necessary to permit copyright protection. The arrangement of data fields was held to be creative and copyrighted but not infringed because not substantially appropriated by Microdos. With respect to (3), the content of data fields was found to be merely facts thus not copyrightable. Warren has not cross appealed, so the findings with respect to data fields are not before us for review.

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[40]Section 103 of the Copyrights Act also protects "derivative works," which involve changing preexisting material by transforming or recasting it. By definition a derivative work incorporates matter capable of protection by copyright, while a compilation incorporates preexisting material or data that may not in itself be capable of copyright protection. *Nimmer on Copyright*, § 3.02.

The district court described Warren's system for selecting and presenting information on cable systems:

> How one defines a "cable system' will dictate the communities selected to represent those systems.Warren Publishing uses a "principle [sic] community' system in selecting and presenting its information on cable systems contained in its Factbook. A "cable system' is defined as an entity composed as one or more communities that are offered the same service by the same cable system owner at the same price. The principle [sic] community, used to represent the entire cable system, is then selected by contacting the cable operator to determine which community is considered the lead community within the cable system. Other communities within the same cable system are then listed under the principle [sic] community, not independently.

Order, p. 10. The court then went on to hold that only Warren's selection of communities was sufficiently creatively original to be copyrightable.

> In effect, Warren had admitted that the coordination and arrangement of the communities selected for coverage in the Factbook was an obvious, mechanical, or routine task which required no creativity. Therefore, the coordination and arrangement of the communities selected is not copyrightable. However, Warren argues that the selection of those communities was creative and protectable because Warren uses a unique system in selecting the communities that will be represented in the Factbook. The court finds that Warren Publishing's system of selecting communities is sufficiently creative and original to be copyrightable.[3]
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> [3] This is not to say that the selection of cable systems would be copyrightable in all cases. Had Warren selected every cable system listed by the F.C.C., then there would not be sufficient originality in the "selection" to warrant copyrightability.
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> * * * * * *
>
> In this case a choice was made as to which communities were to be listed.

Order, p. 11.

Cable system information compiled and arranged by various compilers in the industry is commonly organized alphabetically by state and then, for each state, alphabetically by the names of communities having cable service. Cable systems offering service may serve one geographical community (single-community service) or more than one geographical community (multiple-community service). A system will serve only a community, or communities, for which it has been granted a franchise(s) by one or more local governments. A list of geographical communities served will not, therefore, coincide with a listing of systems–one lists apples and the other oranges. Warren chose to present information on cable systems, each an entity served by the same owner offering the same service at the same price. The limits of the entity are not geographic but owner/price/service bounded. For the purpose of listing, Warren identified systems by the names of communities served. Theoretically, it might have listed systems by the names of operators listed alphabetically, but this would be of doubtful use. Rather Warren chose to list systems geographically by "lead" or "principal" communities served. More than half of the systems were single-community systems, and, for each of them, the lead or principal (hereinafter "principal") community was the sole community served. For a multiple-community system it was necessary to determine a principal community to be listed.[41] include some geographical radius around it. It might choose a large urban site and attach adjacent suburbs, or attach rural areas to urban, or combine rural areas. It might list by communities within areas of the state, i.e., "NW Illinois" or "SW Illinois."

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[41]Other listing methods are possible. The Federal Communication Commission lists communities alphabetically by mapbook name or local lore name. Another compiler might choose to list by "communities" but define a "community" differently than Warren does. It might choose a central geographical site and include some geographical radius around it. It might choose a large urban site and attach adfacent suburbs, or attach rural areas to urban, or combine rural areas. It might list by communities within areas of the state, i.e., "NW Illinois" or "SW Illinois."

According to Warren's evidence it made the determination of principal community by questionnaires (45% of the cases) and contact with the operators (55% of the cases). It acknowledges that it used Federal Communication Commission data to update its files. Once a principal community was determined for a multiple-community system, all other communities served by the system were listed under the principal name, not independently.

The parties chose Illinois as a representative state, and 1988 as a representative year, for purposes of this case. The district court set out differences brought about by different listing methods. The FCC attempts to list alphabetically every geographical Illinois community having cable service. For 1988 it listed 724 communities served. Warren's 1988 Factbook listed 406 as suitable for listing using its principal community concept.[42] The Broadcast Yearbook, another industry source (its criteria were not spelled out by the court), listed 243 communities. The district court found that each source listed some communities not included in other works. The court cumulated the names of communities listed by all sources and found 808.

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[42]As we discuss below under "Infringement," Microdos's list of communities served was almost a 1:1 match of Warren's list of 406 principal communities.

In *Feist Publications, Inc.*, 499 U.S. 340, 111 S.Ct. 1282, the Supreme Court considered copyrightability of Rural's white page telephone directory for several communities, the listings of which were copied by Feist in an area-wide directory. The Court held that Rural's material did not meet minimum standards for copyright protection. Rural simply took raw data–name, town and telephone number–of each person who had applied for, and was receiving, telephone service from it and listed it alphabetically by surname. The court recognized that this was "selection" of a sort but held that it lacked "the modicum of creativity necessary to transform mere assertion into copyrightable expression." *Id.* at 361, 111 S.Ct. at 1296. The Court set out principles for copyrightability of factual compilations of preexisting factual materials. The material contained need not be protectable. *Id.* at 347, 111 S.Ct. at 1289. The constitutional touchstone is originality in selection, coordination or arrangement of the preexisting materials. The level of creativity required is low, "some creative spark, no matter how crude, humble or obvious." *Id.* at 344, 111 S.Ct. at 1287. The copyright is "thin." *Id.* at 347, 111 S.Ct. at 1289. The "sweat-of-the-brow" doctrine was rejected. *Id.* at 351, 111 S.Ct. at 1291.

Feist has been accorded very narrow scope.

> Most applications of *Feist* have recognized the circumscribed sphere to which its holding applies, ruling that it invalidates the copyright only in the most banal of works,[64] such as the white pages of a phone book.[64.1]

[64] *Victor Lalli Enters., Inc. v. Big Red Apple, Inc.*, 936 F.2d 671 (2d Cir.1991) (chart of horse racing statistics arranged according to "purely functional grids that offer no opportunity for variation"); *Sem-Torg, Inc. v. K Mart Corp.*, 936 F.2d 851 (6th Cir.1991) (five plastic lettered signs–*e.g.*, "For Rent"/"For Sale"–purportedly "compiled into a set").

[64.1] *Illinois Bell Tel. Co. v. Haines & Co.*, 932 F.2d 610 (7th Cir.1991). In 1991, two courts of appeals distinguished *Feist* to hold infringing the act of copying a yellow pages compilation. *Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc.*, 945 F.2d 509 (2d Cir.1991); *Bellsouth Adver. & Pub. Corp. v. Donnelley Info. Pub., Inc.*, 933 F.2d 952 (11th Cir.1991). After the latter opinion had been on the books for well over two years, the full court reached the opposite conclusion. 999 F.2d 1436 (11th Cir.1993) (*en banc*), *cert. denied*, [--- U.S. ----,] 114 S.Ct. 943 [427 L.Ed.2d 323] (1994). Over a blistering dissent, *id.* at 1471 (Hatchett, J., dissenting), the court noted that defendant was not alleged to have copied from plaintiff's directory the text or graphic material from the advertisements, the positioning of those ads, the typeface, or the textual material included by plaintiff to assist its readers. *Id.* at 1445. In essence, plaintiff complained that defendant used its directory as a shortcut to prepare a rival publication.

Nimmer on Copyright, ¶ 3.04(B), p. 3-31 (footnote 63 omitted).

Bellsouth Adver. & Pub. Corp. v. Donnelley Info. Pub., Inc., 999 F.2d 1436 (11th Cir.1993) (*en banc*), *cert. denied*, --- U.S. ----, 114 S.Ct. 943, 127 L.Ed.2d 323 (1994), is this court's post-*Feist* directory case. BAPCO, a subsidiary of Bellsouth, published a "yellow pages" advertising directory for the Miami area, organized into an alphabetical list of business classifications. Donnelley, the alleged infringer, obtained the name, address, phone number, and other data from each listing in the BAPCO directory. It entered this into its computer, published it in its directory, and prepared from it advertising leads. This court *en banc* reversed a summary judgment for Bellsouth.

Bellsouth is like *Feist*. BAPCO took its own data–telephone listings of its subscribers–and arranged it in an alphabetical listing of business types, with individual businesses listed in alphabetical order under the applicable headings. These acts of coordination and arrangement, like those of Warren, were–for a business telephone directory–"not only unoriginal but practically inevitable." The court considered BAPCO's asserted acts of selection–i.e., determining the geographical scope of its directory and setting the closing date after which no listing would be accepted, and various marketing techniques to generate listings. The court pointed out that any expression of facts fixed in a tangible medium of expression requires a closing date and, where appropriate, a geographical limit, and that marketing techniques were techniques for collection of facts. No creative originality in selection was present.

In contrast, Warren utilized not raw data from its files but an external universe of existing material drawn from the industry and not itself precisely contoured, and presented and listed in various forms by various compilers. It chose to present information on cable systems by listing cable systems. For that purpose it defined "system." It selected a method for placing each system within the listing structure, i.e., it chose to identify each system by the geographical name of the principal community served, determined in the manner we have described for single-community systems and for multi-community systems.

It is obvious that Warren's listings offer advantages to persons using, serving, or selling to cable operators, who can deal with a single-community system, or a multi-community system connected by service and operation, by identifying and dealing with the heart of the system.

Microdos makes a number of contentions directed to whether Warren's selection process has originality. It says it lacks originality because publicly available information is contained in FCC records, reports and filings.

The FCC reports provide a solid basis for determining cable systems and communities served. The FCC reports are a snapshot of cable systems nation-wide at a fixed time. Cable operations are constantly changing. They are not static and the changes are reported by cable operators to the FCC.

Reply Brief, p. 3. Microdos also says that originality is lacking because Warren contacts operators by questionnaires and telephone, to determine from each what respective community it considers to be its principal community. Microdos's argument overlooks the nature of a compilation, which is copyrightable because it compiles preexisting material in an original manner. It overlooks that the underlying data in this case does not in itself reveal that listing will be by principal communities, and, except for single-community operations, it does not reveal the name of the principal community, which is central to Warren's selection process.

Warren does not, as Microdos suggests, assert copyrightability of a mere list of historically established geographical names. No such claim is made. Except for a single-community system, a geographical designation of "X" is not used by Warren in its local lore/mapbook sense but as the designation of a community that may include A, B and C as well as geographical area X, whose name has been selected as a label and useful as an entry point for the researcher.

We discuss below under "Infringement" Microdos's independent source defense in which it asserts that FCC data can be used to produce the information that Warren lists. That argument is also relevant to the claim that Warren's work lacks originality. For the reasons we give below, it does not demonstrate lack of originality.

The merger doctrine is not a bar to copyrightability in this case. It precludes copyrightability where an idea can only be expressed in a limited number of ways. Here the concern is copyrightability of a compilation embracing selection of items that might, and often are, selected and listed in many forms by authors of existing compilations. The "sweat-of-the-brow" doctrine is not utilized.

The district court did not err in holding that Warren's system of selecting communities is sufficiently creative and original to be copyrightable.

II. Infringement

Microdos markets a computer software package called Cable Access, which, like the Factbook, provides detailed information on the cable television industry. The district court described it:

> The Cable Access software package is broken into three databases. The first database provides information on the individual cable systems. This database is referred to as "the systems database.' The second database provides information on multiple system operators and is simply referred to as "the MSO database.' The third database is a historical database which provides selected information on the cable industry from 1965 to the present. Only the systems database and the MSO database are alleged to be infringing upon plaintiff's copyright.
>
> Defendant's Cable Access software package comes presorted by state and city. The customer may rearrange the data in a format of its choosing. The customer may construct searches of the database's information on cable systems as required to fit its particular needs, as well as output the data to a hard copy in various formats, again to fit the specific needs of the customer.

Order, p. 3. Cable Access has been marketed in four versions which follow essentially the same format. Warren contends that all four versions infringe upon its copyright.

The test for infringement is whether there is substantial similarity between Microdos and the Warren selection of principal communities, the element of copyrightability in Warren's compilation. There is strong evidence of copying by Microdos. Warren included in its Factbook nine or ten fictitious cable system entries, created as decoys. The phony operator(s) appeared in the initial version of Cable Access. Microdos's only explanation to this court is the statement that it has no explanation for how this happened.[43]

The district court found that Cable Access's versions one to four are virtually identical to the 1988 Factbook selection. The Factbook listed 406 communities under its principal community concept. The first version of Cable Access listed 405 communities served, the second 394, the third 393, and the fourth 398. These were almost 1:1 matches with the Factbook–99.9% by version one, 97% by version two, 96.8% by version three, and 98% by version four.[44]

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[43]In a colloquy with the trial court counsel for Microdos stated that there were ten decoys from the Handbook that appeared in Cable Access. On appeal defendants' brief refers to a single decoy operator. We cannot reconcile these variations, and need not, for, one or ten decoy operators, or one or ten listings of a single operator, the entry or entries constitute(s) evidence of copying.

[44]Microdos asserted in the district court that at least 20 communities should not have been included in the matching. If they were excluded the matching of versions one to four, respectively, to the Factbook, would have been 94.85%, 92.10%, 91.85%, and 93.10%. For 1988 the FCC, which attempts to list individually every community having a cable system, listed 724. The Broadcast Yearbook listed 243. The match between the Factbook and the FCC was only 56.10%. Between Cable Access and the Yearbook, the match was only 56.10%.

Faced with this commanding evidence of almost verbatim copying, Microdos asserted an independent creation defense, i.e., that the high correlation of listings was the result of its use of similar but independent community selection processes that produced similar results. The district court held that, in view of the high degree of correlation, Microdos was required to produce detailed evidence showing how it arrived at its listings and how the system worked to produce substantially similar results.

In its independent creation argument Microdos sets out that FCC lists all cable operators and that operator that is part of a multi-community operation is given a "system-iden" number that identifies it as part of a multi-community operation. Thus, it says that it grouped together all systems having the same system-iden code, thereby establishing a geographical area for the multiple system. It then selected a name for the area, "in most cases" the name of the "major community," which was the community with the largest number of subscribers, or in some cases where the headend[45] was located. This process of selecting a name produced what Microdos calls an "inherent selection." It tells us in its brief (p. 27) that the name of the geographical area "may, however, differ from this initial selection." Microdos made telephone calls to cable systems which might reveal changes such as headend location and changes in franchise areas by adding or deleting communities served.

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[45]The place at which television signals were received, to be fed into the cable system.

The district court found this description of independent source not satisfactory. Microdos did not clearly state how, in utilizing it, it determined the major community in each multi-community area, a determination that had to be made to convert FCC's listing of communities served into listings that matched Warren's principal community listings. We have the same difficulty as the district court had. At one point Microdos says that the "major community" is the community with the most subscribers, elsewhere that it is the most populous, elsewhere that in "most cases" it is where the headend is located. It asserts that FCC requires that cable systems report communities served by headends and, that as a matter of common sense, the headend will be the principal community. The district court voiced its dissatisfaction with the changeable, and changing, explanations of listing by headend community, most populous community, common sense community, and "most cases" as against "other cases" not clearly explained. It is self-evident that a single-community operation will be listed in both the Factbook and Cable Access. Additionally, some communities listed by FCC were assigned multiple system-iden codes, which made it unlikely that Microdos's asserted use of FCC data would produce consistent and reliable community listings.[46]

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[46]We have pointed out above that this description of data available from FCC records does not show lack of originality in Warren's community selection process.

In its reply brief Microdos seems to describe another method that it says produced a list of roughly 390 communities. This method embraced using an FCC report "among other public documents and FCC reports," which produced 458 "potential" systems, and this figure was then corrected for 57 errors and irregularities resolved by telephone calls to the FCC and to operators, and also by removal of ten systems listed under other states but serving Illinois communities, producing a final figure of roughly 390 systems "having an Illinois community as the name of the geographical area served by the cable systems."

Like the district court, we are simply not informed by Microdos how its listings of communities served is almost a 1:1 match of Warren's list of principal communities. The district court did not err in holding that Microdos did not establish a plausible and coherent method for arriving at its selection of communities and submitted insufficient evidence that relied on any principled criterion for community selection.

The judgment granting an injunction is AFFIRMED.

KRAVITCH, Circuit Judge, dissenting:

The facts of this case present a very close question, and Judge Godbold has written a well-reasoned and forceful opinion. Nonetheless, I dissent. I conclude that this case is factually similar to *BellSouth Adv. & Pub. Corp. v. Donnelley Info. Publ.*, 999 F.2d 1436, 1441 (11th Cir.1993) (en banc), *cert. denied*, --- U.S. ----, 114 S.Ct. 943, 127 L.Ed.2d 323 (1994), and, therefore, that we are bound by the holding of our en banc opinion.

BellSouth denied copyright protection for the selection of business listings used in the Yellow Pages after determining that the selection did not meet the "requirement of originality." *Id.* at 1440 (citing *Feist Publications, Inc. v. Rural Tel. Ser. Co.*, 499 U.S. 340, 344, 349, 111 S.Ct. 1282, 1287, 1290, 113 L.Ed.2d 358 (1991)). The en banc court determined that "[b]y employing its sales strategies, BAPCO discovered that certain subscribers describe their businesses in a particular fashion and were willing to pay for a certain number of listings under certain available business descriptions." *BellSouth,* 999 F.2d at 1441. It held that BellSouth's acts of selection were "not acts of authorship, but techniques for the discovery of facts" and that the Copyright Act "affords no shelter to the resourceful, efficient, or creative collector." *Id.*

Warren Publishing's selection of principal communities is similar to BellSouth's selection of business listings. Warren Publishing selects how to divide the country into individual cable systems and how to assign principal community names by

> contact[ing] cable operators to come up with a cable *system* listing which identifies the way an operator's service areas are managed.... To determine how to list systems in the Factbook, the Factbook staff, in conjunction with the cable system operators, determines what we call the "principal communities' of their service areas. All data for each separately identified *system* (including data for other communities served) are reported under the "principal community' heading.

Levine Affidavit, WW 11-12. Thus, like BellSouth, Warren Publishing contacts operators, asks them questions about how their systems are run, and uses the responses it receives to place the systems within the directory. In light of this similarity, I am not convinced that Warren Publishing's selection of cable systems and principal communities involves significantly more originality than BellSouth's selection of business listings.

Warren Publishing's claim that "when some names are selected from a larger universe for use in a compilation, that list provides a distinctive, original selection entitled to protection," Brief for Appellee at 18, conflicts with *BellSouth.* Like Warren Publishing, BellSouth selected its business classifications from a larger universe of available headings after contacting those who would be listed in the directory. *BellSouth,* 999 F.2d at 1473-74 (en banc) (Hatchett, J., dissenting) (noting that BellSouth selected approximately 7,000 classified headings from a list of 4,700 primary headings and 34,000 related possible headings).

Warren Publishing's suggestion of copyrightability because "the variation in the selections examined in the record demonstrates that starting from the same source material, authors seeking to present cable system information can and do select separate and distinct groups of systems to report," Brief for Appellee at 18, is similarly refuted by *BellSouth.* In *BellSouth,* substantial variation in listings selected by competitors did not lead to a finding of originality. For example, as noted in the dissent, the "*1985 Miami North* directory contain[ed] approximately 4,000 headings and [the] *1985 Miami South* directory contain[ed] approximately 4,300 headings, as compared to the 7,000 headings in BAPCO's *1984 Yellow Pages.*" *BellSouth,* 999 F.2d at 1474 (en banc) (Hatchett, J., dissenting).

Finally, the fact that BellSouth compiled its own data is not sufficient to differentiate the cases. A compiler who takes facts from an outside source is not any more original under copyright law than a compiler who takes facts from its own files; its employees just may have worked harder. *Id.* at 1440 n. 10 (rejecting "sweat of the brow" or "industrious collection" theories; citing *Feist Publications,* 499 U.S. at 351, 111 S.Ct. at 1291).

Accordingly, in light of our en banc court's holding in *BellSouth,* I cannot conclude that Warren Publishing's acts of selection were sufficiently original to merit copyright protection in this Circuit.[47] Respectfully, therefore, I dissent.

[47]Although the district court concluded that Warren Publishing's selection of principal communities was sufficiently original to receive copyright protection, it did not have the benefit of the en banc *BellSouth* opinion.

United States Court of Appeals,

Eleventh Circuit.

No. 93-8474.

WARREN PUBLISHING, INC., Plaintiff-Counter-Defendant-Appellee,

v.

MICRODOS DATA CORP.; Robert Payne, Defendants-Counter-Claimants-Appellants.

Oct. 5, 1995.

Appeal from the United States District Court for the Northern District of Georgia (No. 1:90-CV-1654-JOF) J. Owen Forrester, Judge.

ON PETITION FOR REHEARING

(Opinion May 23, 1995, 11th Cir., 1995, 52 F.2d 950)

Before TJOFLAT, Chief Judge, KRAVITCH, HATCHETT, ANDERSON, EDMONDSON, COX, BIRCH, DUBINA, BLACK, CARNES and BARKETT, Circuit Judges.*

*Senior U.S. Circuit Judge John C. Godbold has elected to participate in further proceedings in this matter pursuant to 28 U.S.C. § 46(c).

BY THE COURT:

A member of this court in active service having requested a poll on the suggestion for rehearing en banc and a majority of the judges of this Court in active service having voted in favor of granting a rehearing en banc,

IT IS ORDERED that the above cause shall be reheard by this court en banc. The previous panel's opinion is hereby VACATED.

WARREN PUBLISHING, INC.
v.
MICRODOS DATA CORP. et al.

Civ. A. No. 1:90-CV-1654-JOF.

United States District Court, N.D. Georgia, Atlanta Division.

March 31, 1992.

FORRESTER, District Judge:

This matter is before the court on defendant Robert Payne and defendant Microdos Data Corporation's [hereinafter "Microdos"] motion for partial summary judgment; plaintiff Warren Publishing's [hereinafter "Warren"] cross motion for summary judgment; and defendants' motion to compel.

I. Background

This is a copyright infringement case brought pursuant to 17 U.S.C. s 501.

Plaintiff Warren Publishing, Inc., compiles and publishes annually a printed directory known as the "Television and Cable Factbook" [hereinafter "the Factbook"]. The Factbook provides information on cable television systems throughout the country. The subject matter of this case is the 1988 issue of the Factbook. Warren Publishing's Factbook contains two parts, the "Station Volume" and the "Cable and Services Volume," which is the specific part of the Factbook at issue here. The Cable and Services Volume of the Factbook is broken down into two sections regarding cable television systems. There is a "Directory of Cable Systems" section and the "Group Ownership of Cable Systems in the United States" section. These two sections contain approximately 1,350 pages of information on the cable

industry.

The directory of cable systems section arranges entries alphabetically by state and, within each state, alphabetically by the name of the "lead" or "principal" community served by the particular cable system. The group ownership section contains a listing of selected information about entities owning and/or operating more than one cable system. These entities are called multiple system operators, or MSOs. The 1988 Factbook contained information on 8,413 cable systems. Information on each cable system and MSO entry is broken down into a uniform set of "data fields," which provide a specific piece of information about the system. The Factbook uses the same pattern for each cable system entry. The Factbook's format is based on identifying cable systems, then providing information on the cable systems through the use of specific groups of data fields.

Plaintiff has been publishing cable television information since 1948, constantly expanding and adding systems as well as data fields to its works. The Factbook is a copyrighted work with appropriate certificates of registration from the Register of Copyrights. There were 4,453 copies of the 1988 Factbook sold, of which 142 were sold in Georgia. In addition to the Factbook itself, plaintiff will create, for substantial cost, customized reports on the cable television industry for its customers.

Defendant Microdos Data Corporation markets a computer software package called "Cable Access." Cable Access, like the Factbook, provides detailed information on the cable television industry. Defendant Robert Payne is the principal officer, shareholder, director and employee of Microdos Data Corporation. In addition, he is the principal author of the Cable Access software package.

The Cable Access software package is broken into three databases. The first database provides information on the individual cable systems. This database is referred to as "the systems database." The second database provides information on multiple system operators and is simply referred to as "the MSO database." The third database is a historical database which provides selected information on the cable industry from 1965 to the present. Only the systems database and the MSO database are alleged to be infringing upon plaintiff's copyright.

Defendant's Cable Access software package comes pre-sorted by state and city. The customer may rearrange the data in a format of its choosing. The customer may construct searches of the database's information on cable systems as required to fit its particular needs, as well as output the data to a hard copy in various formats, again to fit the specific needs of the customer.

Microdos began marketing Cable Access in 1989. Warren Publishing first became aware of Cable Access in May of 1989. Shortly thereafter, Warren Publishing notified Microdos that it felt that Cable Access was infringing upon its copyright of the Factbook. Upon notification of Warren Publishing's copyright of the Factbook, Microdos ceased marketing the original version of Cable Access for more than seven months. After allegedly recompiling all of the data contained within the Cable Access database, Microdos began marketing the second version of Cable Access in the spring of 1990. Subsequently, Microdos has produced and marketed a third and fourth version of Cable Access. Cable Access version 4 allegedly came out about the same time this suit was filed. All four versions of Cable Access provide detailed information on the cable television industry in essentially the same format. Minor differences do exist in the data fields used in the various versions and the factual information provided in the data fields.

Warren Publishing's complaint alleges that all four versions of Cable Access infringe upon its copyright of the 1988 Factbook.

II. Discussion

The issue pending before the court, in the form of cross motions for summary judgment [FN1], is whether Mircrodos's Cable Access versions 1-4 infringe upon Warren Publishing's copyright of the Factbook as a matter of law.

To prove a copyright infringement claim, two elements must be established: (1) ownership of a valid copyright, and (2) copying of those elements of the work that are original and thus copyrightable. Feist Publications v. Rural Telephone Service Co., --- U.S. ----, ----, 111 S.Ct. 1282, 1296 (1991); BellSouth Advertising and Pub. v. Donnelley Inf. Pub., 933 F.2d 952, 956 (11th Cir.1991); Key Publications v. Chinatown Today Pub. Ent., 945 F.2d 509, 514 (2d Cir.1991). Microdos does not contest the fact that Warren owns a valid copyright for the Factbook. Microdos, however, does contest that it copied any copyrightable portion of the Factbook.

A. Copyrightability [FN2]

Warren Publishing's Factbook is a factual compilation. "A 'compilation' is a work formed by the collection and assembling of preexisting materials or of data that is selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term 'compilation' includes collective works." 17 U.S.C. s 101. Based on this definition, a compilation qualifies for copyright protection when three requirements are met: "(1) The collection and assembly of preexisting data; (2) the selection, coordination, or arrangement of that data; and (3) a resulting work that is original, by virtue of the selection, coordination, or arrangement of the data contained in the

work." Key, 945 F.2d at 512 (citing Feist, 499 U.S. at ----, 111 S.Ct. at 1293). The protected expression in a compilation "is the manner of selection, coordination, or arrangement of the information that constitutes the originality, not the information itself that is accumulated by the 'sweat of the brow.' " BellSouth, 933 F.2d at 957 (footnote omitted).

The court finds that Warren Publishing's Factbook has sufficient originality in its selection, coordination, or arrangement of the data contained therein to be copyrightable, and Mircrodos does not seriously contest that. There is more than the de minimis level of creativity required to create a protectible work. See Feist, 499 U.S. at ----, 111 S.Ct. at 1289, 1297; Bellsouth, 933 F.2d at 957-58; Key, 945 F.2d at 513-14; West Pub. Co. v. Mead Data Cent., Inc., 799 F.2d 1219, 1223-24 (8th Cir.), cert. denied, 479 U.S. 1070 (1986). There is, however, a dispute as to which components of the Factbook's selection, coordination, and arrangement represent original, and thus a copyrightable, component of the work's format. Thus, any determination that summary judgment is appropriate in this case will turn on whether or not there has been substantial copying by Microdos, sufficient to establish infringement, of those elements of Warren Publishing's Factbook that are copyrightable. Bellsouth, 933 F.2d at 958; Key, 945 F.2d at 514.

B. Infringement

The test for copyright infringement, whether it be an original work or compilation, requires a showing that the infringing work is substantially similar to the copyrighted work. [FN3] Key, 945 F.2d at 514; West Pub., 799 F.2d at 1227; Southern Bell Tel. & Tel. v. Assoc. Tel. Directory, 756 F.2d 801, 810 (11th Cir.1985). In the case of compilations, one does not look to the works as a whole to prove substantial similarity. Key, 945 F.2d at 514. "What must be shown is substantial similarity between those elements, and only those

elements, that provide copyrightability to the allegedly infringed compilation." Id. Copyrightability refers to the originality in the work. Feist, 499 U.S. at ----, 111 S.Ct. at 1287-88; BellSouth, 933 F.2d at 957. In a compilation the original, and thereby protected, expression is the work's format. BellSouth, 933 F.2d at 957. The format represents the combination of the work selection, coordination and arrangement of the work's creative elements. Id. [FN4], and the selection, arrangement and grouping of the data fields which provides information on the selected cable systems. If Microdos's Cable Access software package is substantially similar to the 1988 Factbook with regard to the selection of communities or the selection and arrangement of the data fields, then a finding of infringement can be supported. [FN5] See Key, 945 F.2d at 515.

If Microdos's Cable Access has merely appropriated elements in the public domain, then an infringment finding is precluded. Id. The elements of the 1988 Factbook that are not copyrightable are the raw data and facts contained within it. Facts are not copyrightable. Feist, 499 U.S. at ----, 111 S.Ct. at 1287 ("the most fundamental axiom of copyright law is that [n]o author may copyright his ideas or the facts he narrates.' ") (quoting Harper and Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 556 (1985). In Feist the Supreme Court made it clear that the "sweat of the brow" doctrine is invalid, and copyright protection rewards originality, not effort. Feist, 499 U.S. at ----, 111 S.Ct. at 1295.

Therefore, any copying of the facts that make up the data entries in Warren Publishing's Factbook by Microdos, even if substantial, is insufficient to make out an infringement claim. Only if Microdos has copied a substantial portion of Warren Publishing's original elements in the Factbook has infringement occurred. To establish infringement, "there must be a substantial appropriation of the original format of the compilation to constitute the copying of protected material."

Id. (citing Associated Tel. Directory, 756 F.2d at 810); see also 17 U.S.C. s 103. [FN6] Substantial appropriation of the original format occurs when there is a showing of substantial similarity in the work's copyrightable selection, coordination, or arrangement. [FN7]

C. Analysis

Warren contends that Microdos has infringed on the Factbook's copyright in three areas: (1) the communities covered; (2) the data fields; and (3) the data field entries. In order for the court to reach a finding of infringement, the court must find that there is a substantial similarity in the work's copyrightable selection, coordination, or arrangement of any one of the three aforementioned components of the Factbook. [FN8]

1. Communities

Warren Publishing admits that the cable system information coordinated and arranged by the various compilers in the industry is commonly organized alphabetically by state and then alphabetically by community within the states. Warren argues that the choice of communities is not, however, standard within the industry. How one defines a "cable system" will dictate the communities selected to represent those systems.

Warren Publishing uses a "principal community" system in selecting and presenting its information on cable systems contained in its Factbook. A "cable system" is defined as an entity composed as one or more communities that are offered the same service by the same cable system owner at the same price. The principal community, used to represent the entire cable system, is then selected by contacting the cable operator to determine which community is considered the lead community within the cable system. Other

communities within the same cable system are then listed under the principal community, not independently.

In effect, Warren has admitted that the coordination and arrangement of the communities selected for coverage in the Factbook was an obvious, mechanical, or routine task which required no creativity. Therefore, the coordination and arrangement of the communities selected is not copyrightable. However, Warren argues that the selection of those communities was creative and protectible because Warren uses a unique system in selecting the communities that will be represented in the Factbook. The court finds that Warren Publishing's system of selecting communities is sufficiently creative and original to be copyrightable. [FN9]

This position is consistent with other compilation case findings in this circuit. In Bellsouth the court found that the phone company's selection of geographic boundaries, which determined the scope of each directory, was a component of the publication's original format, and thus copyrightable. Bellsouth, 933 F.2d at 957-58. The key is that the publisher of the copyrighted material must have had to make choices regarding the scope and format of the publication, which are not necessarily obvious or standard. In this case a choice was made as to which communities were to be listed. Compare Feist, 499 U.S. at ----, 111 S.Ct. at 1296-97 (white pages) with Bellsouth, 933 F.2d at 958 (yellow pages).

Having determined that the selection of communities was copyrightable, infringement will turn on whether or not Microdos's selection of communities is substantially similar to Warren's.

In a comparison of communities selected for the State of Illinois by the various entities which compile information on cable systems [FN10], Cable Access versions 1-4 are found to be virtually identical to the 1988 Factbook selections. This

is contrasted with a large variation in communities selected for the state by the other entities in the cable system data industry. A total of 880 communities were listed by one or more of the entities publishing works on the cable industry. The FCC, which attempts to list individually every community with a cable system across the country, had the largest listing. The FCC listed 724 communities for the State of Illinois. On the low end of the scale was the Broadcasting Yearbook [hereinafter "the Yearbook"]. It only lists 243 communities for the State of Illinois. The 1988 Factbook listed 406 communities under its principal community concept. Numerous additional communities were listed under the various principal communities but were not separately listed.

By comparison, the first version of Cable Access listed 405 communities for the State of Illinois. The second version of Cable Access contained 394 communities. The third version contained 393 communities. The fourth version contained 398 communities. Warren alleges that all of the communities selected and listed in Cable Access versions 1-3 were also selected and listed in the Factbook, while 20 communities were added to version 4 which are not independently listed in the Factbook. Fifteen of these communities were listed by Warren as being served by another principal community. This represents a match of 99.75% (405 of 406) in version one, 97.00% (394 of 406) in version two, 96.80% (393 of 406) in version three, and 98.00% (398 of 406) in version four, of communities selected and listed by the Factbook and Cable Access. This is compared to, assuming that every community listed by the smaller publication is contained in the larger publication listing, a match of 59.85% (243 of 406) between the Yearbook and the Factbook, and 56.10% (406 of 724) between the Factbook and the FCC. [FN11]

Microdos argues that Warren is not correct in its allegations regarding the degree of similarity in the

communities selected. Microdos argues that a review of the record would reveal at least 20 communities selected by Microdos and listed in Cable Access were not selected and listed in the Factbook, not complete identity in the communities selected by Microdos as claimed by Warren. [FN12] Assuming this is true, the correlation between the Factbook and Cable Access in communities selected and listed would still be 94.85% (385 of 406) for version 1, 92.10% (374 of 406) for version 2, 91.85% (373 of 406) for version 3, and 93.10% (378 of 406) for version 4.

The correlation between the Factbook and Cable Access is ten percent (or more) higher than a comparison of the FCC's listing of communities selected compared to the total number of communities selected by all the other various entities in the industry. The FCC listed 724 communities, while the other entities listed a total of 880, giving a correlation of just 82.25%. Thus, the correlation between the Factbook and Cable Access is significantly higher, under either party's alleged facts, than the industry-wide community selection process as compared to the FCC's baseline.

Microdos argues that even if a high correlation of communities selected existed, that this would not represent evidence of infringement. This correlation is simply the result of Microdos and Warren using similar, yet independent, community selection processes which result in similar results. Microdos stated that "Cable Access determines its listings in most cases by combining FCC listings bearing the same 'system-ident' code [FN13], and then listing under either the major community in that service area or the community where the 'headend' (the point at which the satellite signal is received for distribution) is located." Microdos does not state how it determines the "major community" in the system or how it determines the community listed in those "other cases." Nor does Microdos provide information as to what percentages of its selected communities are determined by which method.

Microdos simply argues that its system provides essentially the same list of communities as Warren's principal community system.

Warren contests Microdos's claims that it uses an independent process based upon the FCC's system-ident codes to arrive at substantially similar results in its selection of communities. [FN14] Based upon an analysis of the FCC system-ident methodology Microdos asserts that it uses in selecting communities, Warren argues that at least 21 communities in Illinois, which were grouped together with other communities in both the Factbook and Cable Access, would not have been grouped together under the FCC system-ident selection process because they had individual system-ident numbers. [FN15] The communities should have been listed separately. Yet, Microdos's Cable Access listed the communities under a single community, which in each case was the same as the principal community selected by Warren in the Factbook. Therefore, Warren argues that Microdos must have copied the Factbook.

Further, there are 80 communities or groups of communities with unique system-ident codes which are not listed as a principal community in the Factbook and which correspondingly are not listed in Cable Access. Nor are any of eighteen communities with specific FCC system-ident numbers which are not listed anywhere in the Factbook, listed at all in Cable Access. Warren argues that at least some of these communities would have shown up as separate listings in Cable Access had Microdos not copied the Factbook when selecting the communities to be listed.

In addition, Warren found that numerous communities were listed under multiple FCC system-ident codes, which would prevent Microdos from reaching identical community listings pursuant to their alleged selection process. A multiple listing would make it difficult to determine if a particular

community represented a single cable system. Thus, differences should have resulted in the selected communities.

The court does not agree with Microdos that a high degree of correlation between the communities selected does not represent evidence of infringement. Warren has developed a system for selecting communities which is original in the industry. This selection process represents a part of the format of the compilation which is copyrightable. Because the evidence would support a finding of infringement, Microdos must prove that its work resulted from the compilation of information independent of the alleged infringed work. Microdos's only valid defense can be that it arrived at its selected list of communities without copying the Factbook.

Yet, there is virtually no evidence that it relies on any principled criteria for community selection, and the impression is that Microdos copied Warren's selection and then endeavored to mask the copying by minor manipulations. Warren has presented significant evidence contesting Microdos's system of selecting communities. In light of the strong correlation in the selection of communities between the Factbook and Cable Access, Microdos may not merely rely on an assertion that their system produces substantially similar results as Warren's system to select communities. Microdos must produce detailed evidence showing how they arrived at their system and how that system works to produce substantially similar results. This Microdos has not done.

Therefore, because Warren has met its burden to prove that "a substantial appropriation of the original format of the compilation to constitute the copying of the protected material [occurred]," BellSouth, 933 F.2d at 957, Microdos's motion for summary judgment on this issue is DENIED, and Warren's cross motion for summary judgment on this issue is GRANTED.

Although the court realizes that any further discussion of potentially infringing components of Microdos's Cable Access is necessarily moot given the finding of infringement above, the court believes that a complete record is necessary to protect the interests of justice and prevent an unnecessary remand should the parties appeal this decision and the court of appeals subsequently reverse the court on the issue of infringement concerning the communities selected. Therefore, the court will address Warren's arguments that Microdos infringed Warren's copyright of the Factbook by substantially appropriating the selection, coordination, and arrangement of the Factbook's data fields and data field entries.

2. Data Fields

Warren argues that Microdos has misappropriated its "data fields" in all versions of Cable Access. Warren alleges that the infringement is based upon the copying of the arrangement and selection of the same group of data fields, not the copying of any single data field or the facts that go into any particular data field. The sequencing and arrangement of the data fields represent original expression which is copyrightable. Warren argues that the use of the same group of data fields necessarily leads to the same content and format, thereby representing infringement of the copyrightable portion of Warren's compilation. [FN16]

Warren further argues that the nearly identical level of correspondence between the Factbook and Cable Access is not found between the Factbook and other publications. [FN17] According to Warren's breakdown of the data fields, Cable Access version 1 contained 28 out of 32 possible data fields, or 87%. [FN18] Cable Access versions 2 and 3 contain 30 out of 32 data fields, or 94%. [FN19] Broadcasting Yearbook has 24 out of 32 data fields, or 75%. CableFile has 21 of 32 data fields, or 66%. The FCC has only 12 of 32 data fields, or 37%. [FN20] Thus, Warren argues that there is substantial

similarity, well above the other publications in the industry, between the Factbook and Cable Access selection and arrangement of data fields which warrants a finding of infringement.

Microdos counters by arguing that standard categories of information are contained in all major competing publications. Particular data fields were chosen after market research into the industry's desired requirements, and the sequencing of those data fields follows normal conventions, FCC records and organization of data into functional groups. Thus, the fact that there might be a high correlation in the data fields selected does not dictate a finding of infringement.

Further, Microdos argues that the actual number of data fields that are identical in Cable Access and the Factbook are far less than the numbers cited by Warren. Microdos argues that one must look at the subcategories of the data fields in addition to the major categories selected. Under such a comparison Microdos argues the correlation percentage drops significantly. In addition, Microdos argues, if one did not count those data fields that are uniformly used, such as name and address, then the correlation percentage would also drop. [FN21]

To determine if infringement occurred, the court first decides if the Factbook's selection, coordination, or arrangement of its data fields is sufficiently creative to warrant copyright protection and then must look to see if Microdos's Cable Access is substantially similar to Warren's Factbook in its selection, coordination, or arrangement of its data fields. BellSouth, 933 F.2d at 959 (citing 17 U.S.C. s 101). The court finds that Warren's selection of its data fields does not represent sufficient originality to warrant copyrightability, however, the Factbook's coordination and arrangement of its data fields are sufficiently creative and original to be copyrightable. [FN22] Feist, 499 U.S. at ----, 111 S.Ct. at

1289 ("These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws. [Cit.]"). Further, the court finds that Microdos's coordination and arrangement of its data fields are not substantially similar to the Factbook's. Therefore, no infringement of Warren's data field format occurred.

a. Selection

Essentially, the court finds that the vast majority of data fields selected by the competing works are obvious to those in the cable industry, and, therefore, the selection of data fields to be incorporated into the published works does not require the creativity and originality necessary to permit the attachment of copyright protection. The court's findings are supported by a comparison of the various data fields selected by the various publications in the industry. Attached as Exhibit 1 is a copy of the data field comparison entered into evidence by Warren to prove the high degree of correlation between the data field entries. Although the court agrees with Warren that there is a high degree of correlation between the data field entries in the Factbook and the various versions of Cable Access, the court finds that this fact alone does not warrant a holding of infringement.

Contrary to Warren's assertions, the court does not find that "the same group of data fields necessarily leads to the same content and format thereby representing infringement." When analyzing the issue of data field infringement in this case, quite the opposite is true. The selection of the data fields is obvious and limited given the known interests of the cable industry, and the coordination and arrangement of these data fields represents the original and creative components of the copyrightable work.

The court's Exhibit 1 has rearranged the data fields listing in order to show that the vast majority of the data fields selected are readily known and obvious to those in the industry. A review of Exhibit 1 shows that the Factbook provides information on the largest number of data fields, of publications existing at the time infringement allegedly occurred. Cable Access contains every data field selected by the Factbook in a least one of its versions. The Yearbook and CableFile provides slightly fewer data fields in their respective works, and the FCC compiles information on less than half of the data fields published by the Factbook. However, out of all the data fields selected by the Factbook, only three of those data fields are not contained in either the Yearbook or CableFile. [FN23] In addition, Cable Access provides two data fields that have not been used by any other publication in the industry. [FN24]

These facts prove to the court that the vast majority of the data fields are obvious to those in the industry. Clearly, the types of information desired by subscribers to publications on the cable industry are fairly standard. There simply is not the creativity necessary in the selection of the data fields to be published to warrant copyright protection.

This conclusion is analogous to the findings in previous compilation infringement cases. In BellSouth the Eleventh Circuit found that the selection of categories and the coordination of the informational components in the business listings constituted the copyrightable format which was infringed. BellSouth, 933 F.2d at 959-960. Arrangement or appearance in the two publications was found to be different and, therefore, insignificant when determining if infringement occurred. Id. Although in BellSouth it was the arrangement which was discounted by the court rather than the selection as is the case here, the copying of the overall format, or the original and copyrightable portions of the work, was the key to the infringement finding. Id. Thus, the BellSouth court found

that the arrangement of listing in the phone directory was not copyrightable because of its obviousness. Here, the court finds that the selection of data fields is obvious and, therefore, not copyrightable.

In Key Publishing, the Second Circuit found that no infringement had occurred, even though there had been substantial overlap in the selection of businesses listed in the two publications. Key, 945 F.2d at 515-16. The court held that the key issue was not "whether there is overlap or copying but whether the organizing principle guiding the selection of businesses for the two publications is in fact substantially similar." Id. at 516. In addition, the fact that the percentage overlap between the publications was low, seventeen percent, was a factor in the holding. Id. at 515. Nonetheless, the court noted that because there was a finite number of businesses that would be relevant to the publications in issue, a substantial overlap was inevitable. Id. at 516. Similarly, here there is an inevitable overlap which precludes infringement.

b. Coordination and Arrangement

As the court previously noted, the Factbook's coordination and arrangement of its data fields are creative and copyrightable. Should Cable Access coordination and arrangement of its data fields be found to be substantially similar to the Factbook's, a finding of infringement would be mandated. The court holds that there is not sufficient substantial similarity in the work's "overall format" or "organizing principle" to warrant a finding of infringement. See Key, 945 F.2d at 516; BellSouth, 933 F.2d at 960. Simply stated, there has not been substantial appropriation of the Factbook's copyrightable components of its coordination and arrangement of its data fields, such as its tier format. Further, Cable Access in its coordination and arrangement has shown sufficient creativity to preclude infringement.

The protection afforded compilations is very narrow, and any significant differences in the alleged infringing publication's coordination and arrangement will prevent a finding of infringement. Feist, 499 U.S. at ----, 111 S.Ct. at 1289. ("[T]he copyright in a factual compilation is thin. ..., a subsequent compiler remains free to use the facts contained in another's publication ..., so long as the competing work does not feature the same [coordination] and arrangement."). Such is the case here. Microdos's coordination and arrangement of its data fields in the Cable Access works are sufficiently different from the Factbook's to represent originality on its part which precludes a finding of infringement of Warren's copyright of the Factbook.

The clearest example of the differences that exist in the Factbook and Cable Access' format and arrangement of their respective data fields is found in a visual comparison of the two works. [FN25] Comparing the Factbook individually with Cable Access, the visual differences are striking. The Factbook has a four-column format for the page and a single column for the individual community entries. Each individual entry provides general information (address and phone number) on the cable system under the "community" in question; then provides "basic service" information; followed generally by information on the cable system's pay services listed under the "tiers" available; and then ends the listing with information on the "equipment" used, "miles of plant," "manager" of the system, and "ownership" of the system (in that order). By contrast, Cable Access [FN26] for each individual community entry provides, in a page-wide format, general information under the "systemname"; then in a three-column format provides subscriber information on the left, with cable system and equipment information in the center, and community information on the right; the entry concludes with MSO information. The last three data fields return to a page-wide format rather than a column format. Thus, Cable Access' "full record" format has significant

differences in its facial appearance and format from that of the Factbook. These differences would be even greater when the Cable Access user merely wants to pull up limited information on any cable system or systems rather than the full record format stored on the data base.

This analysis is further supported by a visual comparison of the Factbook to the Yearbook. Although the Yearbook uses fewer data fields contained in the Factbook than does Cable Access, the Yearbook's format and arrangement appear far more similar to the Factbook than does Cable Access'. [FN27] The Yearbook, in a three column page-wide listing format with a single column format for individual communities, lists information on the "community" in question starting with general information (address and phone number); followed by information on the cable system and the community (subscriptions, homes, costs); followed by "pay cable" information; then "basic cable" information; and concludes with "ownership" information. This organization is significantly closer to the Factbook than is Cable Access. In effect, both provide general information followed by specific information on both the basic and pay services available.

Both the Factbook and the Yearbook provide information in essentially a paragraph format. The court presumes this format is meant to provide easier reading for the subscriber. The only real difference in these works' selection and arrangement formats is the exact order in which the information is presented. The Factbook provides "basic service" information first, followed by pay information in a "tier" format. The Yearbook provides "pay cable" information, followed by "basic cable" information. In addition, there are minor differences in the location of specific data fields within the overall arrangement pattern. For example, the Factbook provides basic service costs in its "basic service" section, while the Yearbook provides the basic service costs under its general cable system and community

information section prior to its "basic cable" section.

The court also finds that the Factbook and the Yearbook provide essentially the same information in essentially the same format, whereas Cable Access provides only limited information as compared to the other two. The clearest example is a comparison of the works' pay service sections. [FN28] The Factbook uses their "tier" format, in which they provide the specific channels provided under that tier and the cost for that service, whereas the Yearbook simply lists the number of channels available and then provides in parentheses the different channels and their cost. The specific channels listed by the Yearbook directly match the order of the channels listed under the various tiers within the Factbook. Conversely, Cable Access only lists the pay channels available without providing any specific costs (in this section of the entry), and their order is different from that in the Factbook and the Yearbook.

The court finds that the Factbook's and the Yearbook's coordination and arrangement provide for a comprehensive analysis of each cable system, in essentially a paragraph format, which provides for easier reading by the subscriber. Cable Access' coordination and arrangement, on the other hand, provide for a quick reference guide of the cable system, which in many respects provides more limited information. However, Cable Access does provide a quicker scanning format, in which it is easier to focus on specific data files or pieces of information about the cable system in question.

Therefore, the court holds that Microdos has not infringed Warren's copyright as to the Factbook's coordination or arrangement of its data files because of the lack of substantial similarity between the format or organizing principle of the two works. Nor is Warren's selection of data files infringed, given the obviousness of the selection process, which in turn precludes copyrightability. Thus, Microdos's

motion for summary judgment on this issue is GRANTED, and Warren's cross motion for summary judgment on this issue is DENIED.

3. Data Field Entries

The court agrees with Microdos that Warren's argument regarding Cable Access' alleged substantial copying of the specific data entries contained within the Factbook represents nothing more than a "sweat of the brow argument," which is controlled adversely to Warren by the Feist decision. See Feist, 499 U.S. at ----, 111 S.Ct. at 1295. Mere facts are not copyrightable. Feist, 499 U.S. at ----, 111 S.Ct. at 1287. Therefore, Microdos's motion for summary judgment on this issue is GRANTED, and Warren's cross motion for summary judgment on this issue is DENIED.

III. Motion to Compel

This matter is before the court on defendant's motion to compel discovery. Because the court has determined that no issues of material fact exist in this case, additional discovery is not warranted. Therefore, defendant's motion to compel is DENIED as moot.

IV. Conclusion

Because Microdos has substantially appropriated the copyrightable selection of communities portion of the format of Warren's Factbook, Microdos has infringed Warren's copyright in the Factbook. Therefore, defendant Microdos's motion for partial summary judgment [19-1] is DENIED, and plaintiff Warren Publishing's cross motion for summary judgment [22-1] is GRANTED. Defendant's motion to compel [18-1] is DENIED as moot.

SO ORDERED this 31st day of March, 1992.

FN1. Fed.R.Civ.P. 56 mandates the entry of summary judgment against a party who fails to make a showing sufficient to establish the existence of every element essential to the party's case, and on which that party will bear the burden of proof at trial. See Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986); Brown v. City of Clewiston, 848 F.2d 1534, 1536 (11th Cir.1988). Once the movant carries his burden of asserting the basis for his motion, see Celotex Corp., 477 U.S. at 323, the non-moving party is then required "to go beyond the pleadings" and present competent evidence designating "specific facts showing that there is a genuine issue for trial." Id. at 324. To survive a motion for summary judgment, the non-moving party must come forward with specific evidence of every element material to his case so as to create a genuine issue for trial. See Celotex Corp., 477 U.S. at 323; Brown, 848 F.2d at 1537.

FN2. The scope of subject matter afforded copyright protection is defined in section 102 of the Copyright Act of 1976, Pub.L. No. 94-553, 90 Stat. 2544, which states: (a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.

* * *

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work. 17 U.S.C. s 102.

FN3. Warren has proven, and Microdos does not contest that it had access to the copyrighted material (the Factbook). See Southern Bell Tel. & Tel. v. Assoc. Telephone Dir., 756 F.2d 801, 811 (1985)

FN4. This is not to say that the selection of cable systems would be copyrightable in all cases. Had Warren selected every cable system listed by the F.C.C., then there would not be sufficient originality in the "selection" to warrant copyrightability.

FN5. The fact that Cable Access is a computer software database rather than a hard copy book is irrelevant. The Eleventh Circuit has held that the act of keying information into a computer database is copying sufficient to permit a copyright infringement claim. BellSouth, 933 F.2d at 958.

FN6. This infringement standard is consistent with the scope of copyright protection given compilations and derivative works under the Copyright Act. Section 103 states in pertinent part: (a) The subject matter of copyright as specified by section 102 includes compilations and derivative works[.] (b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or substance of, any copyright protection in the preexisting materials. 17 U.S.C. s 103.

FN7. Both parties have agreed to use Illinois as a representative sample of their respective works in determining if infringement occurred.

FN8. The fact that Cable Access is a computer software database rather than a hard copy book is irrelevant. The Eleventh Circuit has held that the act of keying information into a computer database is copying sufficient to permit a copyright infringement claim. BellSouth, 933
F.2d at 958.

FN9. This is not to say that the selection of cable systems would be copyrightable in all cases. Had Warren selected every cable system listed by the F.C.C., then there would not be sufficient originality in the "selection" to warrant copyrightability.

FN10. Specifically, a comparison of the Factbook, Cable Access, the Yearbook, and the FCC publications was entered into the record evidence.

FN11. No information was provided comparing the communities selected by CableFile to the Factbook.

FN12. Microdos does not state which versions of Cable Access contain the 20 different communities. Warren's analysis of Microdos's Cable Access version 4 stated that 20 communities were added to that version. The court believes that these additions are the basis of Microdos's allegations that Warren's figures are incorrect regarding the complete identity of communities selected. Thus, only version 4 should have the community comparison percentages reduced, but because of the potential uncertainty, and because the facts should be viewed in the light most favorable to the party opposing summary judgment, the court has looked at revised percentages for all versions. The differences are not significant in any case.

FN13. The FCC's "system-ident" code groups communities together that are provided service by the same cable company in the same state. Thus, even though the FCC attempts to list every community provided some form of cable service, the FCC cross references the individual cable operators providing these services by way of these identification codes in order to determine the group of communities provided services by any one cable system operator. See Aff. of Robert Payne, P 12; Id. at Exhibit D; see also FCC Form 325-schedule 2

Operator's Statistic Report.

FN14. See Supplemental Affidavit of Lynn Levine.

FN15. Warren's analysis of Microdos' system-ident code based selection process used community information contained in Cable Access version 3. The specific example cited was a comparison of the Blue Mound, Illinois cable system listing in the Factbook which includes the Stonington, Illinois community, with the FCC listings, which provides separate system- ident numbers for the two communities.

FN16. In addition, Warren argues that, contrary to Microdos's allegations of uniformity, the sequencing and organization of the data fields in the various publications differ significantly. Warren cites CableFile's listing of cable systems by state and then company name, and the Yearbook's varying listings (with various numbers of data fields in the listings) as two predominant examples.

FN17. Warren provided a table comparing the data field entries of the various competing publications in the cable industry market. See Exhibit 15 of the Supplemental Affidavit of Lynn Levine.

FN18. No comparison was apparently made between the Factbook and Cable, Access version 4 data fields.

FN19. In addition, both Cable Access versions 2 and 3 contained two data fields not contained in the Factbook.

FN20. Microdos alleges that virtually all information contained in the Factbook can be found in various FCC publications or other public sources. Microdos further argues that Warren apparently only looked at one such report when determining the number of corresponding data fields between the two. However, Microdos does not specify the exact

number of data fields it believes correspond between the two entities, or exactly which FCC publications provide additional data field information. Moreover, the FCC confirmed in a letter to Warren that the items listed in Warren's Data Field Comparison were the only categories of data that the FCC collected on the cable industry in the years in question. The data was collected on FCC Form 325, Schedules 1 and 2.

FN21. Although true, the percentage drop would be uniform across the industry so that there would be no difference in a comparison of the various correlation percentages. All the numbers would simply be proportionally lower.

FN22. Specifically, the Factbook's tier format is original.

FN23. The three data fields are "Miles to be Rebuilt," "Franchise Expiration Date," and "Sale Date." See Exhibit 1, under the shaded section.

FN24. The two data fields are "Sale Price" and "FIPS." See Exhibit 1, under the shaded section.

FN25. See Affidavit of Robert Payne at Exhibit C.

FN26. This comparison is based on Cable Access version 4. See Affidavit of Robert Payne at Exhibit A-3.

FN27. The specific example contained in the record evidence compared the Fact Book, the Yearbook, and Cable Access' "Gibson City, Illinois" cable system entries. See Affidavit of Robert Payne at Exhibit A.

FN28. Looking again at the "Gibson City, Illinois" cable system comparison, printed below is the specific "data field" information contained in the various works under their respective "pay services" sections.

The Fact Book

Tier 1
Subscribers: 69(01/01/87). Began: September 1, 1985.
Programming (via satellite): Disney Channel.
Fee: $15.00 installation; $8.95 monthly.
Tier 2
Subscribers: 301 (01/01/87). Began: July 1, 1979.
Programming (via satellite): HBO
Fee: $15.00 installation; $10.00 monthly.
Tier 3
Subscribers: 41 (01/01/87). Began: September 1, 1985.
Programming (via satellite): Playboy Channel.
Fee: $15.00 installation; $10.00 monthly.

The Yearbook

Pay cable: 4 chs (Disney; 80 subs; $8.95/mo.); (HBO; 307 subs;
$10/mo.); (Playboy; 48 subs; $10/mo.); (Showtime; 104 subs; $10/mo.).

Cable Access

PAYSERVICE HBO, SHO, DIS, PLAY

17 U.S.C. § 101. Definitions

* * *

A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term "compilation" includes collective works.

17 USC § 102. Subject matter of copyright: In general

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) literary works;
(2) musical works, including any accompanying words;
(3) dramatic works, including any accompanying music;
(4) pantomimes and choreographic works;
(5) pictorial, graphic, and sculptural works;
(6) motion pictures and other audiovisual works;
(7) sound recordings; and
(8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

17 USC § 103. Subject matter of copyright: Compilations and derivative works

(a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

(b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

MOTION FILED

OCT - 3 1997

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No. 97-376

IN THE

Supreme Court of the United States

October Term, 1997

WARREN PUBLISHING, INC.,
Petitioner,

v.

MICRODOS DATA CORP., *et al.*,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE AND BRIEF AMICUS CURIAE OF INFORMATION INDUSTRY ASSOCIATION IN SUPPORT OF PETITIONER

STEVEN J. METALITZ
Counsel of Record
SMITH & METALITZ, LLP
1747 Pennsylvania Avenue, NW
12th Floor
Washington, D.C. 20006-4604
(202) 833-4198

WILLIAM R. ASHWORTH
INFORMATION INDUSTRY ASSOCIATION
1625 Massachusetts Avenue, NW
Suite 700
Washington, D.C. 20036
(202) 319-0143

38 pp

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MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE

The Information Industry Association ("IIA"), a not-for-profit national trade association established in 1968 and representing the interests of domestic and international information content providers, respectfully moves for leave to file the attached brief *amicus curiae* in this copyright infringement case.* The consent of the attorney for petitioner has been obtained. The consent of the attorney for the respondent was requested but refused.

IIA represents over 550 companies involved in the creation and delivery of information products and services. These

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* IIA's membership list is contained in the Appendix hereto.

companies range from large publishing concerns to small businesses to sole proprietors. Many of IIA's members produce databases which require a great deal of creative, financial and human resources to organize, compile and produce. These information products are efficiency-enhancing resources to the economy. They provide specialized information for business, education and consumer uses, which is essential in promoting global competition in the evolving information age.

The information industry has become an important sector of the U.S. economy, and creatively selected and arranged compilations of data -- particularly electronic databases -- have proven to be essential to the success of the growing information marketplace. Database providers represented by IIA rely on copyright law as a key element in the protection required to help assure the opportunity for a fair return on their investments in the creative compilations they produce, and as an incentive for the creation of new databases and the maintenance of the accuracy and currency of existing databases. The national uniformity of copyright law is a critical requirement that enables these providers to serve national (and international) markets efficiently and competitively. The advent of the Internet, which knows no geographic boundaries, intensifies the need for copyright law to be applied in a uniform fashion. The Eleventh Circuit's decision, *Warren Publishing, Inc. v. Microdos Data Corp.*, 115 F. 3d 1509 (11th Cir. 1997), encroaches upon this national uniformity and threatens to lessen the incentive for database providers to continue making their works widely available.

The petition in this case raises issues of the scope and application of this Court's seminal decision on copyright protection for compilations, *Feist Publications Inc. v. Rural Telephone Services Co., Inc.*, 499 U.S. 340 (1991). It also

addresses important questions of the interpretation and application of the exclusions from copyright protection set forth in Section 102(b) of the Copyright Act, 17 U.S.C. §102(b), and seeks the resolution of conflicts between the circuits. The thoughtful resolution of all these issues is vital both to the database industry that IIA represents, and to the businesses, researchers and consumers who depend upon it.

The participation of IIA as *amicus curiae* at this stage will assist the Court in evaluating the arguments presented in support of, and in opposition to, the petition, particularly in terms of the practical impact of the decision below upon a dynamic and growing sector of the U.S. economy. In IIA's view, the Court should grant the petition and hear this case for five principal reasons, which are set forth in more detail in the accompanying Brief:

1. The decision below misapplied this Court's unanimous decision in *Feist* with regard to the standard of originality required to qualify a compilation of factual data for copyright protection. As a result, contrary to Congress' intent and to this Court's precedent, the Eleventh Circuit denied copyright protection to a commercially useful compilation that features a selection, coordination and arrangement of data heretofore unknown in the cable television industry market which petitioner serves.

2. The decision below misinterpreted Section 102(b) of the Copyright Act when it denied copyright protection to petitioner's compilation on the ground that it constituted an unprotectible "system." This holding is flatly inconsistent with the well-recognized distinction between an unprotectible system and its copyrightable expression.

3. The decision below misinterpreted the merger doctrine of copyright law, also codified in Section 102(b) of the Copyright Act, in such a way as to virtually deny copyright

protection to any commercially significant compilation of data, in contravention of the intent of Congress and the decision of this Court in *Feist*.

4. The decision below incorrectly treated commercial usefulness as a bar to copyrightability, contrary to almost a century of well-established copyright doctrine.

5. The decision below reflects a split among the circuits, since the Eleventh Circuit stands virtually alone in its excessively restrictive approach to compilation copyright. The petitioner's compilation would almost certainly have been accorded copyright protection had this case arisen in another circuit.

Letting this precedent stand will surely dampen incentives for investment in database development and innovation, with clear negative consequences for the growing sector of businesses, professionals, researchers and consumers who increasingly rely upon these products to meet their information needs. Denial of the petition will also perpetuate the circuit split and thus the regional balkanization of copyright law in this critical, complex area so important to the national economy.

As an association representing the leading database providers in the nation, IIA is in a unique position to articulate to the Court the viewpoint of a major sector of the nation's economy that the Eleventh Circuit's decision will adversely impact. IIA is well situated to assist the Court in understanding the broad policy and business implications of this case.

IIA's brief focuses on these legal and policy issues. We respectfully request that the Court grant IIA's motion and that its brief be considered by the Court in conjunction with the petitioner's request for a grant of writ of certiorari.

Respectfully submitted,

/s/ Steven J. Metalitz

STEVEN J. METALITZ
Counsel of Record
SMITH & METALITZ, LLP
1747 Pennsylvania Avenue, NW
12th Floor
Washington, D.C. 20006-4604
(202) 833-4198

WILLIAM R. ASHWORTH
INFORMATION INDUSTRY
ASSOCIATION
1625 Massachusetts Avenue, NW
Suite 700
Washington, D.C. 20036
(202) 319-0143

October 3, 1997

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IN THE

Supreme Court of the United States

October Term, 1997

No. 97-376

WARREN PUBLISHING, INC.,
Petitioner,

v.

MICRODOS DATA CORP., *et al.*,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

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BRIEF AMICUS CURIAE OF INFORMATION INDUSTRY ASSOCIATION IN SUPPORT OF PETITIONER

INTEREST OF AMICUS CURIAE[1]

The interest of *amicus curiae* is set forth in the foregoing motion.

SUMMARY OF THE ARGUMENT

If left undisturbed, the decision below could have a serious detrimental impact on the database industry and on the broader information sector that depends upon copyright protection for original compilations and for other works of authorship. It

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[1] No counsel for any party had any role in authoring this brief, and no person other than the named amicus and its counsel made any monetary contributions to its preparation.

denies copyright protection to precisely those compilations -- comprehensive, logically organized, practically useful databases -- that have both the greatest potential commercial viability and value, and require the greatest sustained investment of creative, human and financial resources in order to produce, distribute and maintain.

This case also exemplifies a split among the circuits on the approach to compilation copyright in the wake of this Court's seminal decision in *Feist Publications Inc. v. Rural Telephone Services Co., Inc.*, 499 U.S. 340 (1991). In the decision below, the Eleventh Circuit in effect held that for fact-based works, creativity at the level of selecting the categories within which information will be arranged in a compilation is insufficient as a matter of law to support copyrightability. By contrast, the Second and Fifth Circuits have held precisely to the contrary: that creativity in the selection of categories of information to be published can suffice to meet the originality threshold for copyrightability. *See, e.g., Engineering Dynamics, Inc. v. Structural Software, Inc.*, 26 F. 3d 1335 (5th Cir. 1994), *opinion supplemented on denial of rehearing*, 46 F.3d 408 (5th Cir. 1995); *Kregos v. Associated Press*, 937 F. 2d 700 (2d Cir. 1991); *Key Publications, Inc. v. Chinatown Today Pub. Enterprises, Inc.*, 945 F. 2d 509 (2d Cir. 1991). Furthermore, the Eleventh Circuit has misinterpreted Section 102(b) of the Copyright Act and the merger doctrine of copyright law also codified in Section 102(b) and has incorrectly treated commercial usefulness as a bar to copyrightability. All these holdings directly conflict with recent decisions of the Second Circuit.

The decision below has grave implications for providers of databases and other compilations and for the public which benefits from the creation and dissemination of such works. By adopting a standard of originality that is far more demanding

than *Feist* contemplated or than other courts of appeal have applied, the Eleventh Circuit has created profound uncertainty about the scope of protection afforded information products and services. This is especially troublesome as the advent of electronic commerce ushers in an age where creative compilations of data can be easily copied and sent instantaneously across domestic and international borders. The Supreme Court should hear this case in order to clarify the minimal standard of originality articulated in *Feist,* reaffirm that originality in categorical selection and arrangement suffices for copyright protection, and resolve the split among the circuits.

I. THE ELEVENTH CIRCUIT IMPOSED A STANDARD OF ORIGINALITY ON WARREN'S FACTBOOK THAT IS INCONSISTENT WITH THE STANDARD OF ORIGINALITY FOR COMPILATIONS ARTICULATED BY THE SUPREME COURT AND OTHER CIRCUITS.

The decision below misapplied this Court's unanimous decision in *Feist* with regard to the standard of originality required to qualify a compilation of factual data for copyright protection. As a result, contrary to Congress' intent and to the Court's precedent, the Eleventh Circuit denied copyright protection to a commercially useful compilation that features a selection, coordination and arrangement of data heretofore unknown in the cable television industry market which petitioner serves[2].

The Supreme Court addressed the originality requirement for compilations in *Feist.* "Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that

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[2] The facts and procedural history of this case are set forth in the Statement of the Case offered by the Petitioners.

it possess at least some minimal degree of creativity." *Feist*, 499 U.S. at 345, citing 1 M. Nimmer & D. Nimmer, Copyright §§ 2.01 [A], [B] (1990). Furthermore, "the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, 'no matter how crude, humble or obvious' it might be." *Id.*, citing Nimmer, §1.08[C][1].

Most courts, both before and after *Feist*, have denied copyrightability to only the most banal of works, *See, e.g., Victor Lalli Enterprises, Inc. v. Big Red Apple, Inc.*, 936 F. 2d 671 (2d Cir. 1991) (copyright protection denied to chart of horse racing statistics arranged according to purely functional grids with no opportunity for variation); *Sem-Torq, Inc. v. K-Mart Corp.*, 936 F. 2d 851 (6th Cir. 1991) (no originality found in plastic lettered "For Rent"/"For Sale" signs compiled in a set); *Mid America Title Co. v. Kirk* , 59 F. 3d 719 (7th Cir. 1995) (real estate title commitment lacks requisite originality since selection of preexisting factual information was not a matter of personal taste but a matter of convention and strict industry standards).

Many courts have applied the *Feist* standard to find originality (and hence, copyright protection) in compilations of data. *See, e.g., Engineering Dynamics, Inc. v. Structural Software, Inc.*, 26 F. 3d 1335, 1343-44 (5th Cir. 1994) (input and output formats of user interface program protectible under copyright); *CCC Information Services, Inc. v. Maclean Hunter Market Reports* 44 F. 3d 61, 67 (2d. Cir. 1994) ("*CCC Information*") (publisher's predictions of values of used cars based on variety of informational sources and professional judgment sufficiently original to warrant copyright protection); *Kregos v. Associated Press*, 937 F. 2d 700, 705 (2d Cir. 1991) ("*Kregos*") (selection of nine statistics for inclusion in baseball pitching form demonstrates sufficient originality); *Key*

Publications, Inc. v. Chinatown Today Publishing Enters., Inc. 945 F. 2d 509, 514 (2d Cir. 1991) (*"Key"*) (yellow pages tailored to local Chinese-American community entailed sufficient originality in selection).

Apparently alone among the courts of appeal, the Eleventh Circuit has adopted a standard of originality more rigorous than that spelled out in *Feist*. The divergence occurs not in the first prong of the originality test -- whether the work was independently created by the author (as opposed to copied from other works) -- but rather in what constitutes "at least some minimal degree of creativity." *Feist,* 499 U.S. at 345. The Eleventh Circuit's misunderstanding of "creativity" not only thwarts the uniformity which the Constitution and the Copyright Act seek to preserve, but threatens the growth of the information industry.

The Eleventh Circuit's deviation from the path marked by *Feist,* and subsequently followed by the other courts of appeal, was evident as early as its *en banc* decision in *BellSouth Advertising & Publishing Corporation v. Donnelly Information Publishing, Inc.*, 999 F. 2d 1436 (11th Cir. 1993), which reached a result contrary to *Key* with respect to copyright protection for a yellow pages directory. [3] The decision below

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[3] In assessing the divergent approaches of the Second and Eleventh Circuits involving the copyrightability of yellow pages directories, one author described the Second Circuit's decision in *Key* as adopting an original elements test, which focuses on whether there is a particular original element in the directory -- whether it be a creative selection of businesses or arrangement of a directory in several different categories. By comparison, the Eleventh Circuit's decision in *BellSouth*, adopts a "general format" test, which bases a finding of originality on the uniqueness of the format. Ethan L. Wood, Note, *Copyrighting the Yellow Pages: Finding Originality in Factual Compilations*, 78 Minn. L. Rev. 1319 (1994).

represents the culmination of this deviation. It seems that under the Eleventh Circuit's view, creativity at the level of selecting the categories or headings to be included can never be sufficiently original to support copyright, regardless of how the compiler selected the headings and arranged the information under them. *See id.* at 1440-1442.

As the Second Circuit articulated in *CCC Information*, the "thrust of the Supreme Court's ruling in *Feist* was not to erect a high barrier of originality requirement. It was rather to specify, rejecting . . . 'sweat of the brow,' that some originality is essential to the protection of authorship, and that the protection extends only to those original elements." *CCC Information,* 44 F.3d at 66. Recognizing this modest threshold, the Second Circuit has afforded copyrightability to compilations which exhibit some editorial judgment in the selection of categories of data to be published.

Warren's acts of selection, as comprehensively cataloged in the dissent to the decision below, *Warren Publishing, Inc. v. Microdos Data Corp.,* 115 F. 3d 1509, 1522-23 (11th Cir. 1997) (Godbold, J., dissenting), clearly surpassed the low threshold set by *Feist.* The *Feist* test does not demand a high level of creativity. Indeed, "it does not require that facts be presented in an innovative or surprising way." *Feist*, 499 U.S. at 361. Nor does it require that the arrangement and selection of facts be novel or unique. *Id.* at 358. However, Warren's acts of selection satisfied even more rigorous criteria. Warren used its principal community system to present facts in a way that was unknown in the industry at the time. Warren's database was entirely atypical from the prevailing industry standard. It was not, as was the white pages directory in *Feist*, "of the garden variety, devoid of even the slightest trace of creativity." *Id.* at 362. By lumping the compilation in this case with the non-copyrightable directory in *Feist*, the court below

strayed so far from the course set by this Court and followed by other circuits as to require this Court's review and correction.

II. THE ELEVENTH CIRCUIT'S INTERPRETATION OF SECTION 102(B) OF THE COPYRIGHT ACT IS INCONSISTENT WITH THAT OF THE SECOND AND EIGHTH CIRCUITS AND CONTRARY TO THE INTENT OF CONGRESS.

Relying on the district court's conclusion that Warren's principle for selecting and arranging information was a "system," the circuit court determined that the plain meaning of Section 102(b) bars the protection of such a "system." Under the Eleventh Circuit's reasoning, any compilation or original work of authorship whose creativity can be categorized as a system is deprived of copyright protection even if the application of that system results in wholly original expression. This fundamentally misconstrues Section 102(b) and the idea/expression dichotomy which it codifies.

Section 102(b) states that:

> In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work. 17 U.S.C. §102(b).

This section represents a codification of the idea/expression dichotomy originally articulated by this Court in *Baker v. Selden*, 101 U.S. 99 (1879), which stated that copyright protection does not extend to ideas; it protects only the original expression of those ideas employed by the author. Professor Nimmer makes the point succinctly:

> Thus, if a given 'procedure' is reduced to written form, this will constitute a protectible work of authorship, so as to preclude the unlicensed copying of 'the expression' of

> the procedure, even if the procedure *per se* constitutes an unprotectible 'idea.' Therefore, although Section 102(b) denies that copyright may 'extend to' an 'idea, procedure, process, etc.,' as contained in a given work, it does not deny copyright to a work merely because that work consists of an 'idea, procedure, process, etc.' Melville B. Nimmer and David Nimmer, Nimmer on Copyright §2.03[D], at 2-35 (1996).

The specific issue of whether a "system" is *per se* uncopyrightable under Section 102(b) was addressed by the Eighth Circuit in *Toro Company v. R & R Products Co.,* 787 F. 2d 1208 (8th Cir. 1986). Like the appellees in the instant case, the appellees in *Toro* argued that Toro's parts numbering system for lawn mower replacement parts was an uncopyrightable "system" under Section 102(b) of the Copyright Act. The district court agreed and granted appellee's motion to dismiss the appellant's copyright infringement claim, finding that Section 102(b) precluded copyright protection for such systems. The circuit court, while affirming the dismissal on other grounds, disapproved the trial court's Section 102(b) analysis. "All that the idea/expression dichotomy embodied in §102(b) means in the parts numbering context is that appellant could not copyright the idea of using numbers to designate replacement parts. Section 102(b) does not answer the question of whether appellant's particular expression of that idea is copyrightable." *Toro,* 787 F. 2d at 1212.

The Eleventh Circuit ignored this distinction. It held that "even if Warren . . . [did] . . . employ a system to select communities to be represented in the book, then section 102(b) of the Act bars the protection of such a system." *Warren Publishing,* 115 F. 3d at 1517. This finding evinces a fundamental misunderstanding of the idea/expression

dichotomy, an error that inevitably shrinks the field of copyrightable compilations to the vanishing point.

Decisions after *Feist* have understood that the use of a principle of selection is the *sine qua non* of most compilations. As the Second Circuit recognized in *CCC Information*, the original element of the majority of compilations will most often be the categorizing principle or system. *See CCC Information,* 44 F. 3d at 70. However, the Eleventh Circuit's approach would eviscerate Congress' intent to provide protection for compilations under Section 103 by categorizing the expression resulting from the application of the categorizing principle as an unprotectible "system."

Under the Eleventh Circuit's logic, the vast majority of compilations will not be entitled to copyright protection, an outcome directly contrary to the expectations of this Court in *Feist. See Feist,* 499 U.S. at 358-59. Section 102(b) does not bar copyright protection for the expression of Warren's system, which was illustrated in its principal/lead community format.

III. THE ELEVENTH CIRCUIT'S APPLICATION OF THE MERGER DOCTRINE IS INCONSISTENT WITH THE APPROACH TAKEN BY THE SECOND CIRCUIT AND CONTRAVENES THE INTENT OF CONGRESS TO AFFORD COPYRIGHT PROTECTION TO COMPILATIONS.

The decision below misinterpreted the merger doctrine of copyright law, also codified in Section 102(b) of the Copyright Act, so as to deny copyright protection to virtually any commercially significant compilation of data, in contravention

of the intent of Congress and in contradiction to the approach adopted by the Second Circuit.[4]

Under this basic tenet of copyright law, when the expression of an idea is inseparable from the idea itself, the expression and the idea "merge," and the expression will be unprotected to insure free public access to the idea. *CCC Information*, 44 F. 3d at 68, (Leval, J.), citing *Kregos,* 937 F. 2d at 705; *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F. 2d 738, 742 (9th Cir. 1971). However, the application of this doctrine to copyright in compilations has been a source of conflict among the circuits. Congress clearly intended to protect original compilations that will advance the progress of science and the useful arts, while the merger doctrine, if construed and applied expansively, could lead to the denial of protection to compilations whose underlying ideas can be expressed in only one or a few ways.

Under Section 103 copyright protection in compilations is limited to the author's original selection, coordination or arrangement of preexisting materials or data. However, as the Second Circuit has noted, "it is apparent that virtually any independent creation of the compiler as to selection, coordination, or arrangement will be designed to add to the usefulness or desirability of his compendium [and] . . . in the case of a compilation . . . such structural ideas are likely to be

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[4] The Eleventh Circuit has chosen to include the merger doctrine in its originality calculus. The Second Circuit, on the other hand, has recommended that it only be used when analyzing the substantial similarity between an alleged infringer's work and the copyright holder's work, rather than in analyzing the copyrightability of the original work, since in the former context it will provide a more realistic basis for evaluating the claim that protection of expression extends to the idea. *Kregos*, 937 F. 2d at 705. Nimmer comments that the Second Circuit's approach is the "better view." Nimmer, §13.03[B] at 13-76 to -78.

expressed in the most simple, unadorned and direct fashion." *CCC Information,* 44 F. 3d at 70.

The Second Circuit squarely addressed this problem in several cases. In *Kregos* the court noted that the inherent tension in the Copyright Act between the protection of creations that will advance knowledge and the need for public access to the ideas underlying the creations is especially acute in the case of compilations. *Kregos,* 937 F. 2d at 705. This is so because "in one sense, every compilation of facts can be considered to represent a merger of an idea with its expression. Every compiler of facts has the idea that his particular selection of facts is useful. If the compiler's idea is identified at that low level of abstraction, then the idea would always merge into the compiler's expression of it. Under that approach, there could never be a copyrightable compilation of facts." *Id.* at 706. The Second Circuit built upon this observation in *CCC Information* by stating that "given the nature of compilations, it is almost inevitable that the original contributions of the compilers will consist of ideas. Originality in selection . . . will involve the compiler's idea of the utility to the consumer of a limited selection from the particular universe of available data." *CCC Information,* 44 F. 3d at 70.

Recognizing the statutory and policy tensions, the Second Circuit deploys the doctrine not in the copyrightability inquiry, but at the infringement stage. Moreover, it applies a test which requires courts to distinguish between ideas which are infused with the personal taste and opinion of the author[5] and those which are essential to the understanding of phenomena or the

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[5] Examples would include the form used to predict the outcome of baseball games in *Kregos*, the telephone directory which only included businesses that the compiler believed to useful to the Chinese-American community in *Key,* or the price valuations in *CCC Information* which reflected the opinion of the author.

solving of problems.[6] Withholding application of the merger doctrine in cases involving the first category would not harm the policy underlying the rule that forbids granting protection to an idea. *CCC Information*, 44 F.3d at 71. The Second Circuit would more aggressively apply the merger doctrine in cases falling in the latter category since the ideas involved therein represent the "building blocks of understanding" and implicate to a greater extent the policy concerns of keeping such ideas in the public domain. *Id.* at 72-73.

In holding that there are very few ways -- if not only one way -- of expressing Warren's principal community system (which is driven by Warren's original conceptualization and definition of an organizing principle), the Eleventh Circuit has adopted an unbridled application of the merger doctrine. Its failure to distinguish selection criteria driven by subjective judgment from those which are purely functional brings it squarely into conflict with the Second Circuit, under whose jurisprudence the petitioner's compilation would almost certainly have been accorded copyright protection, despite the merger doctrine. Given the highly transitory nature of

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[6] Examples of ideas in this category include those which encompass building blocks of understanding or the solving of problems, such as a bookkeeping system, *see Baker v. Selden,* 101 U.S. 99 (1879), ideas or procedures for doing, making or building things, *see Kern River Gas Transmission Co. v. Coastal Corp.* 899 F. 2d 1458 (5th Cir.), *cert. denied,* 498 U.S. 952 (1990), or other concepts which undertake to explain phenomena or furnish solutions. *CCC Information,* 44 F. 3d at 72. As the Court in *CCC Information* noted, this distinction is reflected in the Copyright Office Circular 31 which states that "[c]opyright protection is not available for "ideas or procedures for doing, making, or building things; scientific or technical methods or discoveries; business operations or procedures; mathematical principles; formulas; algorithms; or any concept, process [or] method of operation." *CCC Information,* 44 F. 3d 72 n.22.

electronic commerce, the inherently national market it represents, and the growing importance of databases and other compilations to that market, the Court must resolve this conflict.

IV. THE CIRCUIT COURT INCORRECTLY HELD THAT COMMERCIAL USEFULNESS IS A BAR TO COPYRIGHT PROTECTION FOR COMPILATIONS

The Eleventh Circuit also found that Warren's organizing principle was a mere discovery driven by the needs of the market and thereby lacked the requisite originality for copyright protection. This finding conflicts with well-established copyright dctrine as well as with a recent holding of the Second Circuit.

In discussing the originality requirement for Warren's Factbook, the Eleventh Circuit noted that the "mere discovery of an organizing principle which is dictated by the market is not sufficient to establish creativity." *Warren Publishing,* 115 F. 3d at 1520 n.31. The Eleventh Circuit characterized Warren's unique organization of data as merely a decision to make the Factbook commercially useful." *Id.,* at 1518. It thus erected another bar to copyrightability of compilations by denying protection when a compiler develops a system of selection which responds to the needs of the market.

The decision below is in sharp conflict with the Second Circuit's holding that a finding of commercial usefulness does not negate originality. In *CCC Information,* the Circuit Court explicitly rejected the district court's finding that no originality was shown in the appellant's compilation since it only represented "a logical response to the needs of the vehicle valuation market." *CCC Information*, 44 F. 3d at 67. The Second Circuit recognized the "fact that an arrangement of data responds logically to the needs of the market for which the compilation was prepared does not negate originality. To the

contrary, the use of logic to solve the problems of how best to present the information is independent creation." *Id.* *CCC Information* is only the latest in a long line of copyright cases holding that commercial usefulness is not a consideration for determining original authorship. *See, e.g., Bleistein v. Donaldson,* 188 U.S. 239 (1903).

Information providers and compilation authors routinely tailor their products to the perceived needs of the marketplace, as did Warren. However, under the Eleventh Circuit's analysis, any new principle for organization or selection, no matter how original, would not be entitled to copyright protection if it arose from a motivation to make a database or other compilation "commercially useful." This circuitous reasoning would be fatal to claims of copyright in a wide range of works. Every successful work of authorship could arguably be said to be a response to a market need. Nevertheless, it is still the author who discovers this market niche, synthesizes it in his or her mind and reduces it to tangible form. Under the Eleventh Circuit's reasoning, however, these expressions would not be entitled to copyright protection since they arise from ideas which were already amorphously present in the marketplace, waiting to be discovered. The decision below fails to provide a rationale for this argument, nor does it take into account the practical implications that it would have for the information industry. The Court should take this opportunity to resolve the split between the Second and Eleventh Circuits and to clarify that commercial usefulness, since it is irrelevant to the determination of original authorship, cannot bar copyright protection in compilations or any other works.

V. THE ELEVENTH CIRCUIT'S RULING WILL REDUCE INCENTIVES FOR THE CREATION OF FACTUAL COMPILATIONS

In today's information society, predictable standards of copyright protection are essential to stimulate the inventiveness and creativity necessary to promote the free flow of information in commerce. Without copyright protection, creators of original databases and compilations lack incentive to create new or improved compilations and to maintain the accuracy and reliability of existing databases, for they are denied the full legal arsenal they need to combat piracy of their products and thus seek to achieve a reasonable return on their investments.

If this Court does not clarify the standard of originality in *Feist* as it has been interpreted by the Second and Fifth Circuits and correct the Eleventh Circuit's deviation from that standard, information providers will be faced with uncertainty on the level of protection in various jurisdictions.

As our nation continues to move from a manufacturing to an information services-based economy, the public and private sectors are becoming more dependent on the timely delivery of accurate and reliable data. Information providers expend a tremendous amount of resources and creativity in assembling and delivering useful compilations of data. Although many of these products are still delivered in hard copy to libraries, non-profit institutions and businesses, the advent of the Internet and online commerce portends an acceleration of the trend toward electronic delivery of information products and services. These technological advances leave these products even more vulnerable to unauthorized copying and distribution. If the Eleventh Circuit rule is allowed to stand, or if other circuits follow it, the resulting erosion of incentives means that the

prospects for achieving a robust online information marketplace will be significantly dimmed.

IIA recognizes that facts are not copyrightable. However, the Eleventh Circuit's ruling goes far beyond this maxim and permits -- indeed, invites -- competitors to take the original arrangement and selection of a work with impunity. This is certainly antithetical to the goal of the Copyright Clause -- to stimulate the creation of new works for the benefit of the public.

The Court should also remain mindful that due to the already thin copyright protection afforded compilations, compilers and information providers often rely upon private contracts to prevent piracy and enhance the prospects for a return on their investment. However, while helpful, contracts cannot substitute for copyright. "A copyright is a right against the world. Contracts, by contrast, generally affect only their parties; strangers may do as they please." *ProCD v. Zeidenberg,* 86 F. 3d 1447, 1454 (7th Cir. 1996). If copyright protection for compilations is further restricted by other courts which follow the Eleventh Circuit down the path away from the *Feist* originality standard, marketing methods for many information products would be drastically constrained. Establishing privity would become the paramount goal, so that contractual restrictions on use could be enforced. In this environment, the general public -- the intended ultimate beneficiary of the Copyright Clause -- could find its access to valuable compilations sharply reduced.

CONCLUSION

In order to resolve the conflicts between the Eleventh Circuit and courts of appeal in other circuits, and to ensure that the courts of appeal follow the guidelines articulated by this Court for the analysis of copyright protection for compilations, the Court should grant the writ that petitioners have requested.

Respectfully submitted,

STEVEN J. METALITZ
Counsel of Record
SMITH & METALITZ, LLP
1747 Pennsylvania Avenue, NW
12th Floor
Washington, D.C. 20006-4604
(202) 833-4198

WILLIAM R. ASHWORTH
INFORMATION INDUSTRY
ASSOCIATION
1625 Massachusetts Avenue, NW
Suite 700
Washington, D.C. 20036
(202) 319-0143

October 3, 1997

Appendix

Information Industry Association
Membership Roster

A.T. Kearney
Access Innovations, Inc.
ADIS International Inc.
Advanta Partners LP
AG Communications Systems
Alex Brown & Sons Incorporated
Alimansky Venture Group Inc.
Allied Marketing Group, Inc.
Alpine Meridian, Inc.
AMA CPT Intellectual Property
America Online, Inc.
American Banker/Bond Buyer
American Business Information
American Demographics, Inc.
American Health Consultants
American Stock Exchange
Amulet Inc.
Andersen Consulting Media & Entertainment Group
Architects First Source
AT&T
AT&T EasyCommerce Services
AT&T Global Information Solutions
AT&T HomePlace Services
AT&T Laboratories
AT&T Solutions Customer Care
AT&T WorldNet Services
Atlantic Accord
Australian Stock Exchange
Autex Systems Inc.
Aviation Week Group
Aviation/Aerospace Newsletter
The Baltimore Sun
Bancroft & Whitney
Bankers Trust Company
Barbados Investment & Development Corporation
Barclays Law Publishers
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Belden Associates
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Berkery, Noyes & Co.
Beta Systems Inc.
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Brooks/Cole Publishing Company
Buckman Communications
The Bureau of National Affairs
Burrelle's/VMS NewsAlert
Business Network Inc.
Business Week Group
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BYTE
C.J. Tower, Inc.
Cahners Electronic Media - Industrial Group
Cahners Publishing Company
Cambridge Information Group
Cambridge Scientific Abstracts
Capital Idea, James Inc.
Carbo, Toni
CARCO GROUP INC.
Carfax, Inc.
The Carswell Company Limited
CBOE Trading Operations
CCH Incorporated
CCH Legal Information Services
CCH Washington Service Bureau
CDA Investment Technologies
CDB Infotek
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Charles Schwab Electronic
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Chicago Board of Trade Market Data Services
Chicago Mercantile Exchange/Market Data Services
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CLARITECH Corporation
Clark Boardman Callaghan
Clearnet/The Morris Group
Commercial Information Systems
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Data Control Corporation
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Data Downlink Corporation
Database Technologies, Inc.
Datapro Information Services
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Dow Jones Business Information
Dow Jones Financial News Services
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Dow Jones News Service
Dow Jones Telerate Canada Inc.
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DTN Financial Services
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Electronic Mail & Micro System
Electronic Settlements Group
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GTE Service Corporation
GTE Supply
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GTE Telephone Operations
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Horton, Forest W.
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IHS Environmental Information
IHS Group, Inc.
ILX Systems Inc.
ITP School Publishing
Imark Technologies, Inc.
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Infonautics, Inc.
Information Access Company
Information America
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Information Monitor Co., LLC
Information Resources Group
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Information Today, Inc.
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The InfoWorks Group
Innovest First, Inc.
INSTINET CORPORATION
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Intell.X
Intelpro
Interactive Connection
Interactive Data
Interactive Market Systems
Interactive Video Enterprises
International Database Group
International Development Partners
International Thomson Business
International Thomson Distribution
International Thomson Organisation Ltd.
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International Thomson Publishing Services, Ltd.
International Thomson Transportation
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ITP School Publishing
J.J. Kenny Company Inc.
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North Eastern Evening Gazette

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No. 97-376

IN THE

Supreme Court of the United States

OCTOBER TERM, 1997

WARREN PUBLISHING, INC.,
Petitioner,

v.

MICRODOS DATA CORP., INC., *et al.*,
Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

MOTION FOR LEAVE TO FILE BRIEF *AMICI CURIAE* AND BRIEF *AMICI CURIAE* OF THE NEWSLETTER PUBLISHERS ASSOCIATION, CUTTER INFORMATION CORP., INSIDE MORTGAGE FINANCE PUBLICATIONS, INC., INSURANCE COMMUNICATIONS, INTELLIGENCE PRESS, INC., PASHA PUBLICATIONS, INC., PHILLIPS PUBLISHING INTERNATIONAL, INC., RANDOM LENGTHS PUBLICATIONS, INC., REED ELSEVIER, INC., THOMAS PUBLISHING CO., THE THOMSON CORP., AND UNITED COMMUNICATIONS GROUP IN SUPPORT OF PETITIONER

MICHAEL R. KLIPPER
CHRISTOPHER A. MEYER
CHRISTOPHER A. MOHR
MEYER & KLIPPER, PLLC
918 16th Street, N.W.
Suite 803
Washington, D.C. 20006
(202) 496-0830

LEE LEVINE
Counsel of Record
RAYMOND KU
LEVINE PIERSON SULLIVAN & KOCH, L.L.P.
1155 Connecticut Avenue, N.W.
Suite 700
Washington, D.C. 20036
(202) 508-1110
Counsel for Amici

WILSON - EPES PRINTING CO., INC. - 789-0096 - WASHINGTON, D.C. 20001

35 pp

IN THE

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Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

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MOTION FOR LEAVE TO FILE BRIEF *AMICI CURIAE*

The Newsletter Publishers Association, Cutter Information Corp., Inside Mortgage Finance Publications, Inc., Insurance Communications, Intelligence Press, Inc., Pasha Publications, Inc., Phillips Publishing International, Inc., Random Lengths Publications, Inc., Reed Elsevier, Inc., Thomas Publishing Co., The Thomson Corp., and United Communications Group respectfully move this Court for leave to file the accompanying brief *amici curiae* in support of the Petition for a Writ of Certiorari in this case. The consent of the petitioner, Warren Publishing, Inc., to the filing of the brief *amici curiae* has been obtained. The consent of the respondent, Microdos Data Corp., has been requested and denied.

Amici and their members are the publishers of newsletters, periodicals, directories, other publications and databases that contain original and commercially useful

compilations of information. *See* Appendix A *infra.* If the judgment below is not reversed, these *amici* and their members will be adversely affected in their ability to create and disseminate such works to the public. The accompanying brief *amici curiae* addresses at least three significant matters relevant to this Court's consideration of the Petition for a Writ of Certiorari not previously brought to its attention. First, the brief *amici curiae* chronicles the Eleventh Circuit's copyright jurisprudence in the wake of this Court's decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), including the Court of Appeals' en banc decision in *BellSouth Advertising & Publ'g Corp. v. Donnelley Information Publ'g, Inc.*, 999 F.2d 1436 (11th Cir. 1993) (en banc), *cert. denied*, 510 U.S. 1101 (1994). Second, the brief *amici curiae* brings to the Court's attention the considerable body of scholarly commentary that has identified and addressed the conflict among the circuits that is the subject of the Petition.

Finally, the brief *amici curiae* describes for the Court the practical ramifications of the Eleventh Circuit's application of *Feist*, in the instant case and in *BellSouth*, as well as the resulting conflict in the circuits, for the creators of a broad range of factual compilations beyond the directories at issue in those cases. Specifically, the brief *amici curiae* addresses the impact of the resulting uncertainty in the law on the publishers of newsletters and other periodicals, and on the creators of commercially useful databases, especially in the context of the Internet and National Information Infrastructure. In that regard, the brief *amici curiae* examines the role of such compilations in industries as diverse as healthcare, national defense, energy, forestry, insurance, and mortgage finance.

Accordingly, *Amici* respectfully request this Court to grant leave to file their accompanying Brief in Support of the Petition for Writ of Certiorari.

Respectfully submitted,

MICHAEL R. KLIPPER
CHRISTOPHER A. MEYER
CHRISTOPHER A. MOHR
MEYER & KLIPPER, PLLC
918 16th Street, N.W.
Suite 803
Washington, D.C. 20006
(202) 496-0830

LEE LEVINE
Counsel of Record
RAYMOND KU
LEVINE PIERSON SULLIVAN
& KOCH, L.L.P.
1155 Connecticut Avenue, N.W.
Suite 700
Washington, D.C. 20036
(202) 508-1110
Counsel for Amici

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BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc., 999 F.2d 1436 (11th Cir. 1993), *cert. denied*, 510 U.S. 1101 (1994) ..... *passim*
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Warren Publishing, Inc. v. Microdos Data Corp., 52 F.3d 950, *rev'd*, 115 F.3d 1509 (11th Cir. 1997) 4, 12

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Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* (1997) ..... *passim*

OTHER AUTHORITIES

Hearing on H.R. 2265, The "No Electronic Theft Act," Before the Subcomm. on Courts and Intellectual Property, House Comm. on the Judiciary, 105th Cong., 1st Sess. (Sept. 11, 1997) 19

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Intellectual Property and National Information Infrastructure, The Report of the Working Group on Intellectual Property Rights (1995)	20
Howard B. Abrams, *Originality and Creativity in Copyright Law*, 55 Law & Contemp. Probs. 3 (1992)	15
Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection of Works of Information after* Feist v. Rural Telephone, 92 Colum. L. Rev. 338 (1992)	15
Philip H. Miller, *Life After* Feist: *Facts, the First Amendment and the Copyright Status of Automated Databases*, 60 Fordham L. Rev. 507 (1991)	15
Note, Feist *or Famine—American Database Copyright as an Economic Model for the European Union*, 20 Brooklyn J. of Int'l L. 744 (1994)	15
Note, *Standards of Protection for Databases in the European Community and the United States*: Feist *and the Myth of Creative Originality*, 27 Geo. Wash. J. of Int'l L. & Econ. 457 (1993-94)	15
Ralph Oman, *Reflections on the Changing Shape of Database Protection*, 40 Fed. Bar News & J. 232 (1993)	15
William S. Strong, *Database Protection after* Feist v. Rural Telephone Co., 42 J. Copyright Soc'y of U.S.A. 39 (1994)	15
Russ VerSteeg, *Rethinking Originality*, 34 Wm. & Mary L. Rev. 801 (1993)	15
Ethan L. Wood, *Copyrighting the Yellow Pages: Finding Originality in Factual Compilations*, 78 Minn. L. Rev. 1319 (1994)	11
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BRIEF OF *AMICI CURIAE* IN SUPPORT OF PETITIONER

INTEREST OF THE *AMICI CURIAE*

Amici curiae and their members are the publishers of newsletters, periodicals, directories, and other publications and databases that contain original and commercially useful compilations of information. *See* Appendix A *infra*. If the judgment below is not reversed, *amici*, their members, and numerous others will be adversely affected in their ability to create and disseminate such valuable works to the public.[1]

SUMMARY OF ARGUMENT

In *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 348 (1991), this Court held that a white-pages telephone directory was not entitled to copyright protection because its alphabetical listing of all those receiving telephone service within a designated geographic area lacked the "spark of creativity" necessary to render the work "original" within the contemplation of the Copyright Act and the Constitution. In so holding, however, the Court cautioned that the "level of creativity" required to sustain a copyright is "extremely low; even a slight amount will suffice." *Id.* at 345.

More than six years later, the courts of appeals, most notably the Second and Eleventh Circuits, have arrived at an impasse in their efforts to reach consensus concerning the import of this Court's decision in *Feist*. In a series of cases, the Second Circuit has construed *Feist* to require that courts recognize as "original," and therefore eligible for copyright, all those compilations of otherwise unprotected material that, taken as a whole, reflect "some independent choice in the coordination, selection, or arrangement of data." *CCC Information Services, Inc. v.*

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[1] Pursuant to S. Ct. R. 37.6, *amici* state that counsel for a party to this action did not author any portion of this brief *amici curiae* and that no person or entity, other than *amici*, made a monetary contribution to the preparation or submission of the brief.

Maclean Hunter Market Reports, Inc., 44 F.3d 61, 65 (2d Cir. 1994), *cert. denied*, 116 S. Ct. 72 (1995). Thus, in the years since *Feist*, the Second Circuit has afforded copyright protection to, *inter alia*, a compilation of used car valuations, *id.* at 67; a chart reporting the statistics of baseball players, *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991); a yellow-pages telephone directory, *Key Publications, Inc. v. Chinatown Today Publ'g Enters.*, 945 F.2d 509 (2d Cir. 1991); and a listing of collective terms for identifying animal groups, *Lipton v. Nature Co.*, 71 F.3d 464 (2d Cir. 1995).

In sharp contrast, the Eleventh Circuit has held that the requirement of "originality" articulated in *Feist* is properly invoked to deny copyright protection to a broad range of factual compilations. In the Eleventh Circuit, the very acts of selection that are deemed creative, and hence "original," in the Second Circuit constitute "not acts of authorship but techniques for the discovery of facts" that are not the proper subject of copyright. *BellSouth Advertising & Publ'g Corp. v. Donnelley Information Publ'g, Inc.*, 999 F.2d 1436, 1441 (11th Cir. 1993) (en banc), *cert. denied*, 510 U.S. 1101 (1994); *Warren Publishing, Inc. v. Microdos Data Corp.*, 115 F.3d 1509, 1519 (11th Cir. 1997) (en banc). Indeed, in the Eleventh Circuit, compilations reflecting such independent and creative selection of information are not merely "unoriginal" within the meaning of *Feist*, but they also forfeit any claim to copyright protection because, according to that court, the compiler's method of "selection" itself constitutes an uncopyrightable "system" under Section 102(b) of the Copyright Act and "merges' with the "idea" undergirding the selection as expressed in the resulting compilation. *See id.* at 1517; *BellSouth Advertising & Publ'g Corp.*, 999 F.2d at 1442.

The Eleventh Circuit's decisions in *BellSouth* and *Warren Publishing* conflict not only with the Second Circuit's longstanding interpretation and application of *Feist*, but also with a host of decisions by other circuits construing Section 102(b), the merger doctrine, and *Feist*

itself. *See, e.g., Toro Co. v. R&R Prods. Co.*, 787 F.2d 1208, 1212 (8th Cir. 1986); *Urantia Foundation v. Maaherra*, 114 F.3d 955, 958-59 (9th Cir. 1997); *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 142 (5th Cir. 1992); *U.S. Payphone Inc. v. Executives Unlimited of Durham Inc.*, 931 F.2d 888 (Table), 18 U.S.P.Q.2d 2049, 2051 (4th Cir. 1991); *Atari Games Corp. v. Oman*, 979 F.2d 242, 246-47 (D.C. Cir. 1992) (R.B. Ginsburg, J.). With its en banc decision in *Warren Publishing*, the Eleventh Circuit signals its intention to persist in its contrary views with respect to all of these issues.

Taken together with *BellSouth*, therefore, the decision below places in jeopardy the otherwise uniform copyright protection afforded compilations throughout the nation. Such compilations include not simply directories of the type at issue here and in *BellSouth*, but also a myriad of publications and databases that feature compilations of commercially useful information, from daily reports of price movements in the oil, gas, and forestry industries, to compendia of medical information, to collections of specifications for new products. Accordingly, absent intervention by this Court, the law of copyright as articulated in the Eleventh Circuit—despite its rejection by other circuits—will effectively constrain the creation of a broad array of works that "unquestionably contribute to public knowledge by providing cheaper, easier, and better organized access to information." *CCC Information Servs.*, 44 F.3d at 66.

REASONS FOR GRANTING THE WRIT

I. THE DECISION BELOW CONFLICTS WITH THE LAW OF OTHER CIRCUITS AND WITH THIS COURT'S DECISION IN *FEIST*.

The decision below represents the most recent effort by the Eleventh Circuit to narrow the scope of copyright protection afforded to compilations and other works that serve to disseminate useful information to the public. In

large measure, the Eleventh Circuit's jurisprudence is premised on the notion that this Court's decision in *Feist* worked a major change in the law of copyright, one that mandates that " '*greater emphasis . . . be placed on the public's interest in the free accessibility of ideas.*' " *Cable News Network, Inc. v. Video Monitoring Servs. of America, Inc.*, 940 F.2d 1471, 1479 (11th Cir. 1991) (Birch, J.), *vacated on other grounds*, 959 F.2d 188 (11th Cir. 1992) (quoting W. Warren, *Forward*, in B. Kaplan, *An Unhurried View of Copyright* vii-viii (1967)) (emphasis in original). As a result, twice in the six years since *Feist*, the Eleventh Circuit has revisited, en banc, decisions rendered by panels of that court and has reversed, in the name of *Feist*, holdings that the factual compilations at issue were protected by the law of copyright. *See BellSouth Advertising & Publ'g Corp. v. Donnelley Information Publ'g, Inc.*, 933 F.2d 952, *rev'd*, 999 F.2d 1436 (11th Cir. 1993) (en banc) (Birch, J.); *Warren Publ'g, Inc. v. Microdos Data Corp.*, 52 F.3d 950, *rev'd*, 115 F.3d 1509 (11th Cir. 1997) (en banc) (Birch, J.).

No other circuit has construed *Feist* in this manner. Indeed, as *amici* demonstrate below, the Eleventh Circuit's application of *Feist*—as well as of Section 102(b) and the merger doctrine—conflicts with the decisions of every circuit that has addressed such issues, each of which has interpreted *Feist* as "simply reaffirm[ing] what the statute provides and what had been known" for over a century. *Urantia Foundation*, 114 F.3d at 959; *see also Atari Games Corp.*, 979 F.2d at 244 n.3 (same). Most notably, the Eleventh Circuit's invocation of *Feist* in holding that commercially useful compilations of facts are not the proper subject of copyright conflicts with the Second Circuit's consistent application of *Feist* to afford copyright protection to virtually identical works.

A. *Feist* and the "Originality" Requirement.

In *Feist*, this Court held that a white-pages telephone directory was not entitled to protection under the Copyright Act because it "lack[ed] the requisite originality."

499 U.S. at 364. In so holding, the Court rejected a line of cases suggesting that the "industrious collection" of information, without more, warranted a finding of copyrightability. *See, e.g., Leon v. Pacific Telephone & Telegraph Co.*, 91 F.2d 484 (9th Cir. 1937); *Jeweler's Circular Publ'g Co. v. Keystone Publ'g Co.*, 281 F. 83 (2d Cir.), *cert. denied*, 259 U.S. 581 (1922). Copyright protection, the Court explained in *Feist*, is a consequence of originality, the "*sine qua non* of copyright," and is not a function of "the sweat of the brow." 499 U.S. at 345, 359-60.

The concept of "originality" articulated in *Feist* requires "only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity." *Id.* The Court emphasized that "the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, 'no matter how crude, humble or obvious' it might be." *Id.* (quoting 1 M. Nimmer & D. Nimmer, *Nimmer on Copyright* §1.08[C][1]).

In *Feist*, therefore, the Court held that the "originality" of a factual compilation is judged by the author's selection, coordination, or arrangement of the information contained in the publication when considered as a whole. 499 U.S. at 348. "The compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers." *Id.* Those steps, including the resulting "choices as to selection and arrangement," the Court explained, are "sufficiently original that Congress may protect such compilations through the copyright laws," provided that the choices "are made independently by the compiler and entail a minimal degree of creativity." *Id.* Thus, the Court concluded, "even a directory that contains absolutely no protectible written expression, only facts, meets the constitutional minimum

for copyright protection if it features an original selection or arrangement." *Id.* (citing *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 547 (1985)).[2]

B. The Majority Approach.

Outside the Eleventh Circuit, the lower courts' application of *Feist* reflects a consistent application of the Supreme Court's admonition that, even in the context of factual compilations, the "originality requirement is not particularly stringent" and will preclude a finding of copyrightability only when "the creative spark is utterly lacking or so trivial as to be virtually nonexistent." 499 U.S. at 358-59. Although several courts of appeals have endorsed this approach,[3] it has received its most thorough explica-

[2] In *Feist* itself, the Court held that the "selection, coordination, and arrangement" of information in a white-pages telephone directory "lacks the modicum of creativity necessary to transform mere selection into copyrightable expression." 499 U.S. at 362. The "basic" information such a directory contains—*i.e.*, the "name, town, and telephone number" of each person who applies for telephone service arranged in alphabetical order—"could not be more obvious," the Court concluded, and is therefore "devoid of even the slightest trace of creativity" necessary to warrant copyright protection. *Id.*

[3] *See Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 142 (5th Cir. 1992) ("The level of creativity required to make a work of authorship original 'is extremely low,'" warranting copyright protection for plaintiff's maps) (quoting *Feist*); *Urantia Found. v. Maaherra*, 114 F.3d 955, 958-59 (9th Cir. 1997) (*Feist* "recognized that a compilation of facts may possess the requisite originality when the author chooses which facts to include, in what order to place them, and how to arrange the data so readers may use them effectively"); *U.S. Payphone Inc. v. Executives Unlimited of Durham, Inc.*, 931 F.2d 888, 18 U.S.P.Q. at 2051 (4th Cir. 1991) ("We are persuaded that Payphone's selection and organization of the state tariff material was sufficiently subjective and original to make the Tariff Section copyrightable. . . ."); *Atari Games Corp. v. Oman*, 979 F.2d 242, 244 (D.C. Cir. 1992) (in *Feist*, "the Supreme Court extensively discussed and elucidated the creativity standard" and "left no doubt that the requirement is indeed modest"). Other circuits have applied *Feist* to deny copyright protection to the specific works before them, albeit in a manner consistent with the analysis adopted by the lion's share of the appellate courts. *See*

tion in a series of decisions from the Second Circuit. *See Lipton v. Nature Co.*, 71 F.3d 464 (2d Cir. 1995) (Cabranes, J.); *CCC Information Servs., Inc. v. Maclean Hunter Market Reports, Inc.*, 44 F.3d 61 (2d Cir. 1994) (Leval, J.); *Key Publications, Inc. v. Chinatown Today Publ'g Enters.*, 945 F.2d 509 (2d Cir. 1991) (Winter, J.); *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991) (Newman, J.).

In these decisions, the Second Circuit has affirmed, based on *Feist*, the validity of copyrights in a compilation of baseball statistics (*Kregos*), a yellow-pages directory (*Key Publications*), a compendium of used car valuations (*CCC Information*), and a listing of collective terms for identifying animal groups (*Lipton*).[4] In *Kregos*, the court held that the plaintiff's selection of nine categories of information in which to organize pitching statistics demonstrated sufficient "selectivity to satisfy the requirement of originality," and rejected the suggestion that the merger doctrine otherwise operated to deprive Kregos' compilation of copyright protection. 937 F.2d at 704-05 (citing *Toro Co. v. R&R Prods. Co.*, 787 F.2d 1208 (8th Cir. 1986)).[5] In *Key Publications*, Judge Winter

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Sem-Torq, Inc. v. K-Mart Corp., 936 F.2d 851, 855 (6th Cir. 1991) ("package" of discrete signs, each containing concededly noncopyrightable legends, did not constitute compilation at all); *Mid America Title Co. v. Kirk*, 59 F.3d 719, 722 (7th Cir.) (compilation of title information not original because selection of data to be included governed by "strict industry standards"), *cert. denied*, 116 S. Ct. 520 (1995).

[4] In *Victor Lalli Enters. v. Big Red Apple, Inc.*, 936 F.2d 671, 671 (2d Cir. 1991) (per curiam), the court also applied *Feist* and affirmed a district court's holding that "a compilation of information gleaned from horse racing statistics . . . was not entitled to copyright protection." The district court had found that all "publishers of the charts at issue use the exact same format" and that their "charts do not vary in the slightest." *Id.* at 672.

[5] In *Kregos*, Judge Newman recognized that "[i]n one sense, every compilation of facts can be considered to represent a merger of an idea with its expression. Every compiler of facts has the idea that his particular selection of facts is useful. If the compiler's

similarly emphasized that, for the "selection" of information contained in a compilation to merit copyright protection, it must—when "viewed in the aggregate"—reflect no more than "the exercise of judgment in choosing which facts from a given body of data to include," a rule which easily embraced as original the plaintiff's "thought and creativity in the selection of businesses included" in its directory. 945 F.2d at 513-14. And, in *Lipton*, the court recognized that, even though the terms collected in plaintiff's work were not themselves original, the compilation author's "*selection* and *arrangement* of the terms were original," chosen as they were "from numerous variations of hundreds of available terms." 71 F.3d at 470 (emphasis in original).

The Second Circuit's application of *Feist* is most fully articulated in *CCC Information*. There, Judge Leval set forth the Second Circuit's explanation of why this Court in *Feist* "repeatedly stressed that the required level of originality" in a compilation is "minimal, and that most compilations, merely by exercising some independent choice in the coordination, selection or arrangement of data, will pass the test." 44 F.3d at 65 (citing *Feist Publications, Inc.*, 499 U.S. at 348, 358-59). "Compilations that devise new and useful selections and arrangements of information," the court asserted, "unquestionably contribute to public knowledge by providing cheaper, easier, and better organized access to information." 44 F.3d at 66. Moreover, Judge Leval concluded, "[w]ithout financial incentives, creators of such useful compilations might direct their energies elsewhere, depriving the public of their creations and impeding the advance of learning." *Id.*

Thus, the Second Circuit rejected the view that the plaintiff's compilation of used car valuations could be

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idea is identified at that low level of abstraction, then the idea would always merge into the compiler's expression of it. Under that approach, there could never be a copyrightable compilation of facts." 937 F.2d at 706.

denied copyright protection because its "selection and arrangement of data" represented " 'a logical response to the needs of the vehicle valuation market.' " *Id.* at 67 (quoting district court).[6] Rather, the court held, the "fact that an arrangement of data responds *logically* to the needs of the market for which the compilation was prepared does not negate originality." *Id.* (emphasis in original). In fact, "the use of logic to solve the problems of how best to present the information being compiled is independent creation." *Id.* For analogous reasons, the court concluded, as it had in *Kregos,* that the merger doctrine did not deprive the compilation of copyright protection. *See id.* at 70 ("Given the nature of compilations, it is almost inevitable that the original contributions of the compilers will consist of *ideas*" since "[o]riginality in selection . . . will involve the compiler's idea of the utility to the consumer of a limited selection from the particular universe of available data.") (emphasis in original).

In the Second Circuit, therefore, the "thrust of the Supreme Court's ruling in *Feist* was not to erect a high barrier of originality requirement." *Id.* at 66. Instead, the Second Circuit has repeatedly held, *Feist* sought to establish only that "*some* originality is essential to protection of authorship, and that the protection afforded extends only to those original elements." *Id.* (emphasis in original). The policy underlying the Copyright Act, as articulated in the Second Circuit, "is to encourage authors to publish innovations for the common good—not to threaten them with loss of livelihood if their works of authorship are found insufficiently imaginative." *Id.*

C. The Eleventh Circuit's Approach.

The Eleventh Circuit's application of *Feist* stands in marked contrast to that of its sister circuit. Indeed,

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[6] The compilation at issue in *CCC Information* reflected "choices to accommodate the practical space limitations imposed by the book's format, while providing the information most likely to satisfy customers' needs." 44 F.3d at 67 n.7.

shortly after this Court's decision, a panel of the Eleventh Circuit expressly concluded that *Feist* "mandated a shift" in the "focus" of copyright law, away from protection of the "proprietary" interests of copyrightholders and toward a " '*greater emphasis*' " on the " '*public's interest in the free accessibility*" ' of ideas and information. *Cable News Network*, 940 F.2d at 1478-79 (emphasis in original) (citation omitted). Although that opinion was later vacated on unrelated grounds, its explication of *Feist*'s "mandate" serves to frame the circuit's subsequent applications of *Feist* in *BellSouth* and *Warren Publishing*.[7]

In *BellSouth*, the trial court and a panel of the Eleventh Circuit each held that the copyright holder had "created a unique directory due to its method of selecting, coordinating and arranging its material" and that the resulting "compilation is an original work of authorship which is subject to a valid copyright." *BellSouth Advertising & Publ'g Corp. v. Donnelley Information Publ'g, Inc.*, 719 F. Supp. 1551, 1558 (S.D. Fla. 1988) (subsequent history omitted); *see BellSouth Advertising & Publ'g Corp.*, 933 F.2d at 958 (subsequent history omitted) ("The format of the Yellow Pages before us is sufficiently distinct from the 'white pages' phone directory involved in *Feist* to meet the minimal level of independent creativity required to qualify as original."). Relying on a quite different understanding of the import of *Feist*, however, the en banc court reversed, holding that the various documented acts of selection reflected in the directory at issue (and found by the trial court and the panel to be original) were "not acts of authorship" at all, but rather unprotected "techniques for the discovery of facts." 999 F.2d at 1441. The Copyright Act, the court held,

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[7] *See also* 940 F.2d at 1483 (cautioning trial judges "presented with a 'good guy' copyright owner and a 'bad guy' ('pirate') copyist" not to be "seduced" by "aggressive and overreaching" copyright holders to overlook the "interest of the public in the free flow and availability of ideas").

"affords no shelter to the resourceful, efficient, or *creative* collector." *Id.* (emphasis added).[8]

The Eleventh Circuit's decision in *BellSouth*, by that courts' own admission in the decision below, spawned "'considerable criticism,'" 115 F.3d at 1529 n.29, directed largely at its perceived formulation of "a standard of originality that is inconsistent with the Supreme Court's approach in Feist."[9] The court's cognizance of such criticism, coupled with its awareness of the body of case law developed in other circuits following *Feist*, might have moved it to reconsider its approach to copyright protection for factual compilations in the case currently before this Court. As *amici* discuss *infra*, however, the Eleventh Circuit, again sitting en banc, has chosen in *Warren Publishing* to reaffirm *BellSouth*, even in the face of a contrary application of *Feist* by both the trial court and a majority of the panel that originally considered the case.

The trial court in this case, which ruled prior to the Eleventh Circuit's en banc decision in *BellSouth*, held that Warren's directory of cable television systems reflected a "system for selecting communities" to be included in its publication that was both "original in the industry" and "a part of the format of the compilation which is copy-

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[8] In dissent, Judge Hatchett opined that the majority's decision "establishes a rule of law that transforms the multi-billion dollar classified publishing industry from a business requiring the production of a useful directory based on multiple layers of creative decisionmaking, into a business requiring no more than a successful race to a data processing agency to copy another publisher's copyrighted work-product." 999 F.2d at 1471 (Hatchett, J., dissenting). In all, Judge Hatchett cited *Key Publications* seven times in support of his construction of *Feist*. *See* 999 F.2d at 1473, 1474, 1475, 1476, 1478, 1484.

[9] Ethan L. Wood, *Copyrighting the Yellow Pages: Finding Originality in Factual Compilations*, 78 Minn. L. Rev. 1319, 1336 (1994). *See also* 1 M. Nimmer & D. Nimmer, *supra*, § 3.04[B], at 3-31 (although "[m]ost applications of *Feist* have recognized the circumscribed sphere to which its holding applies," these "post-*Feist* decisions cannot be squared with *BellSouth*").

rightable" under *Feist*. *Warren Publ'g, Inc. v. Microdos Data Corp.*, 1992 WL 235745, at *7 (N.D. Ga. Mar. 31, 1992) (subsequent history omitted). A panel of the appellate court agreed, holding that—the intervening en banc decision in *BellSouth* notwithstanding—Warren's "method for placing each [cable] system within the listing structure, i.e., it chose to identify each system by the geographical name of the principal community served," [10] was sufficiently original to qualify for copyright protection under *Feist*. *Warren Publ'g, Inc. v. Microdos Data Corp.*, 52 F.3d 950, 954 (11th Cir. 1995) (Godbold, J.).

The en banc court's contrary determination in *Warren Publishing* is premised squarely on its view that *Feist*, as construed in *BellSouth*, places "limitations on the scope of copyright protection in a factual compilation" that deprive the independent selection of principal communities reflected in Warren's directory of copyright protection. 115 F.3d at 1515. Warren's decision to group cable systems by principal community reflected an effort "to make the Factbook commercially useful," which—like the commercially useful headings selected by the compiler in *BellSouth*—the Eleventh Circuit deemed to be neither original nor creative within the meaning of *Feist*. *Id.*[11] Further, the Eleventh Circuit concluded, even if Warren's "presentation of the selection of principal communities" were deemed "creative and original," *BellSouth* would nevertheless preclude a finding of copyrightability because

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[10] In compiling its directory, Warren made a "determination . . . as to what community is the 'principal' or 'lead' . . . community served by a particular cable system" and published "data only under the name of the principal community." 115 F.3d at 1512. As the panel recognized, such data are "commonly organized" by other compilers in the industry "alphabetically by state and then, for each state, alphabetically by the names of communities having cable service." 52 F.3d at 952.

[11] *See also* 115 F.3d at 1520 n.31 ("The mere discovery of an organizing principle which is dictated by the market is not sufficient to establish creativity. . . . Thus, even if Warren discovered the existence of the principal community as an organizing concept, Warren did not create this organization.").

"the principal community was 'selected by contacting the cable operator to determine which community is considered the lead community within the cable system,'" a process that constitutes a "'technique[ ] for the discovery of facts,'" not an "'act[ ] of authorship.'" *Id.* at 1519 (quoting *BellSouth Advertising & Publ'g Corp.*, 999 F.2d at 1441).

Finally, the en banc court buttressed its analysis of *Feist* by holding that the "system" of selection reflected in Warren's directory could not properly be the subject of copyright pursuant to Section 102(b) of the Copyright Act and, relying again on *BellSouth*, that "Warren's claim of copyright in its selection of communities does not survive application of the merger doctrine." 115 F.3d at 1517, 1518 n.27. In the Eleventh Circuit, therefore, it is now also the law that Section 102(b), which excludes "any idea, procedure, process, system, method of operation, concept, principle, or discovery" from the scope of copyright, effectively precludes any compiler from securing copyright protection for a work that reflects even a concededly original and creative method of selecting the material in its publication. Similarly, in the Eleventh Circuit, the merger doctrine now bars the ownership of copyright in such a publication, because the "idea" reflected in the author's method of selection "merges" with the expression of that idea in the publication itself. *Id.* at 1518-19 n.27 (citing *BellSouth Advertising & Publ'g Corp.*, 999 F.2d at 1442).[12]

D. The Resulting Conflict.

As the preceding discussion illustrates, the Second and Eleventh Circuits have learned vastly different lessons from this Court's teachings in *Feist* and have, therefore,

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[12] In dissent from the en banc decision, Judge Godbold, joined by Judges Hatchett and Barkett, insisted that the "originality necessary to render Warren's work copyrightable lies in its selection of data." 115 F.3d at 1523 (Godbold, J., dissenting). Once again, the dissenting opinion relied repeatedly on the Second Circuit's contrary interpretation of *Feist*. *See id.* at 1522, 1525-29 (citing Second Circuit's decisions).

reached markedly different results in strikingly similar cases. A yellow-page directory is now the proper subject of copyright in the Second Circuit, but is denied any copyright protection whatsoever in the Eleventh Circuit. A "commercially useful" compilation of used car valuations is afforded copyright protection in the Second Circuit, while a compilation of information about cable television systems is deemed to forfeit any claim to copyrightability precisely because the logic of its selection is driven by notions of commercial utility.[13] The merger doctrine serves to deprive compilations of copyright protection in the Eleventh Circuit because the very method of selection on which the claim rests is deemed an unprotected "idea," while the Second Circuit rejects application of the merger doctrine to analogous compilations because it would effectively deprive compilations of any copyright protection at all. *Cf.* 4 M. Nimmer & D. Nimmer, *supra*, § 13.03[B] at 13-76 (Second Circuit's approach represents the "better view").

The conflict between the decisions of the Eleventh Circuit, here and in *BellSouth*, and those of the Second Circuit, provide the most graphic illustration of the uncertainty that has become embedded in the law of copyright after six years of judicial application of *Feist*. As the cases referenced in note 3 *supra* demonstrate, however, the Eleventh Circuit's reading of *Feist* conflicts with that of at least four other circuits as well, each of which interprets *Feist* to require a " 'spark' of creativity," 499

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[13] Until now, it had appeared well settled that the "commercial nature" of a given work did not jeopardize its entitlement to copyright protection. *Bleistein v. Donaldson Lithographic Co.*, 188 U.S. 239, 251 (1903) (Holmes, J.) ("A picture is none the less a picture and none the less a subject of copyright, that it is used as an advertisement"). Indeed, as this Court remarked almost a century ago, "it would be a dangerous undertaking for persons trained only in the law to constitute themselves final judges of the worth of pictorial illustrations," and presumably other works as well, "outside of the narrowest and most obvious limits." *Id.* at 251.

U.S. at 358, not a towering inferno.[14] Moreover, the Eleventh Circuit's invocation of Section 102(b) is flatly inconsistent with the Eighth Circuit's decision in *Toro Co. v. R&R Prods. Co.*, 787 F.2d at 1212, in which that court held that, in the context of factual compilations, "the idea/expression dichotomy embodied in Section 102(b) means" only that the compiler may not copyright the "idea" of collecting such information in the first

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[14] The conflict has been amply documented by the commentators. *See, e.g.*, Howard B. Abrams, *Originality and Creativity in Copyright Law*, 55 Law & Contemp. Probs. 3, 15 (1992) (*Feist* does not provide a test for determining whether its creativity requirement is satisfied); Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection of Works of Information after* Feist v. Rural Telephone, 92 Colum. L. Rev. 338, 343 (1992) ("The *Feist* opinion is more explicit in describing what is not original than in delineating what is"); Philip H. Miller, *Life After* Feist: *Facts, the First Amendment and the Copyright Status of Automated Databases*, 60 Fordham L. Rev. 507, 516 (1991) (*Feist*'s failure to provide sufficient guidance in evaluating whether a compilation satisfies the originality requirement will make it difficult for lower courts to make that determination consistently); William S. Strong, *Database Protection after* Feist v. Rural Telephone Co., 42 J. Copyright Soc'y of U.S.A. 39, 39 (1994) (*Feist* opinion "inordinately delphic"); Alfred C. Yen, *The Legacy of* Feist: *Consequences of the Weak Connection Between Copyright and the Economics of Public Goods*, 52 Ohio St. L.J. 1343, 1376 & n.149 (1991) (noting inconsistencies in lower courts attempting to apply *Feist*); Russ VerSteeg, *Rethinking Originality*, 34 Wm. & Mary L. Rev. 801, 823 (1993) (*Feist* "did not define 'creativity' in any manner other than by default" and "neglected to articulate a standard"); Note, *Standards of Protection for Databases in the European Community and the United States*: Feist *and the Myth of Creative Originality*, 27 Geo. Wash. J. of Int'l L. & Econ. 457, 469 (1993-1994) ("the *Feist* decision will continue to cast its shadow over works that are on the borderline of copyrightability unless the rule is clarified or excised."); Note, Feist *or Famine—American Database Copyright as an Economic Model for European Union*, 20 Brooklyn J. of Int'l L. 744, 746 (1994) (*BellSouth* illustrates "the major difficulty in applying *Feist*: creativity is in the eye of the beholder"); Ralph Oman, *Reflections on the Changing Shape of Database Protection*, 40 Fed. Bar News & J. 232, 234 (1993) ("*Feist* may generate new uncertainties around the application of the 1976 [Copyright] Act to databases").

place.[15] By reaffrming its decision in *BellSouth* in the case at bar, the Eleventh Circuit has removed any hope that these conflicts will be resolved by the circuits themselves. And, as *amici* demonstrate *infra*, the persistence of such conflicts—now six years after *Feist*—threatens the creators of a broad range of publications, periodicals, databases and other works, each of which is designed to bring compilations of information to the public in an effective and commercially useful manner.

II. THE DECISION BELOW THREATENS THE CREATION OF COMPILATIONS THAT PROVIDE THE PUBLIC WITH INFORMATION IN A USEFUL AND EFFECTIVE MANNER.

The Eleventh Circuit's interpretation of *Feist*, if permitted to stand, threatens more than the validity of copyrights in directories such as Warren's "Factbook" or BellSouth's yellow pages. It also jeopardizes the copyright protection heretofore afforded those portions of a wide variety of publications, such as the newsletters published by several of the *amici curiae*, that regularly include such compilations within a larger work. *Amicus* Random Lengths Publications, for example, publishes a weekly newsletter that reports on developments in the wood products industry. In addition to news and feature articles, *Random Lengths* includes a weekly, independent compilation of prices of over 1,500 different wood products. *See* Appendix B at B-6.[16] Gathered from over 700 sources each week by the newsletter's staff, the Price Guide reflects its authors' selection of which prices to feature, which products to include, and which geographic markets to survey. Subscribers turn to *Random Lengths* precisely because it provides a commercially useful source of such information.

Similarly, *amicus* Inside Mortgage Finance Publications, Inc. publishes a weekly newsletter that reports on the

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[15] *Accord CCC Information Servs., Inc.*, 44 F.3d at 68-69; 1 M. Nimmer & D. Nimmer, *supra*, § 2.03[F].

[16] Copies of Appendix B are lodged with the Clerk of the Court.

home mortgage industry. The newsletter contains articles and other news reports about the industry, as well as weekly compilations of statistical information, both current and historical, likely to be deemed relevant by subscribers. *See* Appendix B at B-5. The selections reflected in the market data compiled in *Inside Mortgage Finance* are a product of the editorial judgment of its authors, who select, *inter alia*, the categories in which information is collected and compiled in the newsletter—*e.g.*, total loan originations, average loan size, average income of borrowers, loan approval rate, etc.

In a variety of publications, *amicus* Phillips Publishing International compiles information reflecting analogous selections from the universe of possible choices about industries as diverse as healthcare, investing, aviation, national defense, and telecommunications. Such compilations include, among other things, compendia of data relating to new product introductions and collections of information about companies in a given industry. *See id.* at B-5. *Amicus* Pasha Publications, Inc., through its publications *Gas Daily* and *Megawatt Daily*, provides daily compilations of price data to subscribers in the gas and electric energy industries respectively, information arranged in categories selected to maximize their utility to subscribers, while *amicus* United Communications Group's *Oil Price Information Service* publishes original compilations of oil prices each week in a format designed to be useful to its readers in the petroleum industry. *See id.* at B-4, B-7. And, *amicus* Intelligence Press, Inc. provides subscribers to its newsletters, *Natural Gas Intelligence, Gas Price Index*, and *NGI's Daily Gas Price Index*, with compilations of data about prices in the natural gas industry, albeit in a different format and through different categories of data than Pasha's *Gas Daily*. *See id.* at B-3.

All of these publications reflect both the judgment and expertise of their authors in selecting the data to be included in their respective compilations, the manner of

their arrangement, and the categories of information to be gathered in the first instance. That the resulting compilations are commercially useful, and thereby cause subscribers to purchase the publications in which they are contained, is a reason to reward the originality and creativity of their authors through the law of copyright, not —as the Eleventh Circuit has held—to strip them of that protection. As the Second Circuit has recognized, it is the purpose of copyright law to provide these publishers with the financial incentive to invest the literally tens of millions of dollars necessary to gather the underlying data and to develop the expertise to compile it in a commercially useful manner. *CCC Information Servs.*, 44 F.3d at 66. The specter created by the Eleventh Circuit—*i.e.*, that anyone can copy these compilations verbatim and sell them virtually contemporaneously at a fraction of the cost without infringing a valid copyright—promises to obliterate the very incentives the Copyright Act is designed to create.

The Eleventh Circuit's construction of *Feist* threatens palpable harm not only to newsletter publishers, but also to the compilers of scientific, legal, medical, environmental, financial and other databases. These compilers, like their colleagues in the newsletter industry, invest significant creative, financial and technical resources to develop, verify and maintain such products. In turn, these compilations provide an invaluable service to academic and professional communities by funneling otherwise cumbersome information into discrete, analytically defined categories.

As this Court recognized in *Feist*, copyright law does not measure the protection afforded a compilation by the amount of effort required to create it, and *amici* do not contend otherwise. By the same token, the fact that enormous effort and resources are often devoted to creating commercially useful compilations is no reason to undercut the incentives that the Copyright Act, and the constitutional provision upon which it is based, are designed to create. For example, POISINDEX, a compilation

listing over one million toxic substances and their antidotes, finds its copyright substantially at risk in the wake of the Eleventh Circuit's decision in this case. For a substance to become included in the index, a medical professional must conclude that it meets a given definition of "poison." The software developed to provide access to the compilation allows the user to view up to four full-text documents describing its clinical effects, toxicity, and treatments. The database requires a host of software engineers to maintain, sort, and retrieve its contents. Under the Eleventh Circuit's analysis, however, the POISINDEX—or any other attempt to create a comprehensive compilation assembled through the use of independently derived objective criteria—may not fit that court's definition of copyrightability. *See* 115 F.3d at 1518.

The necessity of effective legal protection for factual compilations of all stripes has increased dramatically in the wake of the recent, rapid and ongoing digital revolution. This Court has itself noted that the online environment known as the "Internet" provides a "vast platform from which to address and hear from a world-wide audience of millions of readers, viewers, researchers and buyers." *Reno v. American Civil Liberties Union,* 117 S. Ct. 2329, 2335 (1997). From the perspective of the copyright owner, however, this digital marketplace of ideas and information also has a dark side. *See, e.g., United States v. LaMacchia,* 871 F. Supp. 535, 536-37 (D. Mass. 1994) (describing million-dollar losses to copyright owners due to *one* student's unauthorized distribution of commercial software via the Internet); *Hearing on H.R. 2265, The "No Electronic Theft Act," before the Subcomm. on Courts and Intellectual Property, House Comm. on the Judiciary,* 105th Cong., 1st Sess., Statement of Kevin V. DiGregory, Deputy Assistant Attorney General, Criminal Division, Dep't of Justice, at 4-5 (Sept. 11, 1997) (noting that a copyrighted work may be illegally spread around the world "in a few minutes"); Statement of Marybeth Peters, Register of Copyrights, at 3 ("as it becomes easier to transmit large amounts of

information quickly over the NII,[17] it becomes easier . . . to inflict tremendous damage to the market for a copyrighted work"). Current technology permits the illegal copying, and consequent destruction, of a work's market value with literally just a few keystrokes. Thus, as the executive branch has recently recognized:

> [T]he full potential of the NII will not be realized if the education, information, and entertainment products protected by intellectual property laws are not protected effectively when disseminated via the NII. . . . All the computers, telephones, fax machines, [and] scanners . . . in the world will not create a successful NII, if there is no *content*.

NII Report, at 11-12 (emphasis in original).

In the last analysis, the uncertainty that characterizes the law of copyright in the wake of the Eleventh Circuit's reaffirmation of *BellSouth* in *Warren Publishing* has tangible consequences for the creators of factual compilations. As the procedural history of both of these cases illustrates, a compiler seeking to protect its copyrights now faces—at the very least—the prospect of long, complicated, expensive, and uncertain litigation. Absent review by this Court, the real world risks of producing such useful works will necessarily increase, inevitably leading some compilers to conclude that the potential rewards of creation are simply not worth the effort. Nothing could be more anathema to the constitutional policy of promoting "the Progress of Science and the Useful Arts." U.S. Const. Art. 1, § 8, cl. 8.

CONCLUSION

For the foregoing reasons, *amici* respectfully urge this Court to grant the Petition for Writ of Certiorari and reverse the judgment of the Court of Appeals.

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[17] The NII, or "National Information Infrastructure" is a theoretical construct encompassing existing digital, interactive services as well as those that may emerge in the future. *See Intellectual Property and National Information Infrastructure, The Report of the Working Group on Intellectual Property Rights* 2 n.5 (1995) ("*NII Report*").

Respectfully submitted,

MICHAEL R. KLIPPER
CHRISTOPHER A. MEYER
CHRISTOPHER A. MOHR
MEYER & KLIPPER, PLLC
918 16th Street, N.W.
Suite 803
Washington, D.C. 20006
(202) 496-0830

LEE LEVINE
Counsel of Record
RAYMOND KU
LEVINE PIERSON SULLIVAN
& KOCH, L.L.P.
1155 Connecticut Avenue, N.W.
Suite 700
Washington, D.C. 20036
(202) 508-1110
Counsel for Amici

APPENDIX

APPENDIX A

IDENTITY OF INDIVIDUAL *AMICI*

The Newsletter Publishers Association ("NPA") represents the interests of publishers of more than 2,300 independent newsletters and specialized information services. Collectively, members of the NPA publish news and information about virtually every industry and subject of public concern in this nation. In addition to news reporting, the publications of NPA's members frequently feature commercially useful compilations of information of interest to their subscribers.

Cutter Information Corp. ("Cutter") publishes 18 newsletters in the fields of software engineering, energy, and the environment. Its titles include *Data Management Strategies*, the *Oil Spill Intelligence Report*, and the *Global Environmental Change Report*, each of which frequently includes compilations of information useful to its subscribers in these diverse fields. *Data Management Strategies*, for example, regularly provides its subscribers with published compilations of data concerning new product introductions in the rapidly expanding and changing software industry. In the environmental field, Cutter maintains a comprehensive database of information concerning oil spills around the world, which is often consulted by companies for the purpose of assessing the potential environmental risk of contemplated ventures. *Oil Spill Intelligence Report*, a weekly newsletter, frequently provides its subscribers with specialized compilations drawn from the database as well as an annual compiled summary of such information. Each of these compilations reflects the efforts and expertise of Cutter's staff in selecting the categories of data to include in its databases and published compilations.

Inside Mortgage Finance Publications, Inc. ("IMF") is among the leading publishers of mortgage information

in the United States. Its eight publications include a weekly newsletter, *Inside Mortgage Finance*, which contains news reports and compilations of data about mortgage markets; *The Mortgage Market Statistical Annual*, which compiles a variety of statistical information about the mortgage industry; and *The Mortgage Industry 5000*, a directory of mortgage lending institutions. Among other compilations, *Inside Mortgage Finance* annually publishes a compilation of statistical information describing the "Top 100 Mortgage Originators," categorized by total loan originations, average loan size, average borrower income, and loan approval rate, as well as a quarterly compilation of the "Top 30" originators. The selection of such categories by IMF's staff reflects its considered judgment, following in-depth investigation of the mortgage market at considerable expense, with respect to the compiled information's utility to the newsletter's subscribers.

Insurance Communications publishes the monthly newsletter, *Risk Retention Reporter*, and an annual directory, *Risk Retention Group Directory & Guide*, which serve both insureds seeking liability insurance coverage and insurance professionals in the commercial liability marketplace. The newsletter provides subscribers with comprehensive information on insurance industry events and trends, legislative, judicial and regulatory developments, and market and regulatory surveys, while the directory contains in-depth profiles of risk retention groups formed under the 1986 Risk Retention Act.

Intelligence Press, Inc. ("IP") is a leading publisher of news and information about the natural gas industry. It publishes three newsletters, *Natural Gas Intelligence*, *Gas Price Index*, and *NGI's Daily Gas Price Index*, which contain, *inter alia*, compilations of information concerning natural gas prices at locations throughout the United States and Canada. IP's price compilations are the product of its intensive efforts to survey the industry and to

bring its editorial judgment to bear on the selection and arrangement of the data compiled in its newsletters. Indeed, the natural gas industry places a premium on the accurate and effective compilation of such information, which is used by many companies to set prices in supply contracts.

Pasha Publications, Inc. ("Pasha") publishes 27 newsletters and databases covering the natural gas, coal, electric power, mining, defense, and space industries, among others. It publishes two daily newsletters, *Gas Daily* and *Megawatt Daily*, each of which provides daily compilations of pricing information to its subscribers in those industries. *Gas Daily*'s compilation, for example, reports ranges of natural gas prices for the preceding day as well as the median price at a series of different price points across the country. At considerable effort and expense, Pasha's editorial staff is responsible for selecting the categories of information to be compiled, the sources from which it is selected, and the format in which it is presented in the newsletter.

Phillips Publishing International, Inc. ("Phillips") is one of the largest periodical publishers in the United States with over 1.5 million subscribers. The company publishes more than 100 newsletters, magazines, directories, a national weekly newspaper, and nonfiction books. Its publications, including 18 directories and directory-related products, provide a host of industries with easy access to important market data. Phillips' other publications feature factual compilations as well, each of which reflects its expertise and the expenditure of substantial resources in identifying, selecting, and arranging commercially useful information for the benefit of its subscribers in, *inter alia*, the fields of healthcare, investing, aviation, defense, and telecommunications. To offer just one example, Phillips provides the wireless telecommunications industry with factual compilations of such important market data as spectrum licensing information, the manufacturers and distributors of related hardware and soft-

ware, and statistical information from which a subscriber may gauge the competitive state of a given telecommunications market.

Random Lengths Publications, Inc. ("RLP") is a family owned and operated publishing company located in Eugene, Oregon. It is among the leading publishers of information about the North American forest products industry, with subscribers in all 50 states, all 12 Canadian provinces, and 30 other countries. In addition to the company's weekly newsletter, *Random Lengths*, it disseminates five other publications including the *Big Book*, a directory of the forest products industry, and *Yardstick*, a monthly report of forest product statistics. All of these publications feature compilations of commercially useful data about the forest products industry, selected and arranged for publication in a manner designed to be useful to subscribers. RLP's staff of editors devotes enormous energy, resources, and professional judgment to the cause of determining the most effective method of compiling the information reflected in its publications.

Reed Elsevier, Inc.'s more than 12,000 employees compile, verify and maintain large amounts of legal, financial, and scientific data for both the business and academic communities. One of its compilations, the *Martindale-Hubbell Law Directory*, provides an authoritative listing of law firms and lawyers, containing information about location, lawyers and practice concentration. The timely collection and verification of this compilation's contents require teams of researchers who regularly correspond with law firms, corporate legal departments, and government agencies throughout the United States. The compilation of this mass of information is the full-time occupation of more than 200 employees, totaling more than $25 million in payroll and data collection costs.

Thomas Publishing Co. has been a publisher of industry information products for nearly a century. Its 400 employees publish 24 major buying guides, 29 product news magazines, two product information exchange services, a magazine on factory automation, three software

comparison guides, and a publication to help buyers select the most cost-efficient transportation modes for their inbound freight. Its *Register of American Manufacturers* compiles purchasing information about 155,000 companies, classified under more than 57,000 product and service headings.

The Thomson Corporation generates over $8 billion in revenues annually and employs roughly 27,000 American workers. Thomson's U.S. operations include newspapers, specialized information products, and services concentrated in the areas of education, library reference, science, technology, medicine, healthcare, finance and law. Its *Physicians Desk Reference* has been in the forefront of the medical information field for more than 48 years. This compilation includes newly released data about current medicines, as well as information on American prescription medicines covering usage, warnings, and product overviews, plus full-size color photographs cross-referenced by page number to the entry's description.

United Communications Group ("UCG") is one of the largest newsletter publishers in the United States, featuring more than 70 titles in fields as diverse as the automotive industry, banking, federal procurement, telecommunications, the postal service, international finance, and healthcare. It publishes *Oil Price Information Service*, which provides readers with news, market analysis, and compilations of market and spot price levels for petroleum. The latter is compiled and reported to subscribers in categories selected by the newsletter's editorial staff, such as by product (e.g., diesel, propane or jet fuel), by region, by terminal location, and by "key" supplier. In addition, UCG creates information databases such as *Q-Tel*, which compiles pricing, rate and tariff information for subscribers in the telecommunications industry. The *Q-Tel* family of databases allows users to access information concerning telephone rates in a number of price-related categories selected by UCG, including time of call, distance, and day of the week.

FILED
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No. 97-376

In The

Supreme Court of the United States

October Term, 1996

WARREN PUBLISHING INC.,

Petitioner,

v.

MICRODOS DATA CORP., et al.,

Respondents.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Eleventh Circuit

RESPONDENTS' BRIEF IN OPPOSITION

ROBERT B. KENNEDY
Counsel of Record
CARL M. DAVIS II
LESLIE C. RUITER
KENNEDY, DAVIS & KENNEDY
400 Northpark Town Center
1000 Abernathy Road
Suite 1250
Atlanta, Georgia 30328
(770) 396-2244

COCKLE LAW BRIEF PRINTING CO., (800) 225-6964
OR CALL COLLECT (402) 342-2831

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QUESTIONS PRESENTED

1. Whether certiorari should be granted where the Eleventh Circuit properly applied the law of compilation copyright from this Court's decision in *Feist Publications Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), to the facts in the record and determined that the Appellant's selection of material for its compilation lacked creativity and originality and was therefore not copyrightable?

2. Whether certiorari should be granted where the Eleventh Circuit determined that Appellant's system of selecting material for its compilation was excluded from copyright protection under 17 U.S.C. § 102(b) which bars copyright protection for systems?

3. Whether certiorari should be granted where the Eleventh Circuit properly applied the copyright merger doctrine to the record and held that the expression in Appellant's work, a list of geographic names of areas served by cable systems, merged with Appellant's idea?

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INTRODUCTION

Appellant Warren Publishing ("Warren") seeks writ of certiorari for appeal of an *en banc* decision applying the legal principles of this Court in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), on compilation copyright to the particular circumstances of this case against Appellee Microdos Data Corp. and Robert Payne ("Microdos"), where the court below held that Warren's system of selection lacked creativity and originality and was instead a mere discovery and collection of known facts, not entitled to copyright protection.

STATEMENT OF THE CASE

1. Course of Proceedings and Disposition Below

The present petition arises from an *en banc* decision on June 10, 1997, by the Eleventh Circuit which held that the copyright claimant Warren failed to show that the selection of facts in its compilation was sufficiently original to be entitled to copyright protection. 115 F.3d 1520, 1521, Pet. App. 26a.

The case was on appeal from a district court action filed July 26, 1990, by Warren against Microdos and Robert Payne for copyright infringement under 28 U.S.C. § 1338(a) and for unfair competition. R1-1. Microdos counterclaimed for defamation and trade disparagement, interference with contractual obligations, and violations of Section 2 of the Sherman Antitrust Act by Warren attempting to monopolize. R1-6. 115 F.3d at 1513, Pet. App. 8a.

Following discovery, the parties cross-moved for partial summary judgment on the claims for copyright infringement. R1-19; R2-22. On March 23, 1992, the district court entered an order granting Warren's motion and held that "the system [of selecting communities] utilized by Warren in presenting the data on cable systems in its *Factbook* was sufficiently creative and original to be copyrightable." Dist. Ct. Op. at 11, Pet. App. 83a, 115 F.3d at 1513, Pet. App. 9a. A motion for reconsideration was denied and an injunction entered against Microdos. 115 F.3d at 1514, Pet. App. 9a.

In a first appeal to the Eleventh Circuit, the court affirmed the district court. 52 F.3d 950, Pet. App. 53a. The dissent, however, was unable to conclude that Warren's acts of selection were sufficiently original to merit copyright protection (52 F.3d at 957, Pet. App. 73a), in view of its earlier ruling in *BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*, 933 F.2d 952 (11th Cir. 1991), *vacated and reh'g en banc granted*, 977 F.2d 1435 (11th Cir. 1992), *and on reh'g*, 999 F.2d 1436 (11th Cir. 1993) (*en banc*), *cert. denied*, 510 U.S. 1101, 114 S.Ct. 943, 127 L.Ed.2d 232 (1994).

Microdos' suggestion of rehearing *en banc* was granted. 67 F.3d 276, 277, Pet. App. 74a, 75a.

On June 10, 1997, the Eleventh Circuit vacated the preliminary injunction entered by the district court and remanded for further proceedings. In its opinion, the Eleventh Circuit noted "the district court, in ruling on the summary judgment motions, did not have the benefit of our *en banc* opinion in *BellSouth*". 115 F.3d at 1511, Pet. App. 3a. The Eleventh Circuit held that the district court erred in finding that Warren's "principal community system" of selection of material was sufficiently creative and original to be entitled to copyright protection. The court also found that Warren could not show a "likelihood of success on the merits" because it was merely the industrious gatherer and discoverer of facts, rather than an author of an original work. 115 F.3d at 1520, Pet. App. 26a.

2. Statement Of Facts

A. Warren's "Selection" Of Material For Its "Factbook" Was Mere Discovery Of Community Names From Cable System Operators

Warren publishes annually a bound-book compilation of facts about television cable systems across the United States known as the *Television and Cable Factbook* ("*Factbook*"). The directory is arranged state-by-state in alphabetical order from Alabama to Wisconsin. Within each state section is listed, in alphabetical order, communities receiving cable television service. 115 F.3d at 1511, Pet. App. 4a. Factual data about the cable system is printed with a lead or "principal" community. For cable

systems serving more than one community, the data is not reprinted; rather, the smaller communities are cross-referenced to the larger community served by that cable system. 115 F.3d at 1512, Pet. App. 5a. In many cases, a cable system is a single-community system, and thus there is only one possible principal community. 115 F.3d at 112, Pet. App. 5a. For 360 of 406 cable systems in Illinois (over 88 percent), the principal community is the single community or the community with the largest number of subscribers. 115 F.3d at 1519, n. 30, Pet. App. 23a. Pages A.1 attached to this brief illustrates the alphabetical listing and the cross-referencing of communities served by cable systems in the *Factbook*. See 9SR.

The record below establishes how Warren "selected" the "principal community" under which to list factual data with cross-references from the smaller communities (if any) served by a particular cable system. Lynn Levine, Director of Market Research and Data Sales for Appellant Warren, explained how Warren used a number of techniques to discover the principal community names. Warren calls cable companies across the United States and asks them which communities the cable system serves. 115 F.3d at 1517, 1520, Pet. App. 18a, 24a citing Levine depo. p. 53. In response, the cable companies identified the communities served. "The record indicates that it is the cable operators, not Warren, that determine, in the case of a multiple-community system, the community name under which to list the factual data." 115 F.3d at 1520, Pet. App. 26a. Levine also stated that Warren "looked at what was on record at the FCC" for facts about cable systems. Levine depo. pp. 61, 62, 63, 82. The record also shows Warren relied in great part on questionnaire

responses received from the cable operators for review and updating of facts. 115 F.3d at 1520, Pet. App. 24a. Levine depo. p. 35; P. Warren depo. p. 117; 10SR-3. Cable operators also sent copies of FCC reports to Warren to use in updating its cable system facts. Levine depo. pp. 42-44.

B. Microdos's Database Used Federal Communications Commission Reports Which Identify Cable Systems And Communities Served

Appellee Microdos markets a compilation of facts about cable systems in a computer software package titled "Cable Access". The Cable Access program provides detailed information about cable systems and is searchable by community name. 115 F.3d at 1512, Pet. App. 6a.

The names of the communities served by each cable system were obtained from Federal Communication Commission (FCC) public records (115 F.3d at 1519, n. 30, Pet. App. 23a, 24a) as well as other resources, including cable system operators and the Appellant's *Factbook*. The FCC requires operators of cable systems to report on FCC Form 325 the names of the community or communities served. Levine depo. p. 44; 47 CFR §§ 76.12, 76.400, and 76.403 (see 1SR-8 and 9), 1SR-10. The FCC assigns a unique code to each cable system and also to each community, and distributes Form 325 reports about cable systems and communities. P. Payne depo. pp. 37-38; 3SR; 4SR; 5SR; 6SR; 7SR; 8SR; 13SR. The community code and the system code are keys for indexing the FCC reports in order to research facts about each cable system. A cable system may serve one or more communities. Page A.2

attached to this brief was taken from SR13 and the page illustrates a single community cable system (Herscher, Illinois) and a multiple community cable system (Washington Park, Illinois) and some of the FCC public records for each.

The parties agreed to use Illinois as a test state for evaluating the issue of substantial similarity between the *Factbook* and the *Cable Access* database. In Illinois, 233 of 406 cable systems, or over 57 percent, are single community cable systems, according to FCC records. 10SR; R5-51-AFF of R. Payne, page 7. "The record shows that in the Illinois section of the *Factbook*, approximately fifty-five percent of the principal communities are single community systems." 115 F.3d at 1519, n. 30, Pet. App. 23a. A copy of an FCC report in the record at 16SR bears two sequential numberings. On the left is marked potential cable systems in Illinois; on the right is actual cable systems after eliminating duplicates and errors. The report shows 401 actual cable systems in Illinois (as of the date of the report). Of these, 233 are single community cable systems. A simple count of the Illinois cable systems in the *Factbook* shows that 231 out of 405 (or 57 percent) are single community cable systems. 9SR-B259 to B320. The remaining 174 cable systems in the *Cable Access* database serve more than one community, and for most, the lead community has the highest number of subscribers as listed in the FCC records. For over 360 of 406 cable systems in Illinois (over 88 percent) the lead community is either the single community or the community with the largest number of subscribers. 115 F.3d at 119, n. 30, Pet. App. 23a.

REASONS FOR DENYING THE PETITION FOR WRIT OF CERTIORARI

1. Certiorari Is Not Warranted Because The Eleventh Circuit Decision Is Merely An Application Of *Feist* and *BellSouth* To The Facts Shown In The Record: Appellant Disagrees With The Factual Findings And The Application Of An Established Rule Of Law.

The Appellant claims a compilation copyright in a comprehensive directory of cable systems indexed by geographical community names. Appellant's petition for writ of certiorari arises from its dissatisfaction with the application of the law in *Feist* and *BellSouth* to the factual findings of the district court and the *en banc* court below. Such disagreement regarding factual determinations are generally insufficient to obtain grant of the writ of certiorari for appeal to the Supreme Court. *Rules of the Supreme Court of the United States* (May 1, 1997). Further, even a misapplication of a properly stated rule of law is not grounds for granting certiorari. *Id.*

Certiorari is not appropriate in this case because the Eleventh Circuit applied the proper and consistent legal standard to the facts surrounding appellant's selection of material for inclusion in its compilation. The court below determined that the selection of community names in the comprehensive list of communities served by cable systems lacks subjective originality and the Appellant's *Factbook* is therefore not protectable by compilation copyright.

This Court has established the legal principles of compilation copyright law which the court below and the

other circuit courts have consistently followed. Where the compilation results from the originality of the author making the selection through subjective exercise of thought or judgment, the resulting compilation is copyrightable. *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991); *see, also, Key Publications v. China Town Today Publishing Enterprises, Inc.*, 945 F.2d 509, 513 (2nd Cir. 1991) (applying *Feist* to hold that selection copyrightable because it "implies the exercise of judgment in choosing which facts from a given body of data to include in a compilation"); *CCC Information Services v. MacLean Hunter Market Reports, Inc.*, 44 F.3d 61 (2nd Cir. 1994) (applying *Feist* to hold that predictions of future expected values for average vehicles was copyrightable compilation); *Lipton v. Nature Co.*, 71 F.3d 464, 470 (2nd Cir. 1995) (applying *Feist* to hold that "subjective creative judgment" was exercised in selecting 77 terms of venery from hundreds gathered from fifteenth century manuscripts); *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 140 (5th Cir. 1992) (citing *Feist* and holding that author required to make independent choices to select information from numerous sources).

Originality by a copyright author accordingly requires subjective judgment, thought, or constructive imagination, and in the absence of subjective selection, the work is not protected by compilation copyright. *Feist*, 499 U.S. 340, 111 S.Ct. 1282 (selection of listings which is obvious, mechanical or routine so as to require no creativity whatsoever lacks originality); *BellSouth*, 999 F.2d 1436 (11th Cir. 1993) (*en banc*) (applying *Feist* to hold that idea of dividing churches by denomination or attorneys by area of specialty is not copyrightable); *Mid America*

Title Co. v. Kirk, 59 F.3d 719 (7th Cir. 1995) (applying *Feist* and holding no creativity in selecting facts which effect marketable title from the domain of facts that could be included); *National Rifle Assn. v. Handgun Control Federation*, 844 F. Supp. 1178 (D.C. Ohio 1992) (applying *Feist* to hold that selection of factual information about state legislators was mechanical and routine). Indeed, *techniques* used in systems for the discovery of facts are not rewarded with compilation copyright for the gathered facts. *BellSouth*, 999 F.2d at 1441.

The *en banc* court below followed this Court's guidelines on the level of originality required for compilation copyright. The Eleventh Circuit properly applied the principles of compilation copyright under the Copyright Statute, the Constitution, and this Court's case law to the facts in the record (115 F.3d at 1511, Pet. App. 3a) and found that the *selection* by Warren in its system lacked originality (115 F.3d at 1517-1519, Pet. App. 19a, 21a, 22a), that Warren did not apply sufficient subjective judgment and thought to the collected facts (115 F.3d at 1518, Pet. App. 21a) and that the resulting comprehensive list of geographic names for areas served by cable systems was not an expression protectable by compilation copyright. 115 F.3d at 1520, Pet. App. 26a. Such an application of the Supreme Court law in *Feist* to the record does not warrant grant of certiorari.

Consistent with the rulings of other courts of appeals, the court below properly excluded copyrightability in a factual compilation in which there was no selection or original authorship exercised in applying the "organizing principle" by the author. The court below properly vacated the decision of the district court after

finding that Warren had failed to establish facts showing that the selection at issue was protectable expression under copyright law.

Introduction To Sections 2, 3, and 4

Following *de novo* review, the Eleventh Circuit held that Appellant's *Factbook* was not copyrightable on two primary grounds: (1) Appellant Warren's actions were not acts of authorship because Warren made no selection, but included in its *Factbook* compilation the entire universe of cable systems known to Warren (115 F.3d at 1517, 1518, Pet. App. 19a, 21a), and because the selection of the community name under which to list the factual data about the cable system was made by the cable systems, not Warren, which merely discovered those facts (115 F.3d at 1519-1520, Pet. App. 22a, 26a); and (2) the copyright statute excludes copyrights in "systems" under 17 U.S.C. § 102(b), and thus the district court's conclusion that Appellant's *system* of selection was protectable was not correct (115 F.3d at 1517-1519). The court offered a third alternative ground in footnote 27: that the expression of listing cable systems by the name of the communities served, with cross-referencing from smaller communities, does not survive the application of the copyright merger doctrine. 115 F.3d at 1531, n. 27. Each of these grounds, discussed below, is sufficient to uphold the *en banc* decision.

2. Certiorari Is Not Warranted Because The Eleventh Circuit Properly Applied The Compilation Copyright Law Of *Feist* and *BellSouth* To The Record And Held There Was Not Sufficient Creativity Or Originality In Warren's Actions To Entitle It To Compilation Copyright Protection

a. There Was No Originality In Warren's "Selection" Of All Known Cable Systems

The *en banc* court applied the legal guidelines of *Feist* and *BellSouth* to the facts in the record and held that Appellant Warren did not exercise original selection in its *Factbook*:

> [Warren] did not exercise any creativity or judgement in selecting cable systems to include in its Factbook, but rather included the entire relevant universe known to it. The only decision that it made was that it would not list separate information for each community that was part of a multiple community cable system. In other words, it decided to make the Factbook commercially useful.

115 F.3d at 1519, Pet. App. 21a. The court below found that Warren failed to show that it exercised any creativity or judgement in "selecting" cable systems to include in the *Factbook*. 115 F.3d at 1518, Pet. App. 21a.

Warren contends that this holding conflicts with the decision in *Eckes v. Card Prices Update*, 736 F.2d 859, 862-863 (2nd Cir. 1984). Pet. App. 18. In *Eckes*, the court found that the compiler exercised judgment in choosing whether a baseball card was "premium". The compiler thus independently selected certain baseball cards to

have a particular characteristic, i.e., the card was "premium." In contrast, Warren's selection of all cable systems does not provide the selected cable system with a distinguishing characteristic. The holding accordingly does not conflict with *Eckes*.

The *en banc* court below found as "plainly wrong" Warren's assertion that its system of listing communities does not include the entire universe of cable systems. 115 F.3d at 1518, Pet. App. 19a. The *en banc* court pointed out that the district court understood the requirement for subjective selection:

> In an unintentionally prescient footnote, however, the district court noted: This is not to say that the selection of cable systems would be copyrightable in all cases. Had Warren selected every cable system listed by the FCC then there would not be sufficient originality in the "selection" to warrant copyrightability.

115 F.3d at 1518, Pet. App. 19a.

Warren contends in its brief that "nothing in the record suggests the selection of cable systems in the *Factbook* was dictated by external forces or was a convention." Pet. App. 13. This is not correct. The FCC 325 report in 16SR identifies 405 discrete cable systems in the test state of Illinois. Warren's *Factbook* lists 406 Illinois cable systems. The *en banc* court noted that the district court erred in comparing the number of principal communities with the number of individual communities listed by the FCC; saying this was "comparing apples to oranges." 115 F.3d at 1518, Pet. App. 20a. Warren's brief in support of the petition, however, continues the mistake of comparing the number of *cable systems* in its *Factbook*

(406) with the number of *communities* (724 identified by the FCC) served by the cable systems. Pet. App. 13.

b. There Was No Originality In Warren's Organizing Principle Of Grouping Cable Systems By Communities Served

Appellant Warren argues that the Eleventh Circuit's *en banc* decision denied compilation copyright in the *Factbook* on the grounds that Warren used an "organizing principle of commercial usefulness" in its system of selection of cable systems with community names listed alphabetically. Pet. App. 11-14. However, the decision below was not based on a finding of "commercial usefulness." Indeed, Warren fails to recognize that the "organizing principle" must involve the exercise of subjective originality in selecting material for inclusion for the resulting work to be protectable by compilation copyright. As discussed above, commercially useful directories resulting from subjective original selection according to an organizing principle have been held to be copyrightable. *See, Key Publications, supra.*

Warren contends that it produced a unique grouping of communities and cable systems based on the way the cable systems actually developed, by grouping communities being offered the same services at the same prices by the cable systems. 115 F.3d at 1517, Pet. App. 18a. This is nothing more than a statement of how cable systems actually operate within a given geographical franchise. No franchise authority would permit a cable system to offer the same services at different prices within the

geographical area of the franchise. As the court below stated:

> Even if the industry was newly defined, as the dissent contends, when Warren organized cable systems under principal communities, however, the creative element is still lacking in Warren's compilation. The mere discovery of an organizing principle which is dictated by the market is not sufficient to establish creativity. "The distinction is one between creation and discovery: The first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence." *Feist*, 499 U.S. at 347, 111 S.Ct. at 1288. The same can be said for an organizing principle like the "principal community." Thus, even if Warren discovered the existence of the principal community as an organizing concept, Warren did not create this organization.

115 F.3d at 1520, n. 31, Pet. App. 25a.

c. Warren's "Selection" Of Principal Community Is Merely The Discovery Of Facts And Is Original To The Cable Operators, Not To Warren

The court below found that Warren's "selection" of a principal community in its compilation was merely the discovery of facts. 115 F.3d at 1519, 1520, Pet. App. 23a, 24a. The principal community was selected by contacting the cable operator to determine which community it considered the lead community within the cable system. 115 F.3d at 1520, Pet. App. 24a. The court below applied *BellSouth* and observed that the acts in this case were

likewise not acts of authorship but techniques for the discovery of facts:

> Simply because Warren may have been the first to discover and report a fact on cable systems does not translate these acts of discovery into acts of creation entitled to copyright protection. *Feist*, 499 U.S. at 347, 111 S.Ct. at 1288, 113 L.Ed.2d 358 (distinguishing creation from discovery). Just as the Copyright Act does not protect industrious collection, it affords no shelter to the resourceful, efficient, or creative collector. *BellSouth*, 999 F.2d at 1441.

115 F.3d at 1520; Pet. App. 24a, 25a.

Even assuming selection of the principal community for the *Factbook* was creative and original, the court below found that the selection was not Warren's, but rather was that of the cable operators contacted by Warren:

> The record indicates that it is the cable operators, not Warren, that determine, in the case of a multiple-community system, the community name under which to list the factual data for the entire cable system. Therefore, Warren cannot prevail in its claim that it undertakes original selection in employing the principal community concept. Rather, it has created an effective system for determining where the cable operators prefer to have the data listed. While Warren may have found an efficient method of gathering this information, it lacks originality, which is the *sine qua non* of copyright. *See Feist*, 499 U.S. at 345, 111 S.Ct. at 1287. Thus, the district court erred in finding that Warren's principal community

> "system" was sufficiently creative and original to be entitled to copyright protection.

115 F.3d at 1520, Pet. App. 26a.

As the Supreme Court noted in *Feist*, originality of selection may also fail if a court concludes that the selection was dictated by another entity and not by the copyright claimant. *Feist*, 499 U.S. at 361, 362, 111 S.Ct. at 1296, 1297. Similarly, in the present case, the selection of community was dictated by an outside entity (i.e., the cable system operator) and not by the claimant Warren.

3. Certiorari Is Not Warranted Because "Systems" Under 17 U.S.C. § 102(b) Are Clearly Excluded From Copyright Protection

Warren practiced a system of discovering facts about cable systems to determine the names of the communities served by the cable systems. The system used various techniques, including FCC records, telephone calls, and questionnaires, to discover facts about the cable systems and the community name the cable system operator considered the principal community. Warren then listed the community names in its compilation as an index to the cable system facts.

The court below properly held that Appellant's system of learning community names is not protectable by copyright because the Copyright Statute bars copyright for "systems". 17 U.S.C. § 102(b).

Warren claims that the issue is the copyrightability of its *selection* of cable systems included in the directory. Pet. App. 8. Warren describes this selection process in detail

in support of its position. Pet. App. 4-6. Warren then claims that it is not seeking "copyright protection for the underlying idea of its 'system' or for any aspect of its data collection efforts." Pet. App. 9. Warren's reliance on a detailed system of selection of data as the basis for showing copyrightable subject matter on the one hand, and Warren's claim that it is seeking protection only for the resulting *expression* of its system of grouping cable systems by geographical area, is mere semantics.

If copyright of such selection were possible, as Appellant claims, then one could employ a complicated method of gathering names for a telephone book and a complicated computer program for sorting the names by area and alphabetically, and then claim copyright protection for the resulting expression of a list of names. *Feist* makes clear that this is not the law. *See, Feist*, 499 U.S. at 357-359, 111 S.Ct. at 1294, 1295.

Warren claims that the panel's holding conflicts with the ruling in *Toro Co. v. R&R Products Co.*, 787 F.2d 1208 (8th Cir. 1986). Appellant proffers *Toro* for the proposition that 17 U.S.C. § 102(b) does not *per se* prohibit a system from obtaining copyright protection. However, in that case, the Eighth Circuit affirmed the district court ruling, holding that the appellant's parts numbering system was *not* copyrightable. The court held that § 102(b) did not answer the question of whether the parts numbering system at issue in that case contained the requisite level of originality. The court relied not on § 102(b), but rather on the grounds that the parts numbering list lacked the requisite originality. *Toro*, 787 F.2d 1208. The discussion by the Eighth Circuit regarding § 102(b) was *dicta* and is not inconsistent with the Eleventh Circuit's holding.

The Eighth Circuit in *Toro* also stated that the Appellant could have no copyright protection for the *idea* of using numbers to designate replacement parts. *Toro*, 787 F.2d 1208. Likewise, in the present case, Appellant Warren cannot copyright the *idea* of grouping cable systems by the name of the geographical area served by that cable system. There can be no "monopoly on a system or method for performing commercial functions." R. Nimmer, *Nimmer On Copyright* (1997) § 2.18[C].

4. Certiorari Is Not Warranted Because The Eleventh Circuit Applied The Copyright Merger Doctrine To The Record And Held That The Expression In Warren's Work Merged With Its Idea

The petition for writ of certiorari should be denied because Warren's *Factbook* compilation listing facts about cable systems under the community name for the geographical area served by the cable systems merges with the idea behind such a geographically indexed directory. *BellSouth*, 999 F.2d at 1442 (expression not protected where there is only one or so few ways of expressing an idea that protection of the expression effectively accords protection to the idea); *Morrissey v. Proctor & Gamble Co.*, 379 F.2d 675, 154 U.S.P.Q. 193, 195 (1st Cir. 1967) (operation of the merger doctrine does not require the court to wait for an attempt to copyright all possible forms of expression nor does it condemn only the last form of expression); *Cooling Systems and Flexibles, Inc. v. Stewart Radiator, Inc.*, 777 F.2d 485, 492 (9th Cir. 1989) (protectable expression must be "something more than what must be unavoidably reproduced by anyone who wishes to use and restate facts."); *Matthew Bender Co. v. Kluwer Law Book*

Publishers, Inc., 672 F.Supp. 107, 111 (S.D.N.Y. 1987) (no copyright protection in headings used to display data regarding personal injury awards where the terms employed are the most logical and clear way of expressing the idea and "the only way of conveying the desired information").

In applying the merger doctrine, the court must first identify the idea that the work expresses, and then attempt to distinguish that idea from the author's expression. *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 138-139 (5th Cir. 1992). If the idea and its expression merges, then the doctrine applies and the expression is not protected. *Id.*

Warren contends that the idea behind the *Factbook* compilation should be expressed broadly as "a source of information about cable systems." Pet. App. 17. Warren implements that idea by listing facts about the cable system under the community name of the geographic area served by the cable system.

The expression of selecting community names to identify the geographic areas served by cable systems, with cross-indexing from smaller communities for multiple-community cable systems, merges with the idea. As the court below stated:

> Warren's claim of copyright in its selection of communities does not survive application of the merger doctrine. . . . If Warren were given protection in its principal community system, the concept of cross-referencing would be subsumed in its copyright. The idea of organizing by principal community yields very few ways, if not only one way, of expressing the data. Each

> SSO [single-community cable system] has only one principal community. Each MSO [multiple-community cable system] has one obvious principal community. For the compilation to be convenient and useful, not repetitive and onerous, however, the non-principal communities in each MSO must be cross-referenced to the principal community with the data listed only under the principal community. The customers for whom the Factbook and similar products are produced are not interested in having information repeated under every community served by a multiple-community system. Consequently, expression of the principal community selection has merged with the idea, and thus the selection of principal communities is uncopyrightable.

115 F.3d at 1518, n. 27, Pet. App. 21a, 22a.

The court below again described the "selection" of principal community:

> . . . in the case of a single-community system, there is only one community served and therefore only one possible principal community. Thus, no argument can be made regarding the selection of the principal community in the case of a single-community system.

115 F.3d at 1519, n. 30, Pet. App. 23a.

For example, there is but one way to express the community name for the geographical area around Chester, Illinois served by the cable system – that is "Chester." Now, if Warren instead had identified the geographical area as "a quaint town on a bluff overlooking the Mississippi River" – that might be original.

The court below continued:

> The record shows that in the Illinois section of the Factbook, approximately fifty-five percent of the principal communities are single-community systems. For the remaining principal communities, which are all part of multiple-community systems, Appellee Microdos contends that over two-thirds of them are simply the community in the multiple-community system that, according to FCC records, has the highest number of subscribers.

115 F.3d at 1519, n. 30, Pet. App. 23a.

The *en banc* decision also found that the community names were contained in FCC records:

> Warren cannot make any tenable argument regarding selection in these instances either, given that their "selection" is nothing more than discovery of facts that are contained in the publicly-available FCC records.

115 F.3d at 1519, n. 30, Pet. App. 23a.

The expression of a geographical index (i.e., community names) to identify cable systems merges with its idea, and the work is therefore not protectable expression, as the court below properly held, and certiorari is therefore not appropriate.

CONCLUSION

In accordance with the foregoing reasoning and authority, Appellee requests that the petition for certiorari be DENIED.

Respectfully submitted,

ROBERT B. KENNEDY
CARL M. DAVIS II
LESLIE C. RUITER

KENNEDY, DAVIS & KENNEDY
Suite 1250
400 Northpark Town Center
1000 Abernathy Road
Atlanta, Georgia 30328

Programming (via satellite): WTBS (I) Atlanta; WGN-TV (I) Chicago.
Current originations: Time-weather.
Fee: $18.00-$25.00 installation; $9.95 monthly.
Tier 1
Subscribers: 38 (01/01/85). Began: October 1, 1984.
Programming (via satellite): Cinemax.
Fee: $18.00 installation; $10.00 monthly.
Tier 2
Subscribers: 214 (01/01/85). Began: January 1, 1980.
Programming (via satellite): HBO.
Fee: $18.00 installation; $10.00 monthly.
Equipment: GTE Sylvania headend; GTE Sylvania amplifiers; Times cable.
Miles of plant: 6.0 (coaxial). Homes passed: 757.
Manager: John Beck. Chief technician: Dan Lowing.
City fee: None.
Ownership: Cass Cable TV Inc. (see Cable Group Ownership), 100%.
Note: Current information not available.

Wabash County—See MOUNT CARMEL, IL.

WADSWORTH—See WAUKEGAN, IL.

WALNUT—Walnut Cable, Box K, 1416 State St., Bettendorf, IA 52722. Phone: 319-359-0358. County: Bureau. Population: 1,513.
TV Market Ranking: Below 100. Original franchise award date: December 1, 1982. Franchise expiration date: December 1, 1997. Began: July 1, 1983.
Channel capacity: N.A. Channels available but not in use: N.A.
Basic Service
Subscribers: 407 (05/15/87).
Programming (received off air): WIFR-TV (C), Freeport-Rockford; WORF-TV (I), WREX-TV (A), WTVO (N) Rockford.
Programming (via satellite): WTBS (I) Atlanta; WGN-TV (I) Chicago; CBN Cable Network; CNN; USA Network.
Fee: $25.00 installation; $10.45 monthly.
Expanded Basic 1
Subscribers: N.A. Began: N.A.
Programming (via satellite): Discovery Channel; Lifetime; MTV; Nashville Network; Nickelodeon.
Fee: $3.95 monthly.
Tier 1
Subscribers: N.A. Began: N.A.
Programming (via satellite): HBO; Showtime.
Fee: $15.00 installation; $9.00 monthly (each).
Miles of plant: 7.0 (coaxial). Homes passed: 600.
Ownership: Triax Communications Corp. (see Cable Group Ownership), 100%. Purchased from Midland Cablevision Systems Inc., June 1987.

WAMAC—See CENTRALIA, IL.

WAPELLA—See HEYWORTH, IL.

WARREN—Dowden Communications of Illinois, Box 615, 216 W. Main St., Lena, IL 61048. Phone: 815-369-5261. County: Jo Daviess. Also serves Apple River. Population: 2,249.
TV Market Ranking: 97. Original franchise award date: N.A. Franchise expiration date: March 1, 1997. Began: March 31, 1983.
Channel capacity: 36. Channels available but not in use: 16.
Basic Service
Subscribers: 455 (11/30/86).
Programming (received off air): KDUB-TV (A), Dubuque; WIFR-TV (C), Freeport-Rockford; WHA-TV (P), WISC-TV (C), Madison; WQRF-TV (I), WREX-TV (A), WTVO (N) Rockford.
Programming (via satellite): WTBS (I) Atlanta; WGN-TV (I) Chicago; CBN Cable Network; CNN; ESPN; Lifetime; MTV; Nashville Network; Nickelodeon; USA Network.
Current originations: Time-weather; news ticker; stock ticker.
Fee: $25.00 installation; $11.95 monthly.
Tier 1
Subscribers: 72 (11/30/86). Began: March 31, 1983.
Programming (via satellite): Cinemax.
Fee: $25.00 installation; $9.95 monthly.
Tier 2
Subscribers: 188 (11/30/86). Began: March 31, 1983.
Programming (via satellite): HBO.
Fee: $25.00 installation; $9.95 monthly.
Tier 3
Subscribers: 40 (11/30/86). Began: March 31, 1983.
Programming (via satellite): Showtime.
Fee: $25.00 installation; $9.95 monthly.
Equipment: Scientific-Atlanta headend; Scientific-Atlanta amplifiers; Scientific-Atlanta cable; Scientific-Atlanta set top converters; Vitek traps; Scientific-Atlanta satellite antenna; Scientific-Atlanta satellite receivers.
Miles of plant: 18.8 (coaxial). Homes passed: 852. Total homes in franchised area: 852.
Manager: Gary Crosby. Chief technician: Larry Kuepker.
City fee: 5% of gross.
Ownership: Dowden Cable Partners L.P. (see Cable Group Ownership), 100%.

WARREN TWP.—See WAUKEGAN, IL.

WARRENSBURG—Cable Systems USA, Box 600, RD 1, Tionesta, PA 16353. Phone: 814-755-3618. County: Macon. Also serves Latham. Population: 1,936.
TV Market Ranking: 64. Original franchise award date: N.A. Franchise expiration date: January 21, 1995. Began: N.A.
Channel capacity: 36. Channels available but not in use: 19.
Basic Service
Subscribers: 425 (12/31/87).
Programming (received off air): WCIA (C), Champaign; WAND (A), WFHL (I), Decatur; WICS (N), WRSP-TV (I), Springfield; WILL-TV (P) Urbana-Champaign.
Programming (via satellite): WTBS (I) Atlanta; WGN-TV (I) Chicago; CBN Cable Network; CNN; ESPN; Nashville Network; USA Network.
Fee: $35.00 installation; $13.40 monthly; $2.00 monthly (each additional set).
Tier 1
Subscribers: 86 (12/31/87). Began: N.A.
Programming (via satellite): Cinemax.
Fee: $10.00 installation; $8.00 monthly.
Tier 2
Subscribers: 36 (12/31/87). Began: N.A.
Programming (via satellite): Disney Channel.
Fee: $10.00 installation; $6.00 monthly.
Tier 3
Subscribers: 126 (12/31/87). Began: N.A.
Programming (via satellite): HBO.
Fee: $10.00 installation; $10.00 monthly.
Tier 4
Subscribers: 12 (12/31/87). Began: N.A.
Programming (via satellite): Showtime.
Fee: $10.00 installation; $10.00 monthly.
Miles of plant: 15.1 (coaxial). Homes passed: 690.
Manager: Melanie Ward. Chief technician: Walt Ziemba.
City fee: 3% of gross.
Ownership: Cable Systems USA Assoc. (see Cable Group Ownership), 100%. Purchased from First Rural Cable Inc.

WARRENVILLE—See WEST CHICAGO, IL.

WARSAW—See KEOKUK, IA.

WASHBURN—See ROANOKE, IL.

WASHINGTON—See PEORIA, IL.

WASHINGTON PARK—Dowden Communications of Illinois Inc., Box 615, 216 W. Main St., Lena, IL 61048. Phone: 815-369-5161. Counties: Madison & St. Clair. Also serves Fairmont City, Madison County, St. Clair County (unincorporated portions). Population: 10,634.
TV Market Ranking: 11. Original franchise award date: N.A. Franchise expiration date: June 1, 1997. Began: June 23, 1983.
Channel capacity: 36. Channels available but not in use: 12.
Basic Service
Subscribers: 1,679 (11/30/86).
Programming (received off air): KDNL-TV (I), KETC (P), KMOV (C), KNLC (I), KSDK (N), KTVI (A) St. Louis.
Programming (via satellite): WTBS (I) Atlanta; WGN-TV (I) Chicago; WWOR-TV (I) New York; Black Entertainment TV; CBN Cable Network; CNN Headline News; ESPN; MTV; Nashville Network; Nickelodeon; The Weather Channel; USA Network.
Current originations: Time-weather; news ticker; stock ticker.
Fee: $25.00 installation; $11.95 monthly.
Tier 1
Subscribers: 856 (11/30/86). Began: June 23, 1983.
Programming (via satellite): Cinemax.
Fee: $25.00 installation; $9.45 monthly.
Tier 2
Subscribers: 1,086 (11/30/86). Began: June 23, 1983.
Programming (via satellite): HBO.
Fee: $25.00 installation; $9.45 monthly.
Tier 3
Subscribers: N.A. Began: N.A.
Programming (via satellite): Playboy Channel.
Fee: $25.00 installation; $7.90 monthly.
Equipment: Scientific-Atlanta headend; Scientific-Atlanta amplifiers; Scientific-Atlanta cable; Compuvid character generator; Scientific-Atlanta & Hamlin set top converters; Vitek traps; Scientific-Atlanta satellite antenna; Scientific-Atlanta satellite receivers.
Miles of plant: 74.8 (coaxial). Homes passed: 5,092. Total homes in franchised area: 5,092.
Manager: Gary Crosby. Chief technician: Larry Kuepker.
City fee: 5% of gross.
Ownership: Dowden Cable Partners L.P. (see Cable Group Ownership), 100%.

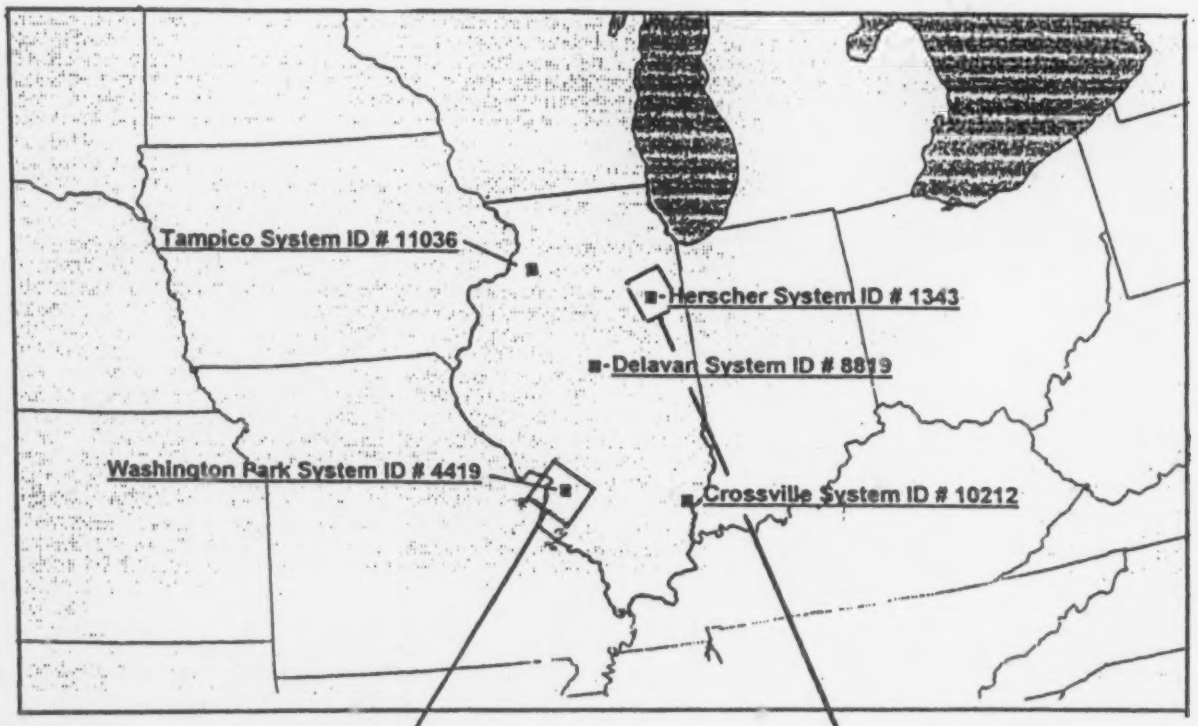
WATAGA—Nova Communications Inc., 562 N. Henderson Rd., Galesburg, IL 61401. Phone: 309-342-8384. County: Knox. Also serves Henderson. Population: 1,365.
TV Market Ranking: 60. Original franchise award date: N.A. Franchise expiration date: N.A. Began: September 1, 1986.
Channel capacity: 35. Channels available but not in use: 23.
Basic Service
Subscribers: 322 (07/01/85).
Programming (received off air): KWQC-TV (N), Davenport; KIIN-TV (P), Iowa City; WQAD-TV (A), Moline; WHBF-TV (C) Rock Island.
Programming (via satellite): WTBS (I) Atlanta; WGN-TV (I) Chicago; CBN Cable Network; CNN; ESPN; Nashville Network.
Fee: $30.00 installation; $8.75 monthly.
Tier 1
Subscribers: N.A. Began: September 1, 1984.
Programming (via satellite): Cinemax; HBO.
Fee: $10.00 monthly (each), $18.50 (both).
Homes passed: 560.
Manager: Robert G. Fischer Jr.
Ownership: Triax Communications Corp. (see Cable Group Ownership), 100%. Purchased from Nova Communications Inc., Sept. 1987.
Note: Current information not available.

WATERLOO—Cencom Cable Assoc. Inc., 200 W. Division St., Maryville, IL 62062. Phone: 618-345-8121. County: Monroe. Population: 4,646.
TV Market Ranking: 11. Original franchise award date: N.A. Franchise expiration date: January 1, 1996. Began: January 1, 1981.
Channel capacity: 36 (2-way capable). Channels available but not in use: 3.
Basic Service
Subscribers: 720 (01/31/85).
Programming (received off air): KDNL-TV (I), KETC (P), KMOV (C), KNLC (I), KPLR-TV (I), KSDK (N), KTVI (A) St. Louis.
Programming (via satellite): WTBS (I) Atlanta; WGN-TV (I) Chicago; CBN Cable Network; CNN; CNN Headline News; ESPN; Lifetime; MTV; Nashville Network; Nickelodeon; The Weather Channel; USA Network.
Fee: $25.00 installation; $9.00 monthly.
Tier 1
Subscribers: 925 (01/31/85). Began: N.A.
Programming (via satellite): HBO; Showtime; The Movie Channel.
Fee: $10.00 installation; $10.00-$10.75 monthly (each).
Equipment: Scientific-Atlanta headend; Theta-Com amplifiers; Scientific-Atlanta cable; Pioneer set top converters; Scientific-Atlanta satellite antenna; Scientific-Atlanta satellite receivers.
Miles of plant: 27.0 (coaxial). Homes passed: 1,538. Total homes in franchised area: 1,538.
Manager: Dave Trotell. Chief technician: Mathew Aldridge.
City fee: 3% of gross.
Ownership: Cencom Cable Assoc. Inc. (see Cable Group Ownership), 100%.
Note: Current information not available.

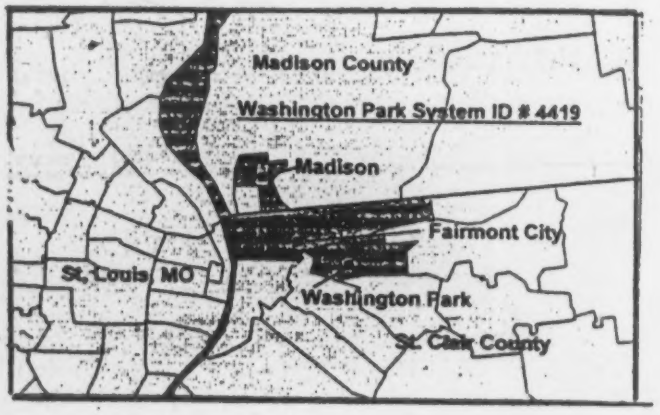
WATERMAN—Dowden Communications of Illinois, Box 615, 216 W. Main St., Lena, IL 61048. Phone: 815-369-5261. County: De Kalb. Also serves Hinckley, Shabbona. Population: 3,241.
TV Market Ranking: Below 100. Original franchise award date: N.A. Franchise expiration date: N.A. Began: December 17, 1984.
Channel capacity: 42. Channels available but not in use: 17.
Basic Service
Subscribers: 670 (11/30/86).
Programming (received off air): WEHS (I), Aurora; WBBM-TV (C), WCFC-TV (I), WCIU-TV (I), WFLD (I), WGN-TV (I), WLS-TV (A), WMAQ-TV (N), WTTW (P), WYCC (P), Chicago; WIFR-TV (C), Free-

BEST AVAILABLE COPY

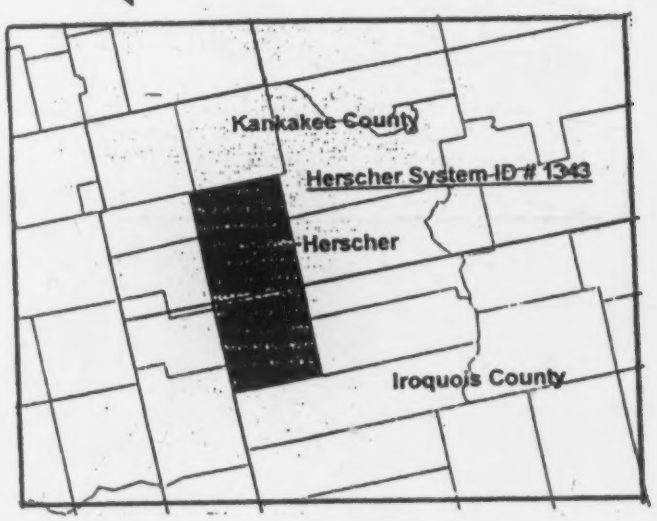
Several of the geographic areas in Illinois served by cable systems



Detail of Washington Park



Detail of Herscher



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SYSTEM-ID	OPERATOR	CHANNEL CAP	CHANNEL USE	PAY TV	LOCAL PROGR	AERO FREQ	MARKET	HOMES-PASSED	SUBSCRIBERS	STRAND MILES	PERC	CODE	COMMUNITY		BEGAN	FILE
004419-01	TRIAX MIDWEST ASSOCIATES	L	P			TOP 50 MKTS		2,927	787	26		IL0694	WASHINGTON PARK	X	8307	8706
	TRIAX MIDWEST ASSOCIATES	L	P			TOP 50 MKTS		938	374	13		IL0695	FAIRMONT CITY		8311	8706
	TRIAX MIDWEST ASSOCIATES	L	P			TOP 50 MKTS		344	139	6		IL1042	MADISON		8409	8706
	TRIAX MIDWEST ASSOCIATES	L	P			TOP 50 MKTS		900	397	19		IL0746	ST CLAIR		8304	8710
		35	26	Y	Y	Y		5,109	1,897	64	37.1	4				
001343-01	TCI OF ILLINOIS INC					OUTSIDE ALL		405	228	11		IL0291	HERSCHER	X	7812	8707
		22	15	Y	Y	N		405	228	11	56.3	1				

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Supreme Court, U.S.
FILED
OCT 22 1997
CLERK

No. 97-376

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1997

Warren Publishing Inc.,
Petitioner,

v.

Microdos Data Corp., *et al.*,
Respondents.

A Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

REPLY IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

JOYCE B. KLEMMER
SMITH, GAMBRELL, & RUSSELL
Suite 3100, Promenade II
1230 Peachtree Street, NE
Atlanta, GA 30309-3592
(404) 815-3500

DENNIS LANE
Counsel of Record
MORRISON & HECKER L.L.P
Suite 800
1150 18th Street, NW
Washington, DC 20036-3816
(202) 785-9100

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REPLY IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Warren Publishing, Inc. ("Warren"), plaintiff-appellee below, submits this reply in support of its Petition For A Writ Of Certiorari ("Cert. Pet.") to review the judgment of the United States Court of Appeals for the Eleventh Circuit in this case.

Respondents in their Opposition ("Opp.") present newly formulated assertions to deflect attention from the conflicts caused by the legal rulings of the Eleventh Circuit's *en banc* decision below with rulings of other circuits regarding the level of creativity needed for factual compilations to be protected by copyright. Similar assertions were resolved against Respondents by the district court, and should not obscure the need for this Court to resolve the conflicts between circuits on these important legal issues.

1. Respondents contend that Warren's comparison of its 406 selected Illinois cable systems with the FCC's listing of 724 cable system communities, Cert. Pet. at 13, was "comparing apples to oranges." Opp. 12; quoting Pet.App. 20a. This fails to recognize, however, that Warren and the FCC define "cable system" differently, and thus the resulting selections of cable systems will necessarily differ. The FCC defines "cable system" as encompassing only a single community:

> (a) Cable system or cable television system. A facility consisting of a set of closed transmission paths and associated signal generation, reception, and control equipment that is designed to provide cable service which includes video programming and which is provided to multiple subscribers within a community . . . .

47 C.F.R. § 76.5(a)(1995)[1]; *see* 47 C.F.R. § 76.5(dd)(1995) (same).

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[1] This same definition was in place when Warren's 1988 *Factbook* at issue here was created. 47 C.F.R. § 76.5(a) (1988).

Under the FCC's definition, each community with cable service is considered a separate cable system. *See* Pet.App. 84a (FCC "attempts to list individually every community with a cable system across the country"). In contrast, Warren groups together those communities "that are offered the same service by the same cable system owner at the same price" into distinct cable systems. Pet. App. 82a. Because Warren's definition combines multiple communities meeting the stated parameters into unified cable systems, it is not surprising that Warren's selection of 406 Illinois cable systems is substantially lower than the FCC's list of 724 community cable systems.

Comparing these two lists measures "apples to apples" because both identify "cable systems." That Warren's selection of cable systems differs from the FCC's demonstrates that Warren was not following a convention. Cert. Pet. at 12-13. Dissimilarities between Warren's, the FCC's, and others' cable system selections highlight the originality found in Warren's selection. *See Engineering Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335, 1346 (5th Cir. 1994)("creativity inherent in EDI's program is proved by the existence of other, dissimilar" programs).

2. To support their contention that the cable system selection in Warren's *Factbook* was dictated by external forces (Opp. at 12), Respondents proffer for the first time a claim that an FCC report "identifies 405 discrete cable systems in the test state of Illinois." *Id.* This newly formulated and unsupported claim is designed to result in a number that mirrors the 406 Illinois cable systems selected for inclusion in Warren's *Factbook*. Opp. at 12. By juxtaposing these two numbers, Respondents seek to imply that the same group of cable systems was originally selected by the FCC and later copied by Warren.

Respondents' implication that Warren's selection of cable systems closely matches this newly proffered grouping of

FCC data is a variation on their "independent creation" defense. Pet.App. 85a. The district court rejected Respondents' previous efforts to show they independently created a selection identical to that in the *Factbook*. The district court found over 120 instances where the FCC data would have led to a different cable system selection from that chosen by Warren. Pet.App. 86a-87a. This finding eviscerates any claim that Warren's selection simply followed an FCC convention, rather than emanated from Warren's independent creation.

Respondents' newly formulated comparison of an FCC report purportedly yielding 405 Illinois cable systems with Warren's selection, Opp. at 12, was not considered below. The *en banc* court below did not employ that comparison, but, instead, compared lists of cable communities, which showed a wide disparity between Warren's list and that of the FCC. Pet.App. 20a. The *en banc* court found that the FCC listed 724 Illinois cable communities while Warren identified 1000 + communities with cable service. *Id.* n.26 and accompanying text. Thus, Respondents' contention rests on a premise not introduced or decided in the decisions below, and which, therefore, should not be considered by this Court.

3. Respondents contend that Warren's selection by "grouping communities being offered the same services at the same prices . . . is nothing more than a statement of how cable systems operate within a given geographical franchise." Opp. 13. Again, they attempt to suggest that Warren's selection merely follows a convention. According to Respondents, "[n]o franchise authority would permit a cable system to offer the same services at different prices within the geographical area of the franchise." Opp. 13-14. Respondents' contention necessarily implies an exact correspondence between "franchise areas" and the 406 Illinois cable systems selected by

Warren.[2]

Respondents' implication does not match reality.[3] Multi-community franchising authorities matching the geographic areas covered by each of Warren's cable system selections are not the norm. Many of Warren's multi-community cable system selections are each governed by multiple franchise authorities.

Because franchising authority resides at the individual community level, Warren's selection of groups of communities served by the same operator with the same service at the same price did not simply mimic groupings already established by franchising authorities. Instead, Warren used its judgment to choose those groups of communities that would be considered cable systems for purposes of the *Factbook*, regardless of whether all communities in the groups were governed by the same franchise authority. Basing the selection on this judgment supports a finding that Warren's selection shows the requisite creativity for copyright protection.

4. Respondents contend that Warren's selection merely follows the wishes of cable operators as to how they want to be

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[2] For example, if Warren selected cable system A encompassing six communities and cable system B with four communities, the franchising authorities regulating them would have to cover the same six communities and four communities, respectively. This pattern must be repeated in all 406 Illinois cable systems selected by Warren for Respondents' implication to be true.

[3] Although state and federal regulatory agencies have authority over some aspects of cable service, *United States v. Southwestern Cable Co.*, 392 U.S. 157, 163 n. 15 (1968) *accord Capital Cities Cable, Inc. v. Crisp*, 467 U.S. 569, 702 (1984), franchising authority resides in "cities, towns and villages, that is, [the] franchise-granting units." Pet.App. 31a; *see Los Angeles v. Preferred Communications*, 476 U.S. 488, 490 n. 1 (1986)(state law granting franchise authority to municipalities).

listed in the *Factbook*. Opp. 14-15. Nothing in the record supports the claims that operators, rather than Warren, select which communities are to be grouped into separate cable systems or which community is to be the principal community identifying a selected cable system.[4] Indeed, that Warren, not the cable operators, makes the selection can be seen on the face of Opp. attachment, Page A-1.

Two selections on Page A-1 – those for the communities of "Warren" and "Washington Park" – contain exactly the same cable system name, address, phone number, manager, chief technician, and ownership. These matches in two separate listings strongly suggest that the cable operator considers the two as a single system and operates them from a community (Lena) that differs from either of the principal communities (Warren and Washington Park) chosen for use in the *Factbook*.

Had Warren slavishly followed cable operator wishes, as Respondents assert, it is unlikely that these two selections would have appeared as they did. Warren's own selection process is revealed in its judgment to include at least two separate cable systems in lieu of what otherwise might appear to be a single system run by this operator. Rather than following cable operator wishes, this choice demonstrates the requisite level of creativity for obtaining protection of the selection found in the *Factbook*.

5. Respondents argue that it "is mere semantics" for

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[4] The presence of preexisting facts in a compilation cannot defeat its copyrightability. The statutory definition recognizes that a compilation includes "preexisting materials." 17 U.S.C. § 101 "compilation"; *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991)(prior existence of facts "largely irrelevant to the issue of whether Kregos' *selection* of statistics display sufficient creativity . . . . Nearly all copyrighted compilations of facts convey facts that have been published elsewhere.")(emphasis in original).

Warren to claim to seek protection of the *Factbook's* selection when Warren relied "on a detailed system of selection of data as the basis for showing copyrightable subject matter." Opp. 17. The short answer to this can be found in the copyright registration which applies solely to the *Factbook*, not to the system of selection. Pet.App. 7a n. 4. Absent registration, no protection can be sought. 17 U.S.C. § 411(a). In addition, the evidence compared Warren's actual selection of 406 Illinois cable systems with Respondents' list of cable systems. *E.g.*, Pet.App. 83a-85a.

Analysis of Warren's system of selection was introduced to satisfy the *prima facie* element of an infringement claim that the copied portions of a work are original and thus copyrightable. Pet.App. 79a; *see Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U... 340, 358 (1991)("courts . . . in determining whether a fact-based work is an original work . . . should focus on the manner in which the collected facts have been selected").

Originality requires that the manner of selection be conceived by the author, rather than simply follow convention or otherwise be so banal as to lack any creative spark.[5] On this question, the *en banc* decision below, requiring what the amici, Newsletter Publishers Association *et al.* Brief at 15, term "a towering inferno" to show originality, conflicts with this Court's and other circuits' rulings that only a small spark of creativity is needed. *See* Cert. Pet. at 7-19 (summarizing conflicts on originality issues).

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[5] Respondents contend that reliance on the method of selection would result in "a complicated method of gathering names for a telephone book and a complicated computer program for sorting the names by area and alphabetically" being improperly protected. Opp. 17. Respondents' example applies to an arrangement of facts and is inapposite. The instant issue addresses a selection, which involves issues of how preexisting materials are chosen, not how that selection is then sorted.

Respondents' contention that *Toro Co. v. R & R Products Co.*, 787 F.2d 1208, 1211 (8th Cir. 1986), does not conflict with the *en banc* decision below, Opp. 17, is groundless. The *en banc* decision below creates a *per se* rule that 17 U.S.C. § 102(b) precludes copyright protection for any compilation that employs a system of selection. Pet.App. 17a. The *Toro* court explicitly rejected this approach, and found, instead, that each compilation must be judged on its facts. Cert. Pet. at 8-9. Contrary to Respondents' assertion, the two decisions are clearly and squarely in conflict.

6. Respondents' claims that the merger doctrine bars protection, Opp. 18-21, repeat an error of the *en banc* decision below which conflicts with similar decisions by other circuits. Cert. Pet. at 15-17. The error is that of examining the idea behind the particular expression chosen, rather than the idea behind the overall work, to determine whether merger has occurred. *See* Opp. at 19 ("The expression of selecting community names to identify the geographic areas served by cable systems, with cross-indexing from smaller communities for multiple-community cable systems, merges with the idea").[6]

But looking at one expression does not address whether the idea behind the *Factbook*, to present data about cable systems, can be expressed in ways other than the selection used by Warren. Other ways of presenting data about cable systems were already being used by the FCC and Warren's competitors. Pet.App. 84a-85a. Still yet unused ways of grouping cable systems are possible. For example, someone may group by system name, so that instead of the *Factbook's* separate listings in the case of "Warren" and "Washington Park," Opp.

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[6] Respondents' have not accurately portrayed Warren's principal communities identification process: the suggestion that the principal community is always the largest community in multiple community situations is inaccurate.

attachment, p. A-1, they might, instead, be listed under the owner's name, or grouped under the system's headquarters in Lena. Multiple possibilities apart from the one chosen by Warren preclude application of the merger doctrine.

Respondents' contention that Warren's selection should be left unprotected because "there is but one way to express the community name for the geographical area," Opp. 20, misses the point. Warren does not and cannot seek protection in any one individual community name. Rather, protection is sought in the entire selection of 406 Illinois cable systems. Some overlap between two selections using community names was to be expected without causing infringement. *See* Pet.App. 85a (district court used a baseline overlap of 82.25%). Infringement was found, however, due to the virtual identity (greater than 90% match) between Warren's and Respondents' Illinois cable system listings. Pet.App. 84a. Such identity is properly regarded as infringement.

7. Respondents' efforts to obfuscate with new factual and legal assertions should not obscure the absence of any persuasive legal grounds for denying Warren's petition. Serious conflicts exist between the *en banc* decision below and the rulings of other circuits on similar questions as well as with the governing statute and decisions of this Court, as was demonstrated in Warren's petition and the amici briefs.

The *en banc* decision below diminishes the incentives for creators of compilations to continue their efforts. Those efforts further the underlying goal of copyright, to advance learning, by providing the public with greater access to information in readily-usable formats. As such, compilations deserve the full protection of the law, not the artificially restrictive approach taken by the *en banc* decision below.

CONCLUSION

For the reasons stated herein and in Warren's petition, the writ of certiorari should be issued.

Respectfully submitted,

DENNIS LANE
Counsel of Record
MORRISON & HECKER L.L.P.
Suite 800
1150 18th Street, NW
Washington, DC 20036-3816

JOYCE B. KLEMMER
SMITH, GAMBRELL & RUSSELL
Suite 3100, Promenade II
1230 Peachtree Street, NE
Atlanta, GA 30309-3592